



**LUKFOOK HOLDINGS COMPANY
LIMITED,**

Petitioner ,

-versus-

SAMUEL G. BANTAY,

Respondent-Registrant.

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IPC No. 14-2013-00273

Petition for Cancellation of:

Reg. No. 4-2011-009054

Date Issued: 28 June 2012

**Trademark: "LUKFOOK
JEWELLERY WITH
CHINESE CHARACTERS
AND DEVICE"**

Decision No. 2015- 111

ORDER

LUKFOOK HOLDINGS COMPANY LIMITED¹ ("Petitioner") filed a petition to cancel Trademark Registration No. 4-2011-009054. The registration, issued to **Samuel G. Bantay** ("Respondent-Registrant")², covers the mark "**LUKFOOK JEWELLERY WITH CHINESE CHARACTERS AND DEVICE**" for use on "*silver accessories namely rings, earrings, necklace, bracelets*" under Class 14 of the International Classification of Goods and Services.³

The Petitioner anchors its case on Sections 121, 123 and 151 of Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), claiming that it is the owner and prior and continuous user of the subject trademark. According to the Petitioner, the mark registered by the Respondent-Registrant is identical and confusingly similar to its "LUKFOOK" trademarks and covers the same class of goods or products.

In support of its petition, the Petitioner, submitted as evidence a copy of the Trademark Reg. No. 4-2011-009054, the affidavit of its Director Ho Lung Danny Wong with annexes, as follows:

1. Annual Report of LukFook Holdings (International) Limited of year 2012,
2. The Interim Report of LukFook Holdings (International) Limited of year 2012/2013;

¹ A corporation duly organized and existing under the laws of Hong Kong, with address at Luk Fook Jewellery Centre, No. 239 Temple Street, Jordan, Kowloon, Hong Kong.

² With address at 2H C-03 168 Shopping Mall, Soler Street, Binondo, Manila .

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on a 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 Purposes of the Registration of Marks concluded in 1957.

3. schedule of the company's worldwide registrations and applications for the Luk Fook marks including the length of use information;
4. copies of certificates of registrations and the filing evidence of the applications worldwide registrations and applications, as well as the certified true copies of the printout from the respective trademark registration offices;
5. schedule showing the number of the LUKFOOK shops and the countries where these shops are located, and the sample photographs thereof;
6. list of awards and recognition from 2000-2012 and copies of the awards/recognition;
7. summary of advertisements featuring the LUKFOOK marks from 2000 to 2012 and relevant promotional materials;
8. Bloomberg lists showing LukFook Holdings (International) Limited is one of the top-ranking jewelry and watches retail listed companies in the world;
9. protection of copyright infringement with supporting materials; and
10. official confirmation of Petitioner's mark as China's "Well-Known mark".

The Petitioner also submitted trademark applications/registrations in the Philippines for the LUKFOOK marks.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Registrant on 10 August 2013. The Respondent-Registrant, however, did not file an Answer. Accordingly, this Bureau issued Order No. 2014-020 declaring the Respondent-Registrant in default and the case deemed submitted for decision.

The Petitioner filed on 27 January 2015 an "EX-PARTE MANIFESTATION RE: NON-FILING OF DECLARATION USE FOR THE SUBJECT REGISTRATION". In the manifestation, the Petitioner makes reference to its trademark applications covering variants of the "LUKFOOK" marks which were rejected on account of the Respondent-Registrant's trademark registration. According to the Petitioner, the rejection of the applications is on appeal before the Director of the Bureau of Trademarks. It cites and attached a copy of the Trademark Examiner's "Answer" to the appeals, wherein it is mentioned the "*non-filing of the required 3rd year Declaration of Actual Use (DAU) within the prescribed period in order to maintain Registration No. 4-2011-009054*".

Succinctly, Sec. 124.2 of the IP Code provides that the "*applicant or the registrant shall file a declaration of actual use of the mark with evidence to that effect, as prescribed by the Regulations within three (3) years from the filing date of the application. Otherwise, the application shall be refused or the mark shall be removed from the Register by the Director⁴*". In this regard, the Trademark Registry⁵, the contents of which this Bureau can take cognizance of via judicial notice, the status of Trademark Reg. No. 4-2011-009054 reads as "*Removed from the register for non-use*".

Considering therefore, that Trademark Reg. No. 4-2011-009054 had already been removed from the Trademark Registry, there is no more trademark registration to cancel.


⁴ Refers to the Director of Trademarks.

⁵ Accessible to the public via www.ipophl.gov.ph.

WHEREFORE, premises considered, the instant Petition for Cancellation is hereby **DISMISSED** for being moot. Let the filewrapper of the subject trademark registration be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 03 June 2015.



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

Copy furnished:

OFFICE OF BAGAY-VILLAMOR & FABIOSA

Counsel for the Petitioner
Unit 107, Oakridge Business Center A
No. 880 A.S. Fortuna St., Banilad
Mandaue City, Cebu

SAMUEL G. BANTAY

Respondent-Registrant
2H C-03 168 Shopping Mall
Soler Street, Binondo
Manila