

Republic of the Philippines
SUPREME COURT
Manila

EN BANC

G.R. No. L-18289 March 31, 1964

ANDRES ROMERO, petitioner,

vs.

MAIDEN FORM BRASSIERE CO., INC., and THE DIRECTOR OF PATENTS, respondents.

Alafriz Law Office for petitioner.

Ross, Selph & Carrascoso for respondent Maiden Form Brassiere Co., Inc.

Office of the Solicitor General and Tiburcio S. Evalle for respondent Director of Patents.

BARRERA, J.:

From the decision of the Director of Patents (of January 17, 1961) dismissing his petition for cancellation of the registration of the trademark "Adagio" for brassieres manufactured by respondent Maiden Form Brassiere Co., Inc., petitioner Andres Romero, interposed this appeal.

On February 12, 1957, respondent company, a foreign corporation, filed with respondent Director of Patents an application for registration (pursuant to Republic Act No. 166) of the trademark "Adagio" for the brassieres manufactured by it. In its application, respondent company alleged that said trademark was first used by it in the United States on October 26, 1937, and in the Philippines on August 31, 1946; that it had been continuously used by it in trade in, or with the Philippines for over 10 years; that said trademark "is on the date of this application, actually used by respondent company on the following goods, classified according to the official classification of goods (Rule 82) - Brassieres, Class 40"; and that said trademark is applied or affixed by respondent to the goods by placing thereon a woven label on which the trademark is shown.

Acting on said application, respondent Director, on August 13, 1957, approved for publication in the Official Gazette said trademark of respondent company, in accordance with Section 7 of Republic Act No. 166 (Trademark Law), having found, *inter alia*, that said trademark is "a fanciful and arbitrary use of a foreign word adopted by applicant as a trademark for its product; that it is neither a surname nor a geographical term, nor any that comes within the purview of Section 4 of Republic Act No. 166; and that the mark as used by respondent company convincingly shows that it identifies and distinguishes respondent company's goods from others."

On October 17, 1957, respondent Director issued to respondent company a certificate of registration of with, trademark "Adagio".

On February 26, 1958, petitioner filed with respondent Director a petition for cancellation of said trademark, on the grounds that it is a common descriptive name of an article or substance on which the patent has expired; that its registration was obtained fraudulently or contrary to the provisions of Section 4, Chapter II of Republic Act No. 166; and that the application for its registration was not filed in accordance with the provisions of Section 37, Chapter XI of the same Act. Petitioner also alleged that said trademark has not become distinctive of respondent company's goods or business; that it has been used by respondent company to classify the goods (the brassieres) manufactured by it, in the same manner as petitioner uses the same; that said trademark has been used by petitioner for almost 6 years; that it has become a common descriptive name; and that it is not registered in accordance with the requirements of Section 37(a), Chapter XI of Republic Act No. 166.

Issues having been joined, the case was heard and, after hearing, respondent Director (on January 17, 1961) rendered the decision above adverted to.

Petitioner filed a motion for reconsideration of said decision, on the grounds that (1) it is contrary to the evidence, and (2) it is contrary to law. Said motion was denied by respondent Director by resolution of March 7, 1961.

Hence, this appeal.

Appellant claims that the trademark "Adagio" has become a common descriptive name of a particular style of brassiere and is, therefore, unregistrable. It is urged that said trademark had been used by local brassiere manufacturers since 1948, without objection on the part of respondent company.

This claim is without basis in fact. The evidence shows that the trademark "Adagio" is a musical term, which means slowly or in an easy manner, and was used as a trademark by the owners thereof (the Rosenthals of Maiden Form Co., New York) because they are musically inclined. Being a musical term, it is used in an arbitrary (fanciful) sense as a trademark for brassieres manufactured by respondent company. It also appears that respondent company has, likewise, adopted other musical terms such as "Etude" (Exh. W-2), "Chansonette" (Exh. W-3), "Prelude" (Exh. W-4), "Over-ture" (Exh. W-6), and "Concerto" (Exh. V), to identify, as a trademark, the different styles or types of its brassieres. As respondent Director pointed out, "the fact that said mark is used also to designate a particular style of brassiere, does not affect its registrability as a trademark" (*Kiekhaefer Corp. v. Willys-Overland Motors, Inc.*, 111 USPQ 105). *1äwphĩ1.ñët*

It is not true that respondent company did not object to the use of said trademark by petitioner and other local brassiere manufacturers. The records show that respondent company's agent, Mr. Schwartz, warned the Valleson Department Store to desist from the sale of the "Adagio" Royal Form brassieres manufactured by petitioner (t.s.n., pp. 27-28, Oct. 7, 1958), and even placed an advertisement (Exhs. 3 & 4) in the local newspapers (Manila Daily Bulletin, Manila Times, Fookien Times, and others) warning the public against unlawful use of said trademark (t.s.n., p. 15, Aug. 17, 1959). The advertisement (Exh. U) in the Manila Times made by respondent company on February 9, 1958, was brought to petitioner's attention (t.s.n., p. 24, Oct. 7, 1958), which must have prompted him to file this present petition for cancellation, on February 26, 1958.

