

YOSHINOYA D & S CO., LTD., <i>Petitioner</i>	}	INTER PARTES CASE NO. 4253
	}	Petition for Cancellation:
-versus-	}	Registration No. : 50362
	}	Date Filed : 30 April 1991
BURGER MACHINE INC. <i>Respondent-Registrant.</i>	}	Trademark : "BEEF BOWL"
x-----x	}	Decision No. 2006-15

DECISION

This is a Petition for Cancellation of Registration No. 50362 for the trademark "BEEFBOWL" issued on April 30, 1991 for eatery and food services in Class 42 of the International Classification.

The Respondent-Registrant in the instant cancellation proceedings is BURGER MACHINE INC., with address at 19th Street, New Manila, Quezon City, Metro Manila.

On the other hand, the herein Petitioner is YOSHINOYA D & S CO., LTD., a corporation duly organized and existing under the laws of Japan, with office address at 3-17, Shinjuku 4 Chome, Shinjuku-ku Tokyo, Japan.

The grounds for the Petitioner for cancellation are as follows:

- "1. Respondent is not the owner of, and therefore, not entitled to register the trademark "BEEF BOWL".
- "2. Petitioner and its predecessor-in-interest have always been the owner of the trademark "BEEF BOWL", having used the same since 1976 continuously up to the present.
- "3. The above registration "BEEF BOWL" was obtained by Respondent-Registrant contrary to the provisions of Section 4, of the Republic Act No. 166, as amended.
- "4. Petitioner's trademark "BEEF BOWL" is duly registered in the United States of America and other countries and is well-known not only in the United States of America and Japan but also in the Philippines. In view thereof, and under Article 6bis of the Paris Convention for the Protection of Industrial Property, the registration of the trademark "BEEF BOWL" in the name of Respondent-Registrant must be cancelled.
- "5. The registration of the trademark "BEEF BOWL" in the name of Respondent-Registrant caused, still causes and continues to cause great irreparable injury and damage to Petitioner within the meaning of Section 17 of Republic Act No. 166;

Petitioner relies on the following facts:

- "1. Petitioner and its sister company in the United States of America bearing its name have been engaged in restaurant service business in the United States of America, in Japan and in the Philippines, using the mark "BEEF BOWL".

- “2. Petitioner’s sister company in the United States of America which bears its name first created, adopted and used in the United States of America the said “BEEF BOWL” trademark for restaurant service business in Class 42, and had the same registered with the United States Patent Office way back in 1976, and subsequently said mark was registered and used in other countries of the world.
- “3. By reason of continuous and worldwide sales and advertisement by Petitioner and its sister company in the United States of America and because of superior quality of its products, Petitioner’s abovementioned trademark “BEEF BOWL” have become well-known throughout the world, including the Philippines prior to the alleged date of first use thereof by Respondent-Registrant of July 10, 1985.
- “4. Likewise, Petitioner and its predecessor-in-interest have established a valuable goodwill for the trademark “BEEF BOWL” long prior to the alleged date of first use thereof by Respondent-Registrant.
- “5. The mark registered in favor of Respondent-Registrant is identical, if not confusingly similar to Petitioner’s trademark “BEEF BOWL”. Under the present circumstances, the registration and the alleged use of the trademark “BEEF BOWL” by Respondent-Registrant is likely to cause confusion, mistake and deception of the buying public.
- “6. Respondent-Registrant is guilty of fraud when it applied for the registration of the trademark “BEEF BOWL” in its favor and Certificate of Registration No. 50362 issued on April 30, 1991 was obtained by him, fraudulently.
- “7. Respondent-Registrant has not lawfully used in commerce in the Philippines the trademark “BEEF BOWL” before it filed its application for registration thereof. Neither has it used said trademark lawfully after its registration.

On September 19, 1996, Respondent-Registrant filed its Answer denying all the material allegations in the Petition for Cancellation and further alleged a counter claim.

During the pre-trial conference the parties were encouraged to discuss the possibility of settling the case amicably, however, no settlement have been reached, hence a full-blown trial have been conducted.

The issue to be resolved in the instant Petitioner for cancellation is:

WHETHER OR NOT CERTIFICATE OF REGISTRATION NO. 50362 FOR THE TRADEMARK “BEEF BOWL” ISSUED ON APRIL 30, 1991 IS STILL VALID AND SUBSISTING.

Petitioner submitted its evidence consisting of Exhibits “A” to “E” and their sub-markings which were admitted under Order No. 2002-23 dated 22 January 2002.

On the other hand, Respondent-Registrant submitted its evidence consisting of Exhibits “1” to “3” inclusive of sub-markings which were admitted under Order No. 2006-217 dated 6 February 2006.

Exhibit “D” a certification issued by the Intellectual Property Office, through *Honorie B. De Vera*, Intellectual Property Rights Specialist V, clearly stated that Certificate of Registration No. 50362 for the trademark “BEEF BOWL & DEVICE WITHIN A BOWL” was deemed cancelled for

non-payment of affidavit of use/non-use for the 5th anniversary. A subsequent verification of the records of the Patent Trademarks Registry Division of the AFHRDSB shows that no affidavit of use for the 5th Anniversary was filed by the Registrant, hence under Sec. 12 of R.A. 166, as amended, such registration is deemed cancelled.

WHEREFORE, this case is DISMISSED for being *moot and academic*.

Let the filewrapper of the trademark "BEEF BOWL & Device within a Bowl", subject of this case be forwarded to the Administrative, Financial and Human Resource Development Services 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, 23 March 2006.

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