



KENTEX MANUFACTURING CORPORATION, }
 represented by its President, KING G. ONG, }
 Petitioner, }
 }
 -versus- }
 }
 WILLIAM YOUNG, }
 Respondent- Registrant. }
 X-----X

IPC No. 14-2009-00280
 Petition for Cancellation:
 Date Registered: 30 July 2007
 Registration No. 4-2006-005342
 TM: "HARANA & DEVICE"

NOTICE OF DECISION

PUNO & ASSOCIATES LAW OFFICE
 Counsel for the Petitioner
 2nd Floor, Puno Building
 336 Roosevelt Avenue, Quezon City

TERESITA GANDIONCO OLEDAN
 Counsel for the Respondent-Registrant
 No. 9 Renowned Lane, Sanville Subd.
 Culiati, Tandang Sora, Quezon City

GREETINGS:

Please be informed that Decision No. 2013 - 234 dated December 02, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, December 02, 2013.

For the Director:

Edwin Danilo A. Daring
Atty. EDWIN DANILO A. DARING
 Director III
 Bureau of Legal Affairs



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IPC No. 14-2009-00280
 Petition for Cancellation:
 Registration No. 4-2006-005342
 Date Registered: 30 July 2007
 Trademark: **"HARANA & DEVICE"**
 (The Device Consists of A Man Playing
 Guitar Inside A Rectangular Device)
 Decision No. 2013 - 234

DECISION

KENTEX MANUFACTURING CORPORATION ("Petitioner")¹, filed on 04 December 2009 a petition for cancellation of Trademark Registration No. 4-2006-005342. The registration, issued to WILLIAM YOUNG ("Respondent-Registrant")², covers the mark "HARANA & DEVICES" for use on goods under class 25³ for t-shirts, pants, jeans, polo, shorts, shoes, slippers, sandals and boots.⁴

The facts are provided as follows:

"5. Even prior to its registration on July 30, 2007, petitioner has continuously used the mark 'HAVANA' for a period of more than ten (10) years. It has invested time, effort and goodwill in promoting its slippers and sandals by using the mark 'HAVANA and DEVICE' through advertisements in print and broadcast media.

"6. Petitioner has earned a reputation and respect in the Philippines as the manufacturer and seller of superior quality slippers and sandals over the years of its continuous use of the goods and products bearing the mark and device 'HAVANA' that the said trademark and device are closely identified with products sold in the market by the petitioner. The mark and device had built the buying public's trust in petitioner's products. It is for this reason that petitioner is enforcing its right thereto.

"7. As part of the compliance of this Honorable Office in proving continuous actual use of the mark and device 'HAVANA', the petitioner had renewed its application No. A-2009-010225.
 x x x

"8. This shows that the use had been continuous and never abandoned by the petitioner. As a matter of fact petitioner has filed its original application on November 16, 2005. x x x

"9. Earlier, on June 16, 1995, the petitioner has filed and was issued a Certificate of Copyright Registration of the Copyright claim 'HAVANA' by the National Library, x x x

"10. The trademarks 'Harana & Device' is practically identical with the registered mark 'Havana' belonging to the petitioner with an earlier filing or priority date in the same goods and

¹ A domestic corporation with principal office address at 63-B Serrano St., cor. 8th Avenue, Grace Park, Caloocan City.
² Of legal age with office address at No. 31 Matutum Street, Sta. Mesa heights, Quezon City.
³ The Nice Classification of goods and services is for registering trademark and service marks, based on a multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.
⁴ Trademark Registration Certificate No. 4-2006-005342 was issued on 30 July 2007.

services or closely related goods and services or nearly resembles such a mark that it is likely to deceive or cause confusion to the buying public, x x x.

“11. The mark ‘HAVANA’ has been actually and continuously used in the Philippines by the petitioner since 1995. As such, it has acquired ownership over the mark and device ‘HAVANA’ and has already a vested right thereto.”

The Petitioner’s evidence consists of the following:

1. Exhibit “A” - Board Resolution dated 09 November 2009;
2. Exhibit “B” - Photocopy of Renewal of Application No. A-2009-010225;
3. Exhibit “C” - Photocopy of Trademark Application for HAVANA;
4. Exhibit “D” - Photocopy of Certificate of Copyright Registration of ‘HAVANA’ issued by the National Library; and,
5. Exhibit “E” - Photocopy of Certificate of Registration for HARANA & DEVICE.

