

MONDE NISSIN CORPORATION	}	Inter Partes Case No. 14-2006-00153
formerly Monde Denmark Nissin	}	Petition for Cancellation of:
Biscuit Corp., represented by its	}	
Brand Development Manager,	}	
Chester Cajucom-Uy,	}	Reg. No. : 4-1982-047840
<i>Petitioner,</i>	}	Date Issued : 01 September 2006
	}	
-versus-	}	Trademark : "NISSIN
	}	(BULLSEYE DEVICE)"
SUNNY DELIGHTS (S) PTE. LTD.,	}	
<i>Respondent-Registrant.</i>	}	
x-----x	}	Decision No. 2008-176

DECISION

This is a verified AMENDED PETITION for cancellation filed by Monde Nissin Corporation, formerly Monde Denmark Nissin Biscuit Corp., represented by its Brand Development Manager, Chester Cajucom-Uy, for the cancellation of registration of the mark "NISSIN (BULLSEYE DEVICE)" bearing Registration No. 4-1982-047840 issued on September 01, 2006 in the name of Respondent-Registrant Sunny Delights (S) PTE. LTD., which covers goods under Class 30, namely, confectionery and bread.

Petitioner is a domestic corporation organized under the laws of the Philippines with principal office place of business at 6750 Building, 6750 Ayala Avenue, Makati City. Respondent-registrant is a foreign corporation with principal office and place of business at 9 Oxlay Rise #02-01 The Oxlay, Singapore 238697.

Petitioner filed its verified petition based on the following grounds:

1. Petitioner is primarily engaged in the business of selling and distributing snack food products bearing the name Nissin and Monde Nissin;
2. Respondent-registrant is the assignee of World Foods Company, Ltd. which has its principal office and place of business at 69 Onoe-sho 5 Chome Naka-ku Yokohama-Shi, Kanagawa-Ken, Japan per assignment of mark dated January 29, 2003 and which assignment was notarized on April 22, 2003 before Wilson Yip, a notary public of Singapore;
3. World Foods Company, Ltd. was formerly known as Nissin Confectionery Co., Ltd.;
4. On September 28, 1979, the mark "Nissin and Bulls Eye Device" was issued Registration No. SR-4255 in the Supplemental Register by the Philippine Patent Office after Application Serial No. SR-5677 was filed on June 14, 1979 by Monde Denmark Nissin Biscuit Corporation which is now succeeded by petitioner;
5. The Supplemental Register issued to petitioner by the then Philippine Patent Office would show that petitioner was the first to actually use said mark in the Philippines;
6. The mark "Nissin and Bulls Eye Device" was used to identify consumable goods falling under Nice Classification Class 30, namely, Butter Cookies, Lemonia Cookies, and Butter Coconuts, and these products were first used in the Philippines on April 03, 1977;

