

THE ANTIGUA GROUP, INC,	}	IPC No. 14-2002-00082
<i>Opposer,</i>	}	Opposition to:
	}	
-versus-	}	Serial No. 4-1998-08730
	}	Date Filed: November 27, 1998
	}	
CHANDER CHANDNANI,	}	Trademark : "ANTIGUA"
<i>Respondent-Applicant</i>	}	
x-----x	}	Decision No. 2004-16

DECISION

This pertains to an Opposition filed on February 17, 2003 by herein Opposer, THE ANTIGUA GROUP, INC., a foreign corporation organized and existing under and by virtue of the laws of the United States of America, with principal office address at 16651 N. 84th Avenue, Peoria, AZ 85382, U.S.A., against the application filed on November 27, 1998 bearing Serial No. 4-1998-08730 for the registration of the trademark "ANTIGUA" used for handkerchiefs, t-shirts, sando, polo shirts, pants, underwear, and t-shirt with collar under class 24 and 25 of the international classification of goods, which, application was published in the Intellectual Property Office Official Gazette, officially released on October 1, 2001 on Page 41, Vol. V, No.7.

The Respondent-Applicant in the instant opposition is CHANDER CHANDNANI of 950 Pedro Gil Street, Paco, Manila.

Accordingly, the grounds for opposition are as follows:

"1. The Opposer is the originator, prior adopter and user of the mark "ANTIGUA" as early as 1984 and has registered the same in the United States of America and in other major countries of the world;

"2. The Respondent-Applicant's trademark "ANTIGUA" is so identical to, or confusingly similar with the Opposer's trademark "ANTIGUA" and its variations that the continued use by Respondent-Applicant of "ANTIGUA" on goods falling under International Classes 24 and 25 will constitute a clear case of commercial and criminal piracy. Accordingly, if allowed to proceed to registration, the Trademark Application Serial No. 4- 1998-08730 will violate not only the provisions of the Intellectual Property Code, particularly paragraphs (e) and (f) of Section 123.1 but also the commitment of the Philippines to the international community through its accession with the Paris Convention and membership with the World Trade Organization (WTO) and as signatory to the Trade Related Aspect of Intellectual Property Rights Agreement (TRIPS);

"3. That the subject mark constitute a colorable imitation of the Opposer's mark which is a well-known mark not only in the Philippines but also in other countries of the world so that the use of the subject mark on the products of the respondent-applicant would indicate a connection between said products and that of the Opposer to the damage and prejudice of the goodwill and interests of the Opposer who had much earlier adopted and use its trademark in commerce in the United States of America and in other countries of the world and who has registered the same worldwide;

"4. Opposer has already spent much for the advertisement and promotion of the "ANTIGUA" and its variations. Hence, Opposer's business and goodwill will clearly be damaged and will suffer irreparable injury by the registration and use of a confusingly similar mark by the respondent-applicant;

“5. That the subject mark constitutes the tradename of herein Opposer. As such, this tradename should be protected pursuant to Art. 8 of the Paris Convention and Section 165 of the IP Code.”

In support of its opposition, the Opposer interposes that Respondent-Applicant has fraudulently applied for the registration of the subject mark “ANTIGUA” since he was merely riding on the popularity of Opposer’s well-known mark. Opposer argued that at the time the Respondent-Applicant filed its application for registration of the mark on November 27, 1998, the mark “ANTIGUA” was already well-known throughout the world and in the Philippines. The Opposer’s goods bearing the trademark “ANTIGUA” had been used in many countries, including the Philippines, as early as 1984 and up to present and has amassed and enjoyed international reputation and goodwill for high quality products. Furthermore, Opposer is of the view that its mark “ANTIGUA” is an internationally well-known mark entitled to the protection under Article 6bis of the Paris Convention and amplified by the Memorandum of the Minister of Trade to the Honorable Director of Patents dated November 20, 1980; the Executive Order No. 913 dated October 7, 1983 and the Memorandum of the Minister of Trade and Industry to the Honorable Director of Patents dated October 25, 1983. Finally, Opposer stressed that it deserves protection under the Intellectual Property Code particularly Sections 123, 134, 147, 165 and other relevant section thereof.

A Notice to Answer dated January 29, 2003 was issued by this Office requiring the Respondent-Applicant to file his Answer within fifteen (15) days from receipt. In an Order dated July 15, 2003, Respondent-Applicant was declared IN DEFAULT for failure to file his Answer within the reglementary period.