This Bureau served upon the Respondent-Applicant a Notice to Answer on 23 January 2009. The Respondent-Applicant filed its Verified Answer on 14 April 2010. In the Answer, he denied all the allegations in the petition, except those in paragraphs 1, 2, 3 and 4 of the said petition. The following are interposed as special and affirmative defences:

“10. The Copyright Certificate attached to the Petition was issued to Mr. KING G. ONG, who is now the President of petitioner KENTEX, a corporation who is not the copyright registrant of the copyright Havana and simply because Mr. Ong is the President of petitioner, petitioner cannot claim to have ‘prior use’ of the trademark HAVANA as alleged and detailed in the Petition.

“11. Respondent-registrant is the registered owner of the trademark ‘HARANA’ with the device of a man playing his guitar. x x x

“12. The word HARANA as registered by respondent Young refers to ‘serenade’ in the Tagalog language as shown by the device attached thereto, that of a ‘man playing a guitar inside a rectangular device’ while Mr. King G. Ong’s copyrighted word ‘HAVANA’ refers to a country in South America. These are two words with definitely different and distinct meanings and cannot lead to confusion, as alleged by petitioner. One does not serenade another to go to as South American country such as Havana.

“13. Petitioner not being the ‘assignee’ of the copyrighted HAVANA has no legal personality to seek the cancellation of respondent-registrant’s. The fact that KENTEX is represented by Mr. Ong in this Petition does not mean that KENTEX has become now the registrant of the copyrighted word ‘HAVANA’. Be that as it may, the prior copyright registration of the word Havana by Mr. Ong, who is not the petitioner, may not be the basis of cancellation under the express provisions of R.A. 8293.

“14. Respondent YOUNG filed his application for registration of the word HARANA under Class No. 25 of the NICE Classification under the provisions of R.A. 8293 where ‘prior use’ as then required under R.A. 166 is not a condition precedent. The fact that said trademark application was favourably considered by this Office proves respondent-registrant’s entitlement thereto.”

The Respondent-Registrant submitted its lone evidence consisting of Certificate of Registration No. 4-2006-005342 marked as Exhibit "1".

Should Respondent-Registrant's trademark registration for "HARANA & DEVICE" be cancelled?

Respondent-Registrant raised a technical issue that herein Petitioner has no legal personality to file the instant case since it is not the named applicant in the application for trademark registration for HAVANA, nor the assignee of the said mark. The records reveal that the application is under the name of King G. Ong, who is the General Manager of the Board of Directors and the authorized representative of the Petitioner to this instant case.⁵

Be that as it may, Sec. 151.1 of the IP Code provides:

A petition to cancel a registration of a mark under this Act may be filed with the Bureau of Legal Affairs by any person who believes that he is or will be damaged by the registration of a mark under this Act as follows:

(a) Within five (5) years from the date of the registration of the mark under this Act.

(b) At any time, if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of this Act, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used. x x x

While the application for the registration of the mark HAVANA is under the name of its General Manager, King G. Ong, the Petitioner alleges that it is dealing in and selling goods that bear the mark HAVANA. As it is alleging that the mark HARANA is confusingly similar to the mark HAVANA, the Petitioner is deemed an interested party who may file a petition for cancellation of Respondent-Registrant's mark.

Going now to the substantive issue of whether or not the Respondent-Registrant's registration should be cancelled, Sec. 138 of the IP Code provides:

A certificate of registration of a mark shall be prima facie evidence of the validity of the registration, the registrant's ownership of the mark, and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate.

⁵ Exhibit "A" of the Petitioner.

Aptly, the burden of proof is on the Petitioner to overcome the presumption under Sec. 138 of the IP Code. In this regard, the Petitioner claims that the marks HAVANA and HARANA, shown below, are confusingly similar:



Petitioner's Trademark



Respondent-Registrant's Trademark

and considering that its application for the registration of the mark HAVANA preceded the filing of the Respondent-Registrant's application for the registration of the mark HARANA, the latter should not have been registered. But while the application for the registration of the mark HAVANA was filed prior to the Respondent-Registrant's, Sec. 123.1 (d) did not pose as a bar to the registration of the mark HARANA.

First, HAVANA and HARANA are two distinct and different words with different meanings. One is a name of a city, in fact the capital of Cuba, while the other is a Filipino word for serenade. Second, the device and styles employed to present both marks are very different. HAVANA is presented very prominently by big and stylized text; while HARANA is presented rather discretely by small text and accompanied by a device with a man playing a string instrument or a violin inside a rectangular box. Clearly, the two marks are dissimilar and HARANA & DEVICE was not calculated to cause confusion to the public.

In conclusion, the Petitioner failed to overcome the presumption of validity of the Respondent-Registrant's trademark registration.

WHEREFORE, premises considered, the instant petition is hereby **DISMISSED**. Let the filewrapper of the Registration No. 4-2010-005342 be returned, together with a copy of this Decision to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 02 December 2013.


ATTY. NATHANIEL S. AREVALO
Director IV, Bureau of Legal Affairs