7. Even prior to its registration on September 28, 1979, petitioner has continuously used said mark for a period of more than twenty (20) years;
8. Petitioner has invested time, effort and goodwill in promoting its Butter Cookies, Lemonia Cookies, and Butter Coconut by using said mark and device through advertisements in print and broadcast media;
9. Petitioner has earned a reputation in the Philippines as the manufacturer of superior, quality biscuits over the years of its continuous use of the goods bearing the mark "Nissin and Bulls Eye Device" such that said mark and device are closely identified with products sold in the market by petitioner;
10. Petitioner's mark and device had built the buying public's trust in petitioner's products and it is for this reason that petitioner is enforcing its right to its mark;
11. As part of compliance with the requirements of this Office, petitioner had renewed its application on its fifth, tenth, and fifteenth anniversaries to prove continuous actual use of the mark and device as follows: 1) On the fifth anniversary on September 28, 1984, an affidavit of use was filed on January 16, 1985; 2) On the tenth anniversary on September 28, 1989, an affidavit of use was filed on July 16, 1990; and 3) On the fifteenth anniversary on September 28, 1994, an affidavit of use was filed on May 11, 1995
12. Per records of this Office, it appears that before the fifteenth anniversary date of petitioner's actual use of the mark "Nissin and Bulls Eye Device", respondent-registrant filed an opposition to petitioner's application for registration: The opposition for the mark "Nissin" was docketed in the records of the Bureau of Legal Affairs (BLA) as IPC No. 3356 entitled "Nissin Confectionery Co., Ltd. v. Monde Denmark Nissin Biscuit Corporation";
13. Petitioner and respondent-registrant are the successors-in-interest respectively of Monde Denmark Nissin Biscuit Corporation and Nissin Confectionery Co., Ltd.;
14. Said case was dismissed by the BLA per Order No. 98-09 while petitioner's application was given due course;
15. Upon filing by respondent-registrant of a motion for reconsideration, the case was revived per Order No. 04-714 but due to respondent-registrant's failure to present evidence on its behalf, the case was dismissed for failure to prosecute per Order No. 97-461;
16. On October 29, 1998, the BLA issued Resolution No. 98-09 dismissing respondent-registrant's opposition;
17. Hence, this Office had earlier decided the matter of registration and opposition of the trademark application under Resolution No. 98-09 involving the same parties, and such decision favored petitioner's application by giving due course thereon as elucidated in Order No. 98-09;
18. However, on August 01, 2002, petitioner was notified that the application was declared abandoned as of January 7, 2002 for failure to comply with official action designated as Action Paper No. 2 dated November 6, 2001;
19. On March 26, 2003, this Office issued Revival No. 4-517-03 declaring the revival of the application;

20. Thereafter, Paper No. 06 was issued by the Examiner with mailing date of July 14, 2004, denying petitioner's application considering that the mark "Nissin and Bulls Eye Device" is identical with Application Serial No. 4-1982-047840 which covers goods under Nice Classification Class 30;
21. Final rejection of petitioner's application was issued in Action Paper No. 9 on the grounds that it is identical with a registered mark belonging to a different proprietor with an earlier filing or priority date in respect of the same good and services or close related goods and services, or that petitioner's mark nearly resembles respondent-applicant's mark such that petitioner's mark is likely to deceive or cause confusion;
22. Per records of this Office, respondent-registrant obtained a registration of the mark "NISSIN (BULLSEYE DEVICE)" for a period of twenty (20) years commencing on October 24, 2005 per Certificate of registration dated September 1, 2006 for Nice Classification Class 30;
23. To protect its property rights, petitioner appealed from the Examiner's final rejection per a Notice of Appeal filed with this Office on March 24, 2006;
24. On May 23, 2006 and August 17, 2006, petitioner filed the Appellant's Brief and Reply to the Examiner's Answer;
25. Petitioner submits that the Examiner erred in failing to consider that the mark "NISSIN (BULLSEYE DEVICE)" had been actually and continuously used in the Philippines by petitioner since 1977 and, as such, petitioner had acquired ownership over the mark and device "Nissin Bulls Eye" and has a vested right thereto;
26. Being first to have actually used the mark and device in the Philippines, petitioner has the priority right thereto;
27. Petitioner is filing the instant petition for cancellation against the mark "NISSIN (BULLSEYE DEVICE)" which was found to be identical with a registered mark belonging to a different proprietor and having an earlier filing or priority date under Section 123.1 (d) of the Intellectual Property (IP) Code;
28. While it may be true that Registration No. 41982047840 appears to have been filed in 1982, it could not have claimed priority right in actual use thereof, given the registration in favor of petitioner of its mark "Nissin and Bulls Eye Device" on June 14, 1979;
29. At the time of the filing of Registration No. 41982048740 in 1982, petitioner remains to be the registered owner of the mark "Nissin and Bulls Eye Device" as early as 1979 and having acquired such priority; it is the only entity legally authorized to use the mark from the time of filing of its application for which reason the filing of Registration No. 41982047840 should not prejudice petitioner's right which was acquired as early as 1979 or prior to the effectivity of the IP Code;
30. Petitioner in filing the instant petition is simply enforcing its right to appropriate and use the mark and device which was existing prior to January 1, 1998, the start of the IP Code's effectivity, and based on ownership of the mark and device under Section 2-A. R.A. No. 166;