Subsequently, this Office proceeded on trial for the presentation of Opposer’s evidence *ex parte*. For its part, Opposer submitted pieces of documentary evidence consisting of the sworn statement of Mr. Ronald A. McPherson together with the annexes which were marked as Exhibits “A” to “H”. The Formal Offer of Evidence by herein Opposer consisting of the foregoing Exhibits was admitted in evidence in Order No. 2004-142, dated March 24, 2004. In compliance with the said Order, Opposer then filed its Memorandum dated May, 4, 2004.

At this point, it can be perceived that the main issues to be resolved in the case at bar are as follows:

- A) WHETHER OR NOT THE RESPONDENT-APPLICANT’S MARK “ANTIGUA” IS IDENTICAL OR CONFUSINGLY SIMILAR TO THE OPPOSER’S MARK “ANTIGUA”;
- B) WHETHER OR NOT OPPOSER’S MARK IS A WELL-KNOWN MARK, ENTITLED TO THE PROTECTION OF THE INTELLECTUAL PROPERTY CODE;

It is noteworthy to emphasize that the law governing the instant opposition case is Republic Act No. 8293, other wise known as the Intellectual Property Code of the Philippines considering that the application for registration of the mark in question was filed during the effectivity of the said statute.

It is undeniable that the contending mark of the Opposer, “ANTIGUA” and that of the Respondent-Applicant, “ANTIGUA” is not only similar but clearly identical. Opposer’s mark “ANTIGUA” is not only registered in the U.S.A. but also in other countries of the world for goods under classes 25 and 28 of the nice classification. On this point alone, the issue of confusing similarity between the conflicting marks can be settled. Considering that Opposer’s mark, “ANTIGUA” deals with goods under class 25 (i.e. clothing, including boots shoes and slippers) and class 28 (i.e. games and play things; gymnastic and sporting articles), while Respondent-Applicant’s mark, “ANTIGUA” is classified under classes 24 and 25 of the nice classification of goods, the confusing similarity arises as both parties are engaged in the same line of business.

Opposer tends to insinuate to this Office that despite the fact that its mark "ANTIGUA" is not registered here in the Philippines, the same mark should be accorded protection in its favor. We are not impressed.

In the case of KABUSHI KAISHA ISETAN, also known and trading as ISETAN CO., LTD., vs. THE INTERMEDIATE APPELLATE COURT, THE DIRECTOR OF PATENTS, and ISETTANN DEPARTMENT STORE, INC., (G.R. No. 75420. November 15, 1991), our Supreme Court ruled:

"The records show that the petitioner has never conducted any business in the Philippines. It has never promoted its tradename or trademark in the Philippines. It has absolutely no business goodwill in the Philippines. It is unknown to Filipinos except the very few who may have noticed it while traveling abroad. It has never paid a single centavo of tax to the Philippine government. Under the law, it has no right to the remedy it seeks." (Underscoring Supplied)

Moreover, in STERLING PRODUCTS INTERNATIONAL, INCORPORATED, vs. FARBENFABRIKEN BAYER AKTIENGESELLSCHAFT and ALLED MANUFACTURING AND TRADING CO., INC., G.R. No. L-19906, April 30, 1969, our Supreme has this to rule, to wit:

"Neither will the 1927 registration in the United States of the BAYER trademark for insecticides serve plaintiff any. The United States is not the Philippines. Registration in the United States is not registration in the Philippines. At the time of the United States registration in 1927, we had our own Trademark Law, Act No. 666 aforesaid of the Philippine Commission, which provided for registration here of trademarks owned by persons domiciled in the United States.

x x x x

There is nothing new in what we now say. Plaintiff itself concedes that the principle of territoriality of the Trademark Law has been recognized in the Philippines, citing Ingenohl vs. Walter E. Olsen, 71 L. ed. 762. As Callmann puts it, the law of trademarks "rests upon the doctrine of nationality or territoriality." (Emphasis Supplied)

We will now delve to the final issue of whether or nor the mark of the Opposer, "ANTIGUA" is an internationally well-known mark, entitled to the protection of the law. This Office had to resolve the same in the negative as herein Opposer failed to establish and prove such fact in the case at hand.

Section 123.1 (e) of Republic Act No. 8293 explicitly provides that:

"Section 123. Registrability. 123.1. A mark cannot be registered if it:

x x x x

(e) Is identical with or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: Provided, That in determining whether a mark is well-known, account shall be taken of the knowledge of relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark."

The above-cited provision of the Code is crystal clear that a mark cannot be registered if it is identical with confusingly similar to or constitutes a translation of a mark, which is considered

by the competent authority of the Philippines to be well-known internationally and in the Philippines.

