VICTOR SIASAT,	}	Inter Partes Case No. 3073
Opposer,	}	Opposition to:
	}	
-versus-	}	Serial No. : 50384
	}	Date Filed : 14 February 1983
	}	Trademark: "RENO & HAT
ATLANTA SPORTSWEAR, LTD.,	}	DEVICE"
Respondent-Applicant.	}	
x----------x		Decision No. 2003 – 05

DECISION

This pertains to the Opposition filed by VICTOR SIASAT, Filipino, of legal age and with business address at No. 54 7th Avenue, Caloocan City, against the registration of the trademark "RENO & HAT DEVICE" for use on clothing including boots, shoes and slippers, men's shirts, t-shirts, sweat shirts, polo shirts, sweaters, jackets, pants, shorts and denim jeans under Application Serial No. 50384 on 14 February 1983 filed by ATLANTA SPORTSWEAR, LTD. of Kowloon, Hong Kong.

The subject application was published for opposition in Volume 82, No. 13 of the Official Gazette, which was officially released for circulation on 29 March 1988. Opposer filed a Verified Notice of Opposition on April 27, 1988.

The grounds for the opposition to the registration of the trademark RENO & HAT DEVICE are as follows:

"1. The approval of the application in question is contrary to Section 4, paragraph (d) of Republic Act 166, as amended;

"2. The approval of the application in question will cause great and irreparable damage and prejudice to Opposer;

Opposer relies on the following facts to support its contentions on this Opposition:

"1. That long before February 14, 1983, the date when the application in question was filed, Opposer had already been using lawfully in commerce in the Philippines the trademark RENO & HAT DEVICE for RTW jeans, slacks, polo, shirts, t-shirts, skirts, blouses, socks, briefs, dresses, jackets, leather bags and shoes;

"2. That Opposer has continued to use and has not abandoned, the trademark RENO & HAT DEVICE;

"3. That through continued and the maintenance of the high quality of the products bearing the trademark RENO & HAT DEVICE, said trademark has become popular and well-known in the Philippines and has been identified as Opposer's mark;

"4. That Respondent-Applicant has never used in lawful commerce in the Philippines the trademark RENO & HAT DEVICE;

"5. That the approval of the application in question is contrary to Section 4, paragraph (d) of Republic Act 166, as amended;

"6. That the approval. Of the application in question will cause great and irreparable damage and prejudice to Opposer;

In its Answer, Respondent-Applicant raised the following defenses to defeat the Opposition and support its Application:

"1. Respondent-Applicant admits the allegations in the opening paragraph of the Opposition except that portion which states that Opposer will be damaged by the approval of subject application for utter lack of legal and factual basis;

"2. Respondent-Applicant specifically denies the allegations in paragraphs 1 and 2 of the grounds of the Opposition for lack of knowledge or information sufficient to form a belief as to the truth or falsity thereof;

"3. Respondent-Applicant specifically denies the allegations in paragraphs 1, 2, 3, 5 and 6 of the facts to support the Opposition for lack of knowledge or information sufficient to form a belief as to the truth or falsity thereof, and further as alleged in the following:

"4. Respondent-Applicant has the earlier adoption and use of the trademark in its home country and in the other countries of the world including the Philippines and has in fact existing registrations and/or applications in such foreign countries including the Philippines;

"5. The approval of subject application by the Bureau of Patents, Trademarks & Technology Transfer is a clear indication of Respondent-Applicant's entitlement to its trademark RENO & HAT DEVICE and its having complied with all the requirements under the Trademark Law and the Rules of Practice and is not contrary to Section 4, par. (d) of the said Republic Act 166, as amended;

"6. It is the Opposer who should be barred by the provision of Section 4, par. (d) of Republic Act 166, as amended, having adopted the trademark RENO & HAT DEVICE subsequent to the adoption and use thereof by Respondent-Applicant and having filed an application for registration thereof subsequent to the filing by Respondent-Applicant for the registration of its trademark;

"7. The alleged continued use of the subject trademark by Opposer is a violation of Respondent-Applicant's prior adoption use and/or application for registration thereof by Respondent-Applicant in other countries of the world including the Philippines;

"8. Opposer has not only copied Respondent-Applicant's trademark but has also copied the design of Respondent-Applicant's clothing items as well, thus seriously and adversely affecting Respondent-Applicant' business in the Philippines.

The issues having been joined, the Notice of Pre-Trial Conference dated June 02, 1988 was sent to Opposer and Respondent-Applicant on June 6 and 7, 1988 respectively which set the case for Pre-Trial Conference on 05 July 1988. Failing to reach an amicable settlement, trial on the merits proceeded where the parties adduced their respective testimonial and documentary evidences.