31. While the Examiner may have ruled that Registration No. 41982047840 was filed first, such filing did not perfect respondent-registrant's right to the subject mark;
32. The earlier rulings of the BLA in Order No. 97-461 and Resolution No. 98-09 show that petitioner's filing date was on June 14, 1979 which is much earlier than respondent-applicant's filing date of the subject mark and, thus, the mark "NISSIN (BULLSEYE DEVICE)" could not have been used at that time by respondent-applicant without infringing petitioner's property rights since only petitioner has the exclusive right to the mark and device since 1979;
33. Among the requirements for the application for registration of the mark is a declaration of actual use which petitioner has filed and from which it can be gleaned that it is petitioner which has precedence in actual and continuous use of the mark "Nissin and Bulls Eye Device" in the Philippines, and it is petitioner, thus, which is more qualified to its registration;
34. While Registration No. 41982047840 was filed in 1982, it cannot be refuted that petitioner was able to obtain registration of its mark and device in 1979, which registration was accompanied by a declaration of actual use even prior to 1979;
35. The mark "Nissin and Bulls Eye Device" could not have been used by the Nissin Confectionery Ltd. three (3) years prior to 1982 since at that time, petitioner is the owner of the registered mark: It was issued a registration for its mark in the Supplemental Register on June 14, 1979;
36. In IPC No. 3356, the registration of petitioner's mark "Nissin and Bulls Eye Device" was given due course per Order No. 97-461 and Resolution No. 98-09, and no appeal was filed by respondent-registrant to said Resolution for which reason said Resolution operates as res judicata to Registration No. 41982047840; and
37. Petitioner submits, thus, that as owner of the mark "Nissin and Bulls Eye Device" with respect to the goods under Nice Classification Class 30, it is the entity which has the right to register the same and which will be greatly damaged if respondent-application's registration is not canceled."

On May 18, 2007, respondent-registrant filed a verified ANSWER TO NOTICE OF OPPOSITION admitting Paragraph 2 of the verified AMENDED PETITION as far as said Paragraph "refers to the Respondent", denying the rest of the allegations, and alleging the following affirmative and special defenses:

- “1. Respondent-registrant's registration of the mark "NISSIN (BULLSEYE DEVICE)" under Certificate of Registration No. 41982047840 issued on September 01, 2006 for confectionery and bread under Class 30 is a valid and effective registration of said mark for which reason all the rights and privileges of a registered owner of a mark so duly registered under Section 147 and other pertinent provisions of the Intellectual Property (IP) Code and all laws pertaining thereto including those constituted through rulings of the Supreme Court are protected for the following reasons:
 - a. Respondent-registrant is the first to file and register the subject mark for which reason all other pretenders thereto as to its ownership are disqualified to claim ownership over said mark;

b. Respondent-registrant's mark is an internationally well-known mark not only in the Philippines but also in various countries of the world including the Philippines as the mark is a foreign word and the goods it represents are globally marketed unlike that of petitioner's mark and goods;

c. Petitioner uses, albeit in bad faith, respondent-registrant's mark in the Philippines with the obvious purpose of misleading the buying public to believe that petitioner's mark is the same as respondent-registrant's mark and that petitioner's mark is used on respondent-registrant's good quality biscuits and buttered cookie products, thereby betraying petitioner's intent to play public to the damage and prejudice of said buying public and respondent-registrant's proprietary rights and interest over its well-known mark;

d. Petitioner's alleged claim over its mark is based on an unfounded and alleged registration in the Supplemental Register which has been made obsolete and defunct, and discarded by operation of law; and

e. Petitioner's claims of registration and use pursuant to the defunct Supplemental Register can be said to be in bad faith: Such claims are totally without weight and evidentiary value, and in total violation of the rights and interests of respondent-applicant over its mark, the ownership over which cannot be assailed by the very party which had long violated respondent-applicant's proprietary rights and interests over the subject mark;

2. The petition is now barred by laches, estoppel, and acquiescence under Section 230 of the IP Code for failure to contest respondent-registrant's application and commercial use prior to the issuance of the Certificate of Registration; and

3. The petition is only an afterthought on petitioner's part after the Certificate of Registration had understandably and duly issued by the IP Philippines, and petitioner has obviously no cause of action against respondent-registrant and its Certificate of Registration for which reason the petition must be dismissed or denied."

