

MYOJYO RUBBER INDUSTRY,
CO., LTD.,

Petitioner,

- versus-

RAMCHAND S. SADHWANI
Respondent-Registrant.

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INTER PARTES CASE NO. 1417
Petition for Cancellation

Reg. No.25861
Issued: March 30, 1978
Trademark: "MIKASA"

DECISION NO. 97-17

DECISION

This is a Petition filed by Petitioner Myojyo Rubber Industry Co., Ltd., for the Cancellation of the trademark "MIKASA" Certificate of Registration No. 25861 for sporting goods, basketball, volleyball, softball, and gloves issued on March 30, 1978 in favor of Ramchand S. Sadhwani.

Petitioner is a corporation duly organized and existing under the laws of Japan, with principal Office at 11-2, 3-Chome, Kusunoki-cho Hiroshima 733, Japan.

Whereas, Respondent-Registrant, Ramchand Satramdas Sadhwani, Filipino citizen, is the Registrant of the trademark "MIKASA" under Certificate of Registration No. 25861, with business address at 100 (interior) Campos Rueda Building, Tindalo Street, Makati City.

The grounds for the Petition for Cancellation are as follows:

- "1. Petitioner possesses exclusive and worldwide rights, title and interest in and to the "MIKASA" trademark by virtue of its indisputable ownership and prior use or appropriation thereof;
2. The continued registration of the "MIKASA" trademark in the name of Respondent-Registrant will only aggravate the worsening confusion and deception presently plaguing the local market as to the source and origin of Respondent's goods to the continuing damages and prejudice of Petitioner."

Petitioner relied on the following facts to support its petition:

"1. Petitioner is a corporation duly organized and existing in accordance with the laws of Japan, with principal office address at 11-2, 3-Chome, Kusunoki-Cho Hiroshima 733 Japan.

"2. Petitioner is the owner and rightful proprietor of the internationally known MIKASA trademark covering various articles used for different sports such as leather and rubber balls for basketball, volleyball, soccer, football, handball, waterpolo and the like. As such owner and rightful proprietor of the MIKASA trademark, petitioner has effected the registration of the same in Japan and several other countries, In the Philippines, petitioner has a pending application for registration with this Honorable Office under Serial No. 23981.

"3. Petitioner and its MIKASA trademark enjoy a fine and unblemished reputation all over the world in view of the unparalleled quality of petitioner's goods covered by said mark. In recognition of this worldwide reputation, the MIKASA basketball was chosen as the exclusive official ball for the following world events, among others: the 1964 Tokyo Olympic Games, the 1968 Mexico City Olympic Games, the 1972 Munich Olympic Games, the 1974 VII Men's World Championships held in Puerto Rico, the 1978 VIII

Men's World Championships staged in the Philippines, etc. For the 1980 Olympics to be hosted by Moscow, Russia, petitioner was again selected as the exclusive supplier of the sports equipment to be used for the games. A list of these international events is attached hereto as Annex "A".

"4. Although the goods of petitioner are exclusively manufactured in Hiroshima, Japan, they are being marketed and sold in many parts of the world and in major cities, including Manila.

"5. For some period of time, respondent, with full knowledge of petitioner's ownership and prior and continuous use of the MIKASA trademark and for the purpose of taking full and undue advantage of the name and reputation which have been identified with petitioner and the MIKASA trademark worldwide through the years, has engaged and continuous to engage in the manufacture and/or sale of goods bearing the MIKASA trademark and passing them off as petitioner's products.

"6. To complete the scheme and in an obvious attempt to provide some semblance of legality to its unauthorized acts, respondent effected the registration of the MIKASA trademark by falsely declaring and misrepresenting that it owns said mark and has priority in the use and appropriation thereof.

"7. In so doing, respondent has unduly prejudiced and infringed upon the reputation of petitioner as the owners and rightful proprietor of the MIKASA trademark in terms of the identifying significance gained and developed through the years and for which petitioner deserves protection in law and the convention.

"8. Inasmuch as respondent's goods are of the same type and nature as those of petitioner, its unauthorized acts are calculated to deceive the public into believing that the goods sold by respondent are made, approved and sponsored by, or affiliated with, petitioner. The aforesaid acts of applicant constitute unfair competition in that they are calculated to and do result in the unjust enrichment of respondent since respondent is unfairly trading upon and appropriating the reputation and goodwill of petitioner as represented by the MIKASA trademark and is imposing widespread fraud and deception upon the public".