In support of his prayer for the rejection of Application Serial No. 50384, Opposer presented and afterwards formally offered his documentary and testimonial evidence on July 25, 2002. Admitted in evidence for the Opposer based on the records are Exhibits "1" to "10" inclusive of submarkings which consisted, among others, of the uncontradicted testimony in an

affidavit form of Victor Siasat, herein Opposer, trademark application for the mark RENO & HAT DEVVICE OF A HAT, RENO, labels and sales invoices showing actual commercial sale of RENO clothings for the year 1982 in the Philippines.

For evaluation of this Office in particular is the propriety of Application Serial No. 50384. The issue hinges on the determination of whether or not Respondent-Applicant is entitled to register the trademark RENO & HAT DEVICE OF A HAT for use on clothing including boots, shoes and slippers, men's shirts, t-shirts, sweat shirts, polo shirts, sweaters, jackets, pants, shorts and denim jeans.

In this connection, it should be noted that Republic Act No. 166, as amended was the law in force at the time the subject trademark application and Notice of Opposition were filed, hence, this Office resolves this instant Opposition under said law so as to adversely affect rights already acquired prior to the effectivity of the new Intellectual Property Code (R.A. 8293).

R.A. 166, as amended, more particularly Section 4 (d), is stated in this wise:

> "Section 4. Registration of trademarks, trade-names and service marks on the principal register --- xxx The owner of a trademark, trade-name or service mark used to distinguish his goods, business or services from the goods, business or service of others shall have a right to register the same on the Principal Register, unless it:
>
> "x x x
>
> *"(d) Consists of or comprises a mark or trade-name which so resembles a mark or trade-name registered in the Philippines or a mark or trade-name previously used in the Philippines by another and not abandoned, as to be likely, when applied to or used in connection with the goods, business or services of the applicant, to cause confusion or mistake or to deceive purchasers."*

After close scrutiny and careful evaluation of the records and evidence presented, this Office finds substantiation to the grounds relied upon to sustain this instant Opposition.

From the evidence presented, it would appear that both trademarks have identical word-mark RENO and device (HAT) and that they cover goods under Class 25. Opposer offered as proof of actual sale in commerce of RENO clothes, (Exhibit "9" and "9-A) the official receipts issued by Cassie Boutique owned and managed by herein Opposer for the year 1982. Considering that Applicant failed to offer testimony and/or evidence to show date of first use of the mark in commerce in the Philippines, Respondent-Applicant's date of first use would be limited to the date when their application was filed pursuant to Rule 173 of the Revised Rules of Practice in Trademark Cases, which provides:

> *"Rule 173. Allegations in the application not evidence on behalf of the applicant. – In all inter partes proceedings, the allegations of date of use in the application for registration of the applicant or of the registrant cannot be used as evidence in behalf of the party making the same. In case no testimony is taken as to the date of use, the party will be limited to the filing date of the application as the date of his first use."*

Application Serial No. 50384 was filed February 14, 1983. Although Opposer's alleged date of first use of the mark was December 15, 1980, during his formal offer of evidence only sales invoices/receipts bearing the year 1982 were presented. However, in point of time, Opposer is still the prior user as Respondent-Applicant's filing date of 14 February 1983 shall be considered as its date of first use.

As held in the case of Unno Commercial Enterprises, Inc. vs. General Milling Corporation *"prior use by one will controvert a claim of legal appropriation by subsequent users".* It may be concluded inevitably that Respondent-Applicant's use of identical mark results in an unlawful appropriation of mark previously used by Opposer and not abandoned, which is contrary to the explicit provision of Section 4 (d) of Republic Act No. 166, as amended, the applicable law that controls the present controversy.

In the case of HEIRS OF CRISANTA Y. GABRIEL-ALMORADIE, et.al. vs. COURT OF APPEALS, *the principle of "First to Use" was used as basis in resolving the case in favor of private respondent where its states that "Thus, all things being equal, it is then safe to conclude that Dr. Perez had a better right to the mark "WONDER". The registration of the mark "Wonder GH" should have been cancelled in the first place because its use in commerce was much later and its existence would cause confusion to the consumer being attached on the product f the same class as that of the mark "WONDER".*

The fact that Opposer first adopted and is the prior user of the questioned mark on goods under Class 25, gives sufficient legal basis for this Office to resolve and confer protection to Opposer against the use of the same mark by others in the Philippines.

WHEREFORE, premises considered, the Notice of Opposition is hereby SUSTAINED. Consequently, application bearing Serial No. 50384 filed by ATLANTA SPORTSWEAR, LTD. for the registration of the mark "RENO & HAT DEVICE" used on goods belonging to Class 25 is hereby REJECTED.

Let the filewrapper of RENO and Hat Device 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 (BOT) for information and to update its record.

SO ORDERED.

Makati City, 27 January 2003.

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