On June 14, 2007, petitioner filed a REPLY, alleging the following among others:

"1. Respondent-registrant's clam that Certificate of Registration No. 41982047840 is a valid and effective registration of the subject mark should not be given credence in view of Section 124.2 of the IP Code;

2. In its ANSWER TO NOTICE OF OPPOSITION, respondent-registrant has neither proved nor presented any proof of actual use of its mark such as the declaration of actual use within 3 years from the filing date of the application which respondent-registrant alleged to be in 1982;

3. Failing such, respondent-registrant's mark, therefore, should have been refused or removed from the register considering respondent-applicant's failure to produce proof that it actually used the mark prior to registration;

4. Respondent-registrant's claim that it is the first to file and register the mark in question should be brushed aside considering that petitioner was first to

register the mark in 1979, and has proven that it has actually used the mark even prior to 1979;

5. While respondent-applicant had claimed that it is an international trademark and known not only in the Philippines, it has not submitted any proof supporting this claim: Respondent-applicant had not established in its ANSWER TO NOTICE OF OPPOSITION that it passed the Criteria for the Determination of Whether the Mark is a Well-Known Mark as provided under Rule 102 of the Rules on Trademarks, Trade Names and Marked or Stamped Containers (Trademark Rules);

6. Contrary to respondent-registrant's assertions, petitioner had never used the mark "Nissin and Bulls Eye Device" in bad faith, and in fact, petitioner had been using said mark as owner in good faith: Petitioner has earned a reputation in the Philippines as the manufacturer of superior quality biscuits over the years of its continuous use of the goods bearing said mark that said mark is now closely identified with the products sold in the market by petitioner;

7. There can be no truth to respondent-registrant's claim that it was prejudiced and damaged by petitioner's use of the mark "Nissin and Bulls Eye Device" for if it were true, it is ridiculous that respondent-registrant had not initiated or actively pursued any legal action against petitioner questioning its use of the mark which had been ongoing for a continuous period of more than 20 years;

8. It is not true that petitioner's ownership is based merely on an unfounded registration because if it were true as respondent-registrant claims that petitioner had made the registration in the supplemental register in bad faith, respondent-registrant had not asserted its right by filing the appropriate action;

9. Respondent-registrant's claim that petitioner is barred by laches, estoppel, and acquiescence for failure to contest respondent-registrant's application prior to the issuance of the Certificate of Registration is untrue considering that petitioner had appealed from the final rejection by the Examiner of its application of the mark "Nissin and Bulls Eye Device";

10. The nature of the proceedings before the Examiner in an application for registration is *ex-parte* as provided for by Rule 600, Part 6 of the Trademark Rules and being such, the failure to file an opposition to the registration does not ipso facto mean acquiescence on petitioner's part and it is for this reason that the instant petition is being filed since petitioner is asserting its vested right of ownership over the mark "Nissin and Bulls Eye Device";

11. Assuming without admitting that respondent-registrant has the right to the subject mark, it is the party that should be barred by laches, estoppel, and acquiescence as it did not initiate any action against petitioner for the use and registration of the mark since 1977 which only shows that respondent-applicant itself recognizes petitioner's right to the mark "Nissin and Bulls Eye Device"; and

12. Petitioner submits that its application for registration for the mark "Nissin and Bulls Eye Device" is still being pursued by it: The BLA suspended final proceedings therein in deference to the final resolution of this case."

Preliminary conference was initially set on July 04, 2007 and was terminated on September 03, 2007. Order No. 2007-1674 was issued requiring the parties to submit their respective position papers within a non-extendible period of ten (10) days from receipt of their respective copies of said Order. Petitioner received its copy of the Order on September 18, 2007

and filed its position paper on October 4, 2007 while respondent-registrant received its copy of the Order on September 18, 2007 and filed its position paper on September 27, 2007. The case is now deemed submitted for decision.

