

THE DINER'S CLUB, INC.  
Opposer/ Petitioner,

INTER PARTES CASE NO. 1599

OPPOSITION TO:

Appln. Serial No. 34521  
Filed : February 17, 1978  
Applicant : Pedro C. Tan  
Trademark : DINERS  
Used on : Hot pepper sauce

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- versus -

- and -

INTER PARTES CASE NO. 1944

PETITION FOR CANCELLATION

Regn. No. SR-3963  
Issued : April 16, 1979  
Registrant : Pedro C. Tan  
Trademark : DINERS  
Used on : Hot pepper sauce  
worcestershire

PEDRO C. TAN  
Respondent-Applicant/  
Registrant.  
x-----x

DECISION NO. 88-27 (TM)  
May 31, 1988

#### DECISION

This decision pertains to a Petition for Cancellation designated as Inter Partes Case No. 1944 filed on August 22, 1985 by The Diner's Club, Inc., a corporation organized and existing under the laws of the State of New York, U.S.A., seeking the cancellation of Certificate of Registration No. SR-3963 for the trademark "DINERS" for hot pepper sauce and worcestershire issued on April 16, 1979 in the name of the herein Respondent-Registrant, Pedro C. Tan, of Navotas, Metro Manila, Philippines.

The Petition is based on the grounds that Respondent was not entitled to register the mark "DINERS" at the time of the application for registration thereof because Respondent's trademark "DINERS" is confusingly similar to the mark "DINER'S CLUB" which is duly registered in the name of the Petitioner and not abandoned; and that Petitioner's trademark "DINER'S CLUB" is well known all over the world including the Philippines, for which reason the registration of the trademark "DINERS" in the name of the Respondent should be cancelled as mandated by Section 4 of Republic Act No. 166, as amended, and Article 6bis of the Convention of Paris for the Protection of Industrial Property and further, in line with the policy of the then Ministry of Trade contained in a letter-memorandum dated November 20, 1980 and October 25, 1983 addressed to the then Director of Patents directing the latter to reject and/or cancel unauthorized registration of foreign marks.

On February 28, 1986, Respondent-Registrant filed his Answer specifically denying all the material allegations in the Petition. Thereafter, the case was set for pretrial conference on April 4, 1986.

Prior to the date of the pre-trial conference, counsel for the Petitioner filed a Motion to Consolidate Inter Partes Cases Nos. 1944 and 1599 alleging that the parties and the issues in

the two cases are the same. There being no objection from Respondent-Registrant, the motion was granted by this Bureau under Order No. 86-74 dated March 21, 1986.

On November 6, 1987, Petitioner filed a motion to render judgment on the ground that Respondent-Registrant failed to file the requisite fifth year Affidavit of Use/ Non-Use for the above trademark registration, thus the said registration is deemed cancelled by operation of law.

Verification of the records of the case confirms the findings and conclusion of the Petitioner. Section 12 of Republic Act 166, as amended, reads:

“SEC. 12. Duration. - Each certificate of registration shall remain in force for twenty years: Provided, That registrations under the provisions of this Act shall be cancelled by the Director, unless within one year following the fifth, tenth and fifteenth anniversaries of the date of issue of the certificate of registration, the registrant shall file in the Patent Office an affidavit showing that the mark or trade-name is still in use or showing that its non-use is due to special circumstances which excuse such non-use and is not due to any intention to abandon the same, and pay the required fee.”  
(Underscoring supplied)

IN VIEW OF THE FOREGOING, Inter Partes Case No. 1944 is hereby DISMISSED for being moot and academic.

Inter Partes Case No. 1599, an opposition to the registration in the Principal Register of the trademark “DINERS” under Application Serial No. 34521, not being affected by the cancellation of Certificate of Registration No. SR-3963, shall proceed to trial on the merits. Let the hearing therefore be set to June 24, 1988 at 9:30 A.M.

Let the records of Inter Partes Case No. 1944 be remanded to the Patent/Trademarks and EDP Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO  
Director