Respondent-Registrant filed its Answer to Petition for Cancellation on January 22, 1981.

In its answer, Respondent-Registrant alleged that it was the first user of the, trademark "MIKASA" by virtue of Certificate of Registration No. 25864, issued in its favor on March 20, 1978. It also alleged that IPC No. 767, this Office found that Respondent had proven himself to have a better right to the ownership of the mark "MIKASA", and he had not committed any act which constitutes infringement of trademark. Since the Decision in IPC No. 767 had become final, Petitioner's action in the present case had no legal basis under the Doctrine of RES JUDICATA.

Issues having been joined, this case was set for pre-trial conference between the parties. However, before trial on the merits could be conducted, Petitioner obtained a judgment in its favor in Civil Case No. 37504 entitled Myojyo Rubber Ind., Co. Ltd. vs. Ramchand Satramdas Sadhwani for Unfair Competition, in the Court of First Instance of Rizal, Makati, Metro Manila on May 12, 1981 (Annex A). The dispositive portion of the decision of the Court through the presiding Judge, Hon Segundo M. Zosa is as follows:

"WHEREFORE, premises considered, Order is hereby issued:

"1. Denying plaintiffs motion to cite defendant for contempt of court;

"2. Declaring the defendant guilty of unfair competition and consequently enjoining him from:

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"a. Selling, marketing, distributing, exporting, advertising, offering for sale, or procuring to be sold or otherwise disposing of any article under the mark "MIKASA" or any other mark, word, name or device which by colorable imitation or otherwise unfairly competing with plaintiff;

"b. Selling, distributing, sporting, advertising, offering for sale, procuring to be sold, or otherwise disposing of any article described as purporting to be manufactured by the plaintiff or an alleged authorized license of plaintiff in labels, symbols, and/or wrappers so contrived or expressed as, by colorable imitation or otherwise, to represent the products sold by the defendant to be the same as that manufactured and sold by plaintiff;

"c. Directly or indirectly using any marks, or doing any acts or things likely to indicate the belief on the part of the public that defendant or defendant's products are in any way connected with plaintiffs or plaintiff's products;

"3. Directing the Philippine Patent Office and its officers to cancel Registration No. 25864 and ALL registrations of defendant bearing the trademark "MIKASA" for being contrary to law."

Petitioner by virtue of the Orders dated 4 May 1981 and 14 July 1981 and Writ of Execution dated 17 July 1981 issued by the then Court of First Instance of Rizal Branch XXVI, Makati, Metro Manila, and pursuant to SECTION 25 of R.A. No. 166 prayed that Certificate of Registration No. 25861 in the name of RAMCHAND SATRAMDAS SADHWANI for the trademark as well as all other Certificate of Registrations, including subject Certificate of Registration No. 25861 be cancelled.

The issue in this case is whether the above mentioned Orders dated 4 May and 14 July 1981 and the Writ of Execution dated 17 July 1981 the Court of First Instance of Rizal, Branch XXVII, could be a sufficient ground to cancel Regn. No. 25861, subject matter of the instant case.

The Petitioner's cause of action is meritorious. The Decision secured by Petitioner in its favor, in Civil Case No. 37504 against Respondent-Registrant for "UNFAIR COMPETITION" is given cognizance by this Bureau under Section 25 of R.A. No. 166 as amended which provides:

"SEC. 25. Authority to determine right to registration. In any action involving a registered mark or trade name the court may determine the right to registration, order the cancellation of registration, in whole or in part, restore cancelled registration, and otherwise rectify the register with respect to the registration of any part to the action. Judgment and orders shall be certified by the Court to the Director, who shall make appropriate entry upon the records of the Patent Office, and shall be controlled thereby.

WHEREFORE, in view of the foregoing premises, this Petition for Cancellation is as it is hereby GRANTED in view of the Decision rendered by the Court of First Instance in Civil Case No. 3704... Accordingly, Certificate of Registration No. 25861 issued on March 30, 1978 in favor of Respondent-Registrant for the trademark "MIKASA" for use on sporting goods, basketball, volleyball, softball and gloves is, as it is hereby ordered CANCELLED from the Principal Register.

Let the filewrapper of this case be forwarded to the Patents/Trademarks Registry and EDP Division for appropriate action in accordance with this Decision furnishing a copy thereof to the Trademark Examining Division for information and to update its records.

SO ORDERED.

Makati City, November 03, 1997.

EMMA C. FRANCISCO
Director