There is no dispute that petitioner's and respondent-registrant's respective marks are virtually identical.

Petitioner's mark "Nissin and Bulls Eye Device" is depicted below:



Meanwhile, respondent-registrant's mark is depicted below:



Both marks consists of the following: The word "NISSIN" with uppercase letters in Arial-like fonts except for the stylized font of the two letters "S"; the downward stroke of the first letter "N" which forms into a counterclockwise circle; and concentric circles inside the counterclockwise circle which enclose a dark circle or a "bull's eye" device.

There is no dispute, too, that the marks of both parties are used on similar and related goods that fall also under the same class: cookies for petitioner, specifically, butter cookies, lemonia cookies, and butter coconuts; and confectionery and bread for respondent-registrant, all of which fall under Class 30.

Having ruled, thus, the similarity of both marks as well as the similarity or relatedness of the goods to which both marks are used, this Bureau shall now discuss and rule upon the following issues:

1. Who between petitioner and respondent-registrant had prior use of the mark "NISSIN (BULLSEYE DEVICE)" / "Nissin and Bulls Eye Device";
2. Whether petitioner abandoned its mark "Nissin and Bulls Eye Device" when it failed to comply with the Action Paper No. 2 dated November 6, 2001 issued by the Bureau of Trademarks (BOT);
3. Who between petitioner and respondent-registrant has a better right to the mark "NISSIN (BULLSEYE DEVICE)" / "Nissin and Bulls Eye Device"; and
4. Whether there is ground to cancel respondent-registrant's mark "NISSIN (BULLSEYE DEVICE)".

Records show that petitioner's predecessor-assignor, Monde Denmark Nissin Biscuit Corporation, filed an application for, and was granted, registration under the Supplemental

Register for the mark "Nissin and Bulls Eye Device" for butter cookies, lemonia cookies, and butter coconuts under Class 30, which registration denominated as Registration No. 4255 (Serial No. SR-425) was issued on September 28, 1979. Said predecessor-assignor filed affidavits of use within one year following the fifth, tenth, and fifteenth anniversaries of the date of issue of Registration No. 4255 (Serial No. SR-4255): The fifth anniversary of the date of issue of Registration No. 4255 (Serial No. SR-4255) was on September 28, 1984 and an affidavit of use was filed on January 16, 1985; the tenth anniversary of the date of issue of said registration was on September 28, 1989 and an affidavit of use was filed on July 16, 1990; and the fifteenth anniversary of the date of issue of said registration was on September 28, 1994 and an affidavit of use was filed on May 11, 1995.

Records further show that petitioner's predecessor-assignor Monde Denmark Nissin Biscuit Corporation filed on March 17, 2000 an application for registration of the same mark "Nissin and Bulls Eye Device" denominated as Application Serial No. 4-2000-02098 for butter cookies, lemonia cookies, and butter coconuts under Class 30.

It is to be noted that the application for registration as well as the registration in the Supplemental Register by petitioner's predecessor-assignor Monde Denmark Nissin Biscuit Corporation for the mark "Nissin and Bulls Eye Device" for butter cookies, lemonia cookies, and butter coconuts under Class 30 was during the effectivity of R.A. No. 166, the old Trademarks Law.

Pursuant to Section 20 of R.A. No. 166 and Section 2 of Rule 130 of the Rules on Evidence, a *prima facie* presumption was created that petitioner, by virtue of its predecessor-assignor Monde Denmark Nissin Biscuit Corporation, is the owner of the mark "Nissin and Bulls Eye Device" for butter cookies, lemonia cookies, and butter coconuts under Class 30; that petitioner has the exclusive right to use said mark in butter cookies, lemonia cookies, and butter coconuts under Class 30 subject to the conditions and limitations stated therein; and that petitioner had actual use of said mark from April 03, 1977 and continuously onwards.

