



BOI TRADING COMPANY, LTD.,
Petitioner,

-versus-

RISHI N. MIRANI,
Respondent-Registrant.

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IPC No. 14-2013-00482
Petition for Cancellation:
Registration No. 4-2012-009692
Date Issued: 09 August 2013
TM: "SMITH AND JONES"

X-----X

NOTICE OF DECISION

VERA LAW
DEL ROSARIO RABOCA GONZALES & GRASPARIL
Counsel for Petitioner
2nd Floor A & V Crystal Tower
105 Esteban Street
Legaspi Village, Makati City

RISHI N. MIRANI
Respondent-Registrant
Kampri Building
2254 Don Chino Roces Avenue
Makati City

GREETINGS:

Please be informed that Decision No. 2015 - 50 dated April 07, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, April 07, 2015.

For the Director:

Edwin A. Dating
Atty. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs



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IPC No. 14-2013-00482

Petition for Cancellation
Registration No. 4-2012-009692
Date Issued: 09 August 2013

Trademark: **"SMITH AND JONES"**
Decision No. 2015- 50

DECISION

BOI Trading Company, Ltd.¹ ("Petitioner") filed a petition to cancel Trademark Registration No. 4-2012-009692. The registration issued on 09 August 2013 to Rishi N. Mirani² ("Respondent-Registrant") covers the mark "SMITH AND JONES" for the use on *"fashion accessories, namely: necklace, bracelet, earrings, ring, set jewelry, fancy jewelry, watches, bangles, charms, cuffs, chokers, brooch", "fashion accessories, namely: belts, bags, beads", "clothing, namely: sportswear and casual wear for men, wt-shirtsomen and children, specifically shirts, t-shirts, jogging suits, trousers, jeans, shorts, tank tops, rainwear, cloth bibs, skirts, blouses, polos, dresses, suspenders, sweaters, jacket, coats, raincoats, ties, robes, hats, caps, sunvisors, belts, scarves, sleepwear, pajamas, lingerie, underwear, socks, swimwear, pants, shirts, poloshirts, jumpers, children tops and bottoms, round neck t-shirts, shoes, boots, sandals, women shoes, sneakers, overshoes, clogs & tongs; headbands'* and *"hair accessories, namely: ribbon, hair pins, hair clips, pony tail, hair stick, hair claw, hair barette, 3 pong hair forks, hair clamps, bobby pins, banana pins, bun holder, ponytail holder and point pins"* under Classes 14, 18, 25 and 26, respectively, of the International Classification of Goods.³

The Petitioner alleges that the Respondent-Registrant's existing registration for the mark "SMITH AND JONES" should be cancelled for being identical to its own mark. According to the Petitioner, when its company was founded by Ms. Diane Bellamy and Mr. Ama Singh in 1994, it primarily engaged in the wholesale sales of other clothing brands such as Wrangler, Levi's, Lee and Pepe. In view of its marketing success, it developed its own brand, which includes "SMITH AND JONES", which was first conceived in 2005, taken from an old American western series in the '70s and conceived to market a Western-inspired denim and casual wear brand. After the conception thereof, the brand was marketed in the United Kingdom in 2005 and since then, the Petitioner produced several designs for each season covering a

¹ A company duly organized and existing under the laws of France, with business address at 12 rue Ampère F-91430 Igny, France.

² With address at 54 Scout Torillo Street, Quezon City, Philippines.

³ The 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 Organization. The treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purpose of the Registration of Marks concluded in 1957.

wide variety of products. In view of the brand's success and to protect the growing goodwill thereof, it obtained several trademarks worldwide. It believes that the substantial sales worldwide of "SMITH AND JONES" were a result of its aggressive marketing and promotional strategies.

In support of its petition, the Petitioner submitted the affidavit-direct testimony of Diane Bellamy⁴, with annexes.

This Bureau issued a Notice to Answer dated 03 March 2014 and served a copy thereof upon the Respondent-Registrant. However, Respondent-Registrant failed to comply. Accordingly, the Hearing Officer issued on 16 May 2014 Order No. 2014-642 declaring the Respondent-Registrant in default and the case submitted for decision.

Essentially, the issue to be resolved is whether Registration No. 4-2012-009692 should be cancelled.

Section 138 of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides that:

Sec. 138. Certificates of Registration. - 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.

As a holder of a trademark registration, the Respondent-Registrant enjoys, among other things, the presumption of ownership of the mark "CROSSHATCH". Thus, the party who seeks cancellation of this trademark registration has the burden to prove compliance with the requirements and existence of the grounds for the revocation as provided for in Section 151 of the IP Code, to wit:

(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. If the registered mark becomes the generic name for less than all of the goods or services for which it is registered, a petition to cancel the registration for only those goods or services may be filed. A registered mark shall not be deemed to be the generic name of goods or services

⁴ Exhibit "C".

solely because such mark is also used as a name of or to identify a unique product or service. The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.

(c) At any time, if the registered owner of the mark without legitimate reason fails to use the mark within the Philippines, or to cause it to be used in the Philippines by virtue of a license during an uninterrupted period of three (3) years or longer.

In this regard, this Bureau finds that the Petitioner failed to present substantial evidence to overcome the presumption of validity of the Respondent-Registrant's trademark registration. Substantial evidence is more than a mere scintilla of evidence. It means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion, even if other minds equally reasonable might conceivably opine otherwise.⁵ The burden of proof still rests on the shoulder of the Petitioner, notwithstanding the fact that the Respondent-Registrant has been declared in default.

The only evidence submitted by the Petitioner is the affidavit-direct testimony of Diane Bellamy with attached annexes consisting of what appears to be Petitioner's products and advertisements thereof, list of its pending applications and registration, a supposed documentation of its total sales and the Respondent-Registrant's certificate of registration. None of these support its claim of ownership and/or prior use of the mark "SMITH AND JONES". Not even a single copy of the Petitioner's purported application and/or registration was presented. Even the documents showing the "Total Sales" appears to be a mere printout and uncertified. Hence, statement of Diane Bellamy in her affidavit-direct testimony is bereft of merit and wanting of supporting evidence. In so ruling, this Bureau simply defers to the basic rule in evidence that each party must prove his affirmative allegation. The basic rule is that mere allegation is not evidence, and is not equivalent to proof.⁶

WHEREFORE, premises considered, the instant petition for cancellation is hereby **DISMISSED**. Let the filewrapper of Trademark Registration No. 4-2012-009692 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 07 April 2015.


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

⁵ Primo C. Miro vs. Marilyn Mendoza Vda. De Erederos, G.R. No. 172532, 172544-55, 20 November 2013.

⁶ Hector C. Villanueva vs. Philippine Daily Inquirer, Inc., G.R. No. 164437, 15 May 2009.