

RUBBERMAID, INC.,
Petitioner,

INTER PARTES CASE NO. 1951

PEITION FOR CANCELLATION

- versus

Cert. of Regn. No. SR-5736
Issued : October 2, 1981
Registrant : Filipina Plastic
Corporation
Trademark : RUBBERMAID
Used on : Sink mats, door mats, car
mats

FILIPINAS PLASTIC CORPORATION,
Respondent-Applicant.

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DECISION NO. 88-102 (TM)
October 12, 1988

DECISION

Rubbermaid, Inc. filed on October 22, 1985 a Petition seeking for the cancellation of Certificate of Registration No. SR-5736 for the trademark "RUBBERMAID" used on sink mats, door mats and car mats issued on October 2, 1981 in the name of Filipinas Plastic Corporation.

Petitioner is a foreign corporation organized and existing under the laws of Ohio, United States of America, with principal office at 11147 Akron Road, Wooster, Ohio 44691, U.S.A, while Respondent-Registrant is a domestic corporation with business address at 15 Liwayway Street, Acacia, Malabon, Metro Manila, Philippines.

The grounds alleged in the Petition are as follows:

"1. That the registrant Filipinas Plastic Corporation was not entitled to register the mark at the time of its application for registration thereof;

2. That the registration compromises a trademark or tradename previously used in the Philippines by Petitioner and not abandoned, as to be likely, when applied to or used in connection with the goods, business or services of the Petitioner, to cause confusion or mistake or to deceive purchasers to the injury of both the Petitioner and the public in accordance with Section 4 (d) of Republic Act No. 166.

3. That Article 6bis of the Paris Convention protects Petitioner's registered marks, which is internationally well-known, against reproductions, imitations or translations over identical or similar goods.

4. That Article 8 of the Paris Convention likewise protects Petitioner in its tradename "RUBBERMAID", an internationally known tradename."

In its Answer filed on December 20, 1985, respondent-Registrant specifically denied all the materials allegations made in the Petitions and raised therein the following affirmative defenses:

"5. That petitioner has no valid cause of action against respondent-Registrant;

6. That respondent-registrant was the first to lawfully adopt and use in commerce in the Philippines, the trademark RUBBERMAID for sink mats, door mats and car mats and, therefore, the lawful owner thereof pursuant to the Trademark Law.

7. That petitioner is not licensed to do business in the Philippines. Neither is it actually doing business in the Philippines. Consequently, it has no legal capacity or personality to file, much less prosecute, the above petition for cancellation.

8. That the issuance of Registration Certificate No. SR-5736 to respondent-registrant conforms to and is in all respects in accordance with the provisions of the Trademark Law and the Revised Rules of Practice in Trademark Cases;

9. That under the principles of estoppels and/or laches, petitioner is now stopped to question the use, as well as the ownership, of the trademark RUBBERMAID by respondent-registrant.”

After the pre-trial conference, the case was set for hearing on the merits. On July 9, 1986, Opposer submitted the Affidavit of its main witness with Annexes “A” to ‘M”. The process was quite prolonged because of the use of Cross-Written Interrogatories upon Opposer`s foreign witnesses Robert W. Thomas and James Morgan by the Respondent-Registrant.

On September 9, 1988, the parties filed a Joint Motion to dismiss this case in view of the fact that they have already “arrived at an amicable settlement of the instant Petition for Cancellation” by way of the assignment of the mark RUBBERMAID to the Petitioner, as shown in the attached Assignment of Mark dated July 12, 1988 (Annex “A”) duly signed by the parties.

WHEREFORE, premises considered, this Petition is DISMISSED subject to the provisions of the above-cited Assignment of Mark.

Let the records of this case be forwarded to the Trademark/Patents Registry and EDP Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO
Director