On the other hand, respondent company's long and continuous use of the trademark "Adagio" has not rendered it merely descriptive of the product. In *Winthrop Chemical Co. v. Blackman* (268 NYS 653), it was held that widespread dissemination does not justify the defendants in the use of the trademark.

Veronal has been widely sold in this country by the plaintiff; over 5,250,000 packages have been sold since 1919. This is a consequence of the long and continued use by the plaintiff of this trademark and is the result of its efforts to inform the profession and the public of its product. This widespread dissemination does not justify the defendants in the use of this trademark. If this argument were sound, then every time a plaintiff obtained the result of having the public purchase its article, that fact of itself would destroy a trademark. Arbitrary trademarks cannot become generic in this way. *Jacobs v. Beecham*, 221 U.S. 263, 31 S. Ct. 555, 55 L. Ed. 729; *Coca-Cola Co. v. Koke Co. of American*, 254 U.S. 143, 41 S. Ct. 113, 65 L. Ed. 189. (emphasis supplied.)

Appellant next contends that the trademark "Adagio" at the time it was registered (in the Philippines) on October 17, 1957, had long been used by respondent company, only "to designate a particular style or quality of brassiere and, therefore, is unregistrable as a trademark. In support of the contention, he alleges that the sentence "Maidenform bras are packaged for your quick shopping convenience. For other popular Maidenform styles writ for free style booklet to: Maiden Form Brassiere Co., Inc 200 Madison Avenue, New York 16, N.Y." printed on the

package (Exh. W), shows that the trademark "Adagio" is used to designate a particular style or quality of brassiere. He also cites portions of the testimonies of his witnesses Bautista and Barro, to the effect that said trademark refers to the style of brassieres sold in the stores of which they are salesmen.

This contention is untenable. Said sentence appearing on the package (Exh. W), standing alone, does not conclusively indicate that the trademark "Adagio" is merely a style of brassiere. The testimony of Mr. Schwartz, witness of respondent company, belies petitioner's claim:

Q. There is a statement at the bottom of Exhibit W which reads, 'There is a Maidenform for every type of figure'. As you stated you are very familiar with these bras manufacture by Maidenform Brassiere Company, what are these types of figures this Exhibit W refer to?

A. This is a product sold primarily in the United States they have cold climate there, and a style to suit the climate and we have different here. This kind of bra very seldom comes here. This type is very expensive and sold primarily in the United States. We do not sell it here; it is very expensive and import restrictions do not allow our dollar allocations for such sort.

As to the testimonies of Bautista and Barro, they are mere conclusions of said witnesses. Note that when Bautista was asked why he considered the trademark "Adagio" as a style, he replied that the brand "Adagio" is attached distinguish the style. He stated as follows:

Q. You said that those bras mentioned by you such as Adagio, Prelude, Alloette, are styles, will you please tell us the reason why you said that those are styles?

A. You know his brand like Adagio, Alloette are just attached to the bras just to distinguish the style: It is not the main brand.

Barro, on the other hand, said that "Adagio" is a mark. She declared as follows:

Q. You state that you used to sell brassieres in the store in which you work; when customers come to your store and ask for brassieres, what do they usually ask from you?

A. Well, I tell you there are so many types and certain types of people ask for certain brassiere. There are people who ask for Royal Form Adagio and there are others who ask for Duchess Ideal Form, and so many kinds of marks.

Brassieres are usually of different types or styles, and appellee has used different trademarks for every type as shown by its labels, Exhibits W-2 (Etude), W-3 (Chansonette), W-4 (Prelude), W-5 (Maidenette), and W-6, (Overture). The mere fact that Appellee uses "Adagio" for one type or style, does not affect the validity of such word as a trademark. In the case of Kiekhaefer Corp. v. Willys-Overland Motors, 111 USPQ 105, it was held that the fact that the word "Hurricane" was used to designate only one model of automobile, did not affect the validity of that word as a trademark. In Minnesota Mining Co. v. Motloid Co., 74 USPQ 235, the applicant sought to register the letters "MM" in diagonal relationship within a circle. Applicant admitted that this mark was used only for its medium price and medium quality denture-base materials. The Assistant Commissioner of Patents held:

It clearly appears, however, that the mark serves to indicate origin of applicant's goods; and the fact that it is used on only one of several types or grades does not affect its registrability as a trade mark.

Appellant also claims that respondent Director erred in registering the trademark in question, despite appellee's non-compliance with Section 37, paragraphs 1 and 4 (a) of Republic Act No. 166.