This question now arises: Did petitioner's predecessor-assignor Monde Denmark Nissin Biscuit Corporation abandon the mark "Nissin and Bulls Eye Device" for butter cookies, lemonia cookies, and butter coconuts under Class 30 as of January 07, 2002 for failure to comply with BOT's official action designated as Action Paper No. 2 dated November 06, 2001 which directed petitioner's predecessor-assignor Monde Denmark Nissin Biscuit Corporation to submit formal drawings and facsimiles representing the mark and to submit a written statement that it is a small entity, such that the continuous use of said mark since April 03, 1977 by said predecessor-assignor ceased on January 07, 2002; such that petitioner's trademark right to said mark lost; and such that, as a consequence, it opened the mark to appropriation or adoption by others?

This Bureau finds that petitioner's predecessor-assignor did not abandon the mark "Nissin and Bulls Eye Device" as of January 07, 2002 when it failed to comply with official action designated as Action Paper No. 2 dated November 6, 2001.

To work as an abandonment, the disuse must be permanent and not ephemeral; it must be intentional and voluntary, and not involuntary or even compulsory. There must be a thoroughgoing discontinuance of any trademark use of the mark in question (*Romero v. Maiden Form Brassieres Co., Inc.* 10 SCRA 556 [1964] and *Philippine Nut Industry v. Standard Brands Inc.* 65 SCRA 575, 587 [1975], citing *Callman, Unfair Competition and Trademark*, 2nd Ed.). To establish the defense of abandonment, it is necessary to show not only the acts indicating practical abandonment, but an actual intention to abandon (*Klehner v. Eisener & Mendelson Budweiser Malt Products Corp.*, 287 F. 245.). In the case at bench, it appears that petitioner's predecessor-assignor Monde Denmark Nissin Biscuit Corporation was not able to timely respond to the BOT's official action designated as Paper No. 2 dated November 06, 2001 in regard to Application Serial No. 4-2000-02098 filed on March 17, 2000 for the mark "Nissin and Bulls Eye Device" which directed it to submit formal drawings and facsimiles representing the mark and to submit a written statement that it is a small entity, as the same was mailed only on January 14, 2002

though the "Notice of Abandoned Application" sent to petitioner's predecessor-assignor Monde Denmark Nissin Biscuit Corporation indicated that the "abandonment" became effective on January 07, 2002 (Underscoring supplied). It is illogical and impossible for petitioner's predecessor-assignor Monde Denmark Nissin Biscuit Corporation to have complied with the directive in Paper No. 2 before January 07, 2002 as mailed only on January 14, 2002 of after it was declared to have "abandoned" its application. Thus, there is no abandonment by petitioner's predecessor-assignor Monde Denmark Nissin Biscuit Corporation. Moreover, the following acts on the part of petitioner's predecessor-assignor Monde Denmark Nissin Biscuit Corporation after it received a copy of the "Notice of Abandoned Application" belie abandonment on its part: 1) It failed a PETITION FOR REVIVAL OF AN ABANDONED APPLICATION which was granted per Order Revival No. 4-517-03, declaring the application revived and remanding it to the examiner for further appropriate action; and 2) It filed a NOTICE OF APPEAL on March 24, 2006, appealing the examiner's final rejection of its Application Serial No. 4-2000-02098 filed on March 17, 2000 for the mark "Nissin and Bulls Eye Device" (Paper No. 9, FINAL REJECTION dated January 06, 2006).

Records show that Application Serial No. 4-2000-02098 filed on March 17, 2000 for the mark "Nissin and Bulls Eye Device" was rejected for the reason that registration of said mark in the name of petitioner's predecessor-assignor Monde Denmark Nissin Biscuit Corporation is contrary to Section 123.1 (d) of the Intellectual Property (IP) Code (Paper No. 9, FINAL REJECTION dated January 06, 2006). It appears that this ruling stems from the fact that respondent-registrant applied for registration of the subject mark "NISSIN (BULLSEYE DEVICE)" on March 29, 1982 denominated as Application Serial No. 4-1982-047840 for butter cookies, lemonia cookies, and butter coconuts under Class 30.

