



RACAL CERAMICS BARGAIN CENTER, INC.,
Opposer,

-versus-

SHE SHAODA,
Respondent-Applicant.

X-----X

IPC No. 14-2011-00023
Opposition to:
Appl. Serial No. 4-2010-005935
Date filed: 02 June 2010
TM: "CAIDA"

NOTICE OF DECISION

RACAL CERAMICS BARGAIN CENTER, INC.,
Counsel for the Opposer
Rm. # 39 Brgy. Biga II
Emilio Aguinaldo Highway
Silang Cavite

SHAODA SHE
Respondent-Applicant
Rm. 1104, 745A T. Alonzo Mansion
Alonso Street, Sta. Cruz
Manila

GREETINGS:

Please be informed that Decision No. 2013 - 208 dated October 24, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 24, 2013.

For the Director:

Atty. PAUSLU U. SAPAK
Hearing Officer
Bureau of Legal Affairs



RACAL CERAMICS BARGAIN CENTER, INC., IPC No. 14-2011-00023
Opposer, Case Filed: 31 January 2011

-versus-

Opposition to:
Appln. Serial No. 4-2010-005935
Date Filed: 02 June 2010

SHE SHAODA,
Respondent-Applicant.

Trademark: CAIDA

x-----x Decision No. 2013 - 208

DECISION

RACAL CERAMICS BARGAIN CENTER, INC. ("Opposer")¹ filed an opposition on 31 January 2011 to Trademark Application Serial No. 4-2010-005935. The application, filed by SHE SHAODA ("Respondent-Applicant")², covers the mark "CAIDA" for use on floor tiles under Class 19 of the International Classification of Goods and Services³.

The Opposer anchors its opposition on the ground that the Respondent-Applicant's mark "CAIDA" is identical to its mark "CAIDA" which was first used in the Philippines sometime in November 2008 and filed for registration on 07 September 2010 for goods ceramic and granite tiles under Class 19 of the International Classification of Goods and Services, hence approval of the Respondent-Applicant's application will cause great and irreparable damage and injury to the Opposer.

In support of its opposition, the Opposer submitted in evidence the following:

1. Exhibit "A" - Import Commodity Clearance Certificate issued by the Department of Trade and Industry dated 06 November 2008;
2. Exhibit "B" - Import Commodity Clearance Certificate issued by the Department of Trade and Industry dated 28 November 2008; and
3. Exhibit "C" - True print out of Trademark Application Serial No. 4-2010-009797 filed with the IPO for the mark CAIDA in the name of RACAL CERAMICS BARGAIN CENTER, INC.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 11 April 2011. The Respondent-Applicant, however, did not

¹ A corporation duly organized and existing under the laws of the Republic of the Philippines with address at Km. 39, Brgy. Biga II, E. Aguinaldo Highway, Silang, Cavite Philippines.

² With address at Room 1104, 745A T. Alonzo Mansion, Alonzo St., Sta. Cruz, Manila.

³ The Organization. The treaty is called the Nice Agreement Concerning the International Nice Classification is a classification of goods and services for the purpose of registering trademark and services marks, based on the multilateral treaty administered by the World Intellectual Property Classification of Goods and Services for the Purpose of the Registration of Marks concluded in 1957.

file the Answer. Hence, the instant opposition is considered submitted for decision based on the opposition and evidence submitted by the Opposer.

Should the Respondent-Applicant's trademark application be allowed?

The Opposer anchored its opposition on Section 134 of R. A. No. 8293, otherwise known as the Intellectual Property Code of the Philippines ("IP Code"), which provides that:

Any person who believes that he would be damaged by the registration of a mark may, upon payment of the required fee and within thirty (30) days after the publication referred to in Subsection 133.2, file with the Office an opposition to the application. Such opposition shall be in writing and verified by the oppositor or by any person on his behalf who knows the facts, and shall specify the grounds on which it is based and include a statement of the facts relied upon. Copies of certificates of registration of marks registered in other countries or other supporting documents mentioned in the opposition shall be filed therewith, together with the translation in English, if not in the English language. For good cause shown and upon payment of the required surcharge, the time for filing an opposition may be extended by the Director of Legal Affairs, who shall notify the applicant of such extension. The Regulations shall fix the maximum period of time within which to file the opposition.

In this regard, Section 123.1 (d) of the same Code provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date in respect of the same goods or services or closely related goods or services, or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

There is no dispute that the contending marks are identical as shown below:

CAIDA

Opposer's mark

CAIDA

Respondent-Applicant's mark

Also, the marks are used on the same or closely related goods falling under Class 19 of the International Classification of goods.

The records show that the Respondent-Applicant applied for registration of the mark CAIDA on 02 June 2010, earlier than the filing of Opposer's trademark application on 07 September 2010. Be that as it may, the earlier filing of Respondent-Applicant's trademark application will not suffice to allow the same for registration.

While it is true that the Respondent-Applicant has prior application for the mark CAIDA than the Opposer, the evidence shows that the subject mark has already been used in commerce in the Philippines as early as 2008⁴. The Import Commodity Clearance Certificate issued by the Department of Trade and Industry to the Opposer on 06 November 2008 covers imported ceramic tile under the brandname CAIDA.

⁴ Exhibit "A"

This only shows that the mark CAIDA is already owned by another person or entity and uses it for ceramic tile before the Respondent-Applicant filed a trademark application.

Thus, because the Respondent-Applicant is not the owner of the mark, the latter has no right to register it. In fact, even if in the unlikely event that the Respondent-Applicant obtains registration, the registration may be cancelled or revoked.

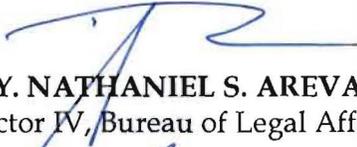
The Supreme Court in the case of *Berris v. Norvy Abyadang*⁵, has categorically ruled that:

"The ownership of a trademark is acquired by its registration and its actual use by the manufacturer or distributor of the goods made available to the purchasing public. Section 122 of R.A. No. 8293 provides that the rights in a mark shall be acquired by means of its valid registration with the IPO. A certificate of registration of a mark, once issued, constitutes prima facie evidence of the validity of the registration, of 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. R.A. No. 8293, however, requires the applicant for registration or the registrant to file a declaration of actual use (DAU) of the mark, with evidence to that effect, within three (3) years from the filing of the application for registration; otherwise, the application shall be refused or the mark shall be removed from the register. In other words, the prima facie presumption brought about by the registration of a mark may be challenged and overcome, in an appropriate action, by proof of the nullity of the registration or of non-use of the mark, except when excused. Moreover, the presumption may likewise be defeated by evidence of prior use by another person, *i.e.*, it will controvert a claim of legal appropriation or of ownership based on registration by a subsequent user. This is because a trademark is a creation of use and belongs to one who first used it in trade or commerce."

WHEREFORE, premises considered the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2010-005935 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate actions.

SO ORDERED.

Taguig City, 24 October 2013.


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


⁵ G. R. No. 183404, 13 October 2010.