There is no debate on the fact that herein Opposer is the registered owner of the mark "ANTIGUA" in the United States of America as well as in other countries in the world. On the contrary however, there is not even a single piece of evidence which showed that the mark of the Opposer has been in actual use in commerce in the Philippine territory. Opposer does not even have a local distributor or licensee in this country to prove that the mark owned by it was adopted, used, and sold in commerce within this jurisdiction.

It is settled that the *onus probandi* in establishing and proving that the mark is well-known internationally and in the Philippines lies on the Opposer. However, with all the pieces of evidence presented by the latter, it failed to prove that its mark "ANTIGUA" falls under the category of a well-known mark.

It is likewise a settled rule in both law and jurisprudence that the law on Trademarks adhere to the principle of nationality and territoriality. As aptly put, the registration in the United States of America is not registration in the Philippines considering that America is not Philippines.

Furthermore, the Rules and Regulations on Trademark, Service Marks, Trade Names, and Marked or Stamped Container of Goods particularly Rule 102 thereof provides for the Criteria for determining whether a Mark is Well-Known:

"Rule 102. Criteria for determining whether a Mark is Well-Known. In determining whether a mark is well-known, the following criteria or any combination thereof may be taken into account:

- (a) *the duration, extent and geographical area of any use of the mark, in particular, the duration, extent and geographical area of any promotion of the presentation, at fairs or exhibition, of the goods and/or services to which the mark applies;*
- (b) *the market share, in the Philippines and in other countries, of the goods and/or services to which the mark applies*

x x x" (Emphasis Ours)

In fine, the foregoing provision is clear that the protection accorded to a well-known mark should comply with the criteria mentioned above. Opposer in the case at bar did not even meet a single criterion or any of the other combinations of the cited criteria. We also observed that herein Opposer did not bother to file an application for the registration of its mark "ANTIGUA" here in the Philippines.

The evidence presented during trial on the merits revealed that the expenses devoted for the promotion and other pertinent commercial activities of the Opposer to prove actual use of its mark took place in America, Europe and other countries in the world. It is ironic that not even a single promotional activity was ever conducted in this country. Yet, it argued that mark "ANTIGUA" has gained goodwill and reputation throughout the world. Therefore, it is not correct to say that the mark "ANTIGUA" of the Opposer is well-known here in the Philippines. The law categorically states that the mark should also be well-known in this country for it to be recognized as well-known mark.

Opposer also invoked the protective mantle of the Paris Convention to which the Philippines is a signatory. This Office views the said argument of Opposer as clearly self-serving. As shown above, there is nothing which we can discern as of this moment which will persuade us to believe that the Opposer is entitled to the protection of the law. We doubted that the Opposer has shown and proven actual use of its mark so to speak, here in the Philippines.

WHEREFORE, in view of the foregoing, the Notice of Opposition filed by the Opposer is, as it is hereby, DENIED. Considering however that, as shown by the records, Respondent-Applicant, despite due notice failed to file its Answer prompting this Office to issue an Order declaring him IN DEFAULT, thus, as ruled by Our Supreme Court, defendant has admitted the allegations in the Complaint, or the Notice of Opposition as applied in this case. The High Court has ruled thus,

“In failing to file its answer specifically denying under oath the Deed of Sale, the bank admitted the due execution of the said contract. Such admission means that it acknowledged that Tena was authorized to sign the Deed of Sale on its behalf. Thus defenses that are inconsistent with the due execution and the genuineness of the written instrument are cut off by an admission implied from a failure to make a verified specific denial.” (Rural Bank of Milaor [Camarines Sur], vs. Francisca Ocfemia, et al, G.R. No. 137686, February 8, 2000)

Moreover, under the Rules and Regulation on Trademark, Servicemarks, Trade Names and Marked or Stamped Containers particularly Rule 602 thereof, the law imposes upon the Respondent-Applicant the duty to look after his own interest in the prosecution of his application. On the contrary, the applicant in this case appears to have no interest in defending his application which is the subject of this Notice of Opposition.

IN VIEW THEREOF, Application Serial No. 4-1998-08730 for the mark “ANTIGUA” used for handkerchiefs, t-shirts, sando, polo shirts, pants, underwear, and t-shirt with collar under class 24 and 25 of the international classification o goods filed on November 27, 1998 by Respondent-Applicant CHANDER CHANDNANI, is hereby considered ABANDONED/WITHDRAWN for Respondent’s lack of interest to prosecute subject application.

Let the filewrapper subject matter of this case be forwarded to the Administrative, Financial, Human Resources 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 records.

SO ORDERED.

City of Makati, 27 October 2004.

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