While it may be true that petitioner's Registration No. 4255 (Serial No. SR-5677) for the mark "Nissin and Bulls Eye Device" was registered, not in the Principal Register, but in the Supplemental Register during the effectivity of R.A. No. 166, and that petitioner applied for the same mark during the effectivity of the IP Code on March 17, 2000 per Application Serial No. 4-2000-02098 while respondent-registrant applied for registration of the subject mark "NISSIN (BULLSEYE DEVICE)" on March 29, 1982 denominated as Application Serial No. 4-1982-047840, both for Class 30 goods, making respondent-registrant's application during the effectivity of the IP Code earlier than petitioner's application, it cannot be denied that petitioner had and has use of the mark "Nissin and Bulls Eye Device" prior to respondent-registrant, specifically since April 03, 1977, as evidenced by the Certificate of Registration No. 4255 (SR-5677) in the Supplemental Register, which prior use is the act that establishes one's ownership over the mark to the exclusion of others pursuant to R.A. No. 166, the law in effect at the time such registration in the Supplemental Register was issued. This is a *prima facie* presumption that has not been overturned by respondent-registrant through contrary evidence. Moreover, such prior use continued even at the time respondent-registrant filed on March 29, 1982 its Application Serial No. 4-2000-02098 for the subject mark "NISSIN (BULLSEYE DEVICE)" for Class 30 goods, as it has been earlier ruled herein that there was no abandonment of the mark. Albeit effective January 07, 2002, contrary to the finding of the Bureau of Trademarks (BOT). Finally, finding of the Bureau of Trademarks (BOT) pertains only to an abandonment of the application due to alleged non-compliance of an official action but NOT the abandonment of the actual use of the mark which is the basis for acquiring ownership thereof. Thus, though respondent-registrant first filed its application for registration of the subject mark in the Principal Register on March 29, 1982 while petitioner filed an application for registration of its mark "Nissin and Bulls Eye Device" on March 17, 2000 under the IP Code (Considering that the term of petitioner's registration in the Supplemental Register was only until September 28, 1999 pursuant to Section 3.7.1 of the *Rules On Trademarks, Service Marks, Trade Names and Marked Or Stamped Containers*), it has been established that petitioner has prior use of the mark "Nissin and Bulls Eye Device" to which respondent-registrant's mark "NISSIN (BULLSEYE DEVICE)" is confusingly similar, which prior and continuous use is the act that gives petitioner ownership and a better right over the mark "Nissin and Bulls Eye Device". Under R.A. No. 166 pursuant to which petitioner's application for registration of the mark "Nissin and Bulls Eye Device" for Class 30 goods was filed and pursuant to which registration in the Supplemental Register was made, prior use, not the act of first-to-file,

is the determining factor in weighing who owns and, thus, who has a better right to, the mark (Section 4(f), 12, and 15 of R.A. No. 166). In this case, thus, petitioner has a better right to and is the owner of the mark "Nissin and Bulls Eye Device" to which respondent-registrant's mark is confusingly similar.

As to the first issue, thus, petitioner had prior use of the mark "NISSIN (BULLSEYE DEVICE)" / "Nissin and Bulls Eye Device" and therefore has a better right to the mark NISSIN (Bullseye Device) over Respondent-Registrant. As to the second issue, petitioner did not abandon its mark "Nissin and Bulls Eye Device" when it failed to comply with the BOT's Action Paper No. 2 dated November 6, 2001. As to the third issue, petitioner has a better right to the mark "Nissin and Bulls Eye Device". As to the fourth issue, thus, there is ground to cancel respondent-registrant's mark "NISSIN (BULLSEYE DEVICE)".

WHEREFORE, premises considered, the verified AMENDED PETITION for cancellation is, as it is, hereby GRANTED. Consequently, Registration No. 4-1982-047840 for the mark "NISSIN (BULLSEYE DEVICE)" issued on September 01, 2006 in the name of Respondent-Registrant Sunny Delights (S) PTE. LTD., which covers goods under Class 30, namely, confectionery and bread is, as it is hereby, CANCELLED.

Let the filewrapper of this case be forwarded to the Bureau of Trademarks (BOT) for appropriate action in accordance with this Decision.

SO ORDERED.

Makati City, December 19, 2008.

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