This contention flows from a misconception of the application for registration of trademark of respondent. As we see it, respondent's application was filed under the provisions of Section 2 of Republic Act No. 166 as amended by Section 1 of Republic Act 865 which reads as follows:

"SEC. 2. What are registrable — Trademarks, ... own by persons, corporations, partnerships or associations domiciled ... in any foreign country may be registered in accordance with the provisions of this Act: *Provided*, That said trademarks, trade-names, or service marks are actually in use in commerce and services not less than two months in the Philippines before the time the applications for registration are filed: ..."

Section 37 of Republic Act No. 166 can be availed of only where the Philippines is a party to an international convention or treaty relating to trademarks, in which the trade-mark sought to be registered need not be use in the Philippines. The applicability of Section 37 has been commented on by the Director of Patents, in this wise:

Trademark rights in the Philippines, without actual use the trademark in this country can, of course, be created artificially by means of a treaty or convention with another country or countries. Section 37 of the present Philippine Trademark Law, Republic Act No. 166 (incorporated as Rule 82 in the Rules of Practice for Registration of Trademarks) envisions the eventual entrance of the Philippines into such convention treaty. It is provided in said section that applications filed thereunder need not allege use in the Philippines of the trade mark sought to be registered. The Philippines has, however not yet entered into any such treaty or convention and, until she does, actual use in the Philippines of the trademark sought to be registered and allegation in the application of such fact, will be required in all applications for original or renewal registration submitted to the Philippine Patent Office. (Circular Release No. 8.)

Appellant, likewise, contends that the registration the trademark in question was fraudulent or contrary Section 4 of Republic Act No. 166. There is no evidence to show that the registration of the trademark "Adagio" was obtained fraudulently by appellee. The evidence record shows, on the other hand, that the trademark "Adagio" was first exclusively in the Philippines by a appellee in the year 1932. There being no evidence of use of the mark by others before 1932, or that appellee abandoned use thereof, the registration of the mark was made in accordance with the Trademark Law. Granting that appellant used the mark when appellee stopped using it during the period of time that the Government imposed restrictions on importation of respondent's brassiere bearing the trademark, such temporary non-use did not affect the rights of appellee because it was occasioned by government restrictions and was not permanent, intentional, and voluntary.

To work 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 thorough-going discontinuance of any trade-mark use of the mark in question (Callman, *Unfair Competition and Trademark*, 2nd Ed., p. 1341).

The use of the trademark by other manufacturers did not indicate an intention on the part of appellee to abandon it.

"The instances of the use by others of the term 'Budweiser, cited by the defendant, fail, even when liberally construed, to indicate an intention upon the part of the complainant to abandon its rights to that name. 'To establish the defense of abandonment, it is necessary to show not only acts indicating a practical abandonment, but an actual intention to abandon. *Saxlehner v. Eisener & Mendelson Co.*, 179 U.S. 19, 21 S. Ct. 7 (45 L. Ed. 60). (*Anheuser-Busch, Inc. v. Budweiser Malt Products Corp.*, 287 F. 245.)

Appellant next argues that respondent Director erred in declaring illegal the appropriation in the Philippines of the trademark in question by appellant and, therefore, said appropriation did not affect appellee's right thereto and the subsequent registration thereof. Appellant urges that its

appropriation of the trademark in question cannot be considered illegal under Philippine laws, because of non-compliance by appellee of Section 37 of Republic Act No. 166. But we have already shown that Section 37 is not the provision invoked by respondent because the Philippines is not as yet a party to any international convention or treaty relating to trademarks. The case of *United Drug Co. v. Rectanus*, 248 U.S. 90, 39 S. Ct. 48, 63 L. Ed. 141, cited by appellant, is not applicable to the present case, as the records show that appellee was the first user of the trademark in the Philippines, whereas appellant was the later user. Granting that appellant used the trade-mark at the time appellee stopped using it due to government restrictions on certain importations, such fact did not, as heretofore stated, constitute abandonment of the trademark as to entitle anyone to its free use.

Non-use because of legal restrictions is not evidence of an intent to abandon. Non-use of their ancient trade-mark and the adoption of new marks by the Carthusian Monks after they had been compelled to leave France was consistent with an intention to retain their right to use their old mark. Abandonment will not be inferred from disuse over a period of years occasioned by statutory restrictions on the name of liquor. (*Nims Unfair Competition and Trade-Mark* p. 1269.)

IN VIEW OF ALL THE FOREGOING, we are of the opinion and so hold, that respondent Director of Patents did not err in dismissing the present petition for cancellation of the registered trademark of appellee company, and the decision appealed from is therefore hereby affirmed, with costs against the appellant. So ordered.

Bengzon, C.J., Padilla, Bautista Angelo, Labrador, Reyes, J.B.L., Paredes, Dizon, Regala and Makalintal, JJ., concur.
Concepcion, J., took no part.