

SHEN LI MING,
Petitioner,

-versus-

**JAN WEI QUI a.k.a. SUNNY BEO
FRANCISCO,**
Respondent-Registrant.

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IPC No. 14-2013-00068
Petition for Cancellation:
Registration No. 4-2011-015433
Date Issued: 06 September 2012
TM: **"MR. DATA"**

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NOTICE OF DECISION

MANTARING BAGASBAS & ASSOCIATES LAW OFFICE

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Paranaque City

JAN WEI QUI a.k.a. SUNNY BEO FRANCISCO

Respondent-Registrant
Elegant Tower, Galleria de Binondo
Rm. 1003, Numancia, Binondo, Manila

GREETINGS:

Please be informed that Decision No. 2015 - 261 dated November 11, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, November 11, 2015.

For the Director:


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

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IPC No. 14-2013-00068

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Registration No. 4-2011-015433
Date Issued: 06 September 2012

Trademark: **"MR. DATA"**

Decision No. 2015- 261

DECISION

Shen Li Ming¹ ("Petitioner") filed a petition to cancel Trademark Registration No. 4-2011-015433. The registration issued on 06 September 2012 to Jan Wei Qui a.k.a. Sunny Beo Francisco² ("Respondent-Registrant") covers the mark "MR. DATA" for use on "*blank cdr, dvdr disc*" under Class 09 of the International Classification of Goods.³

The Petitioner alleges that he is the author, creator and prior user of the marks "SUMAX" and "MR. DATA" and that since 2009, he has been importing, selling and distributing DVDs and Optical Devices using the said marks. According to the Petitioner, he, with other individuals including Respondent-Registrant, decided to form a corporation which was later named as "Blue-Ray DVD-R King Inc.". On 08 June 2010, a Certificate of Incorporation was by the Securities and Exchange Commission (SEC) wherein the Petitioner and the Respondent-Registrant are Incorporators and at the same time members of the Board of Directors of the company. In order for Blue-Ray DVD-R Inc., to effectively conduct business, Petitioner allowed the company to use the trademarks "SUMAX" and "MR. DATA". Blue-Ray DVR-R King Inc. was given license by the Optical Media Boards (OMB) to import and distribute recordable disk which it subsequently marked and marketed as "SUMAX" and "MR. DATA".

The Petitioner moreover avers that the Respondent-Registrant was the President of the company. Acting as President, the Respondent-Registrant allegedly filed and/or directed the filing of cases for violation of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), concerning the trademarks "SUMAX" and "MR. DATA", among others. In this view,

¹ Of legal age, Chinese citizen, with postal address at No. 2208 Balagtas St., Pasay City.

² With known address at 462 C. Palanca Street, Quiapo, Manila, Metro Manila, 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.

Republic of the Philippines

INTELLECTUAL PROPERTY OFFICE

the Petitioner asserts that the Respondent-Registrant is estopped from claiming ownership over the subject mark. In support of the petition, the Petitioner submitted the following as evidence:⁴

1. copies of the import documents;
2. copies of the Certificate of Incorporation and Articles of Incorporation of Blue-Ray DVD-R King Inc.;
3. photocopy of the license given by the OMB;
4. copies of the bill of lading wherein Blue-Ray DVD-R King Inc. is the consignee;
5. copy of the Special Power of Attorney (SPA) in favor of Renato Antonia;
6. affidavit of Renato Antonia;
7. affidavit of Allan A. Uy;
8. copy of the certification issued by the Respondent-Registrant on 12 June 2012;
9. photocopy of the Registrability Report for "SUMAX";
10. copy of the letter signed by the Respondent-Registrant to the Director of Trademarks;
11. photocopy of the letter signed by Respondent-Registrant to the OMB; and
12. photocopy of the Corporate Secretary's Certificate dated 02 May 2011.

This Office notes, however, that the Petitioner did not submit or present the originals or certified true copies of the following:

1. import document dated 12 June 2009 (Exhibit "A-2");
2. license to operate issued by the OMB (Exhibits "D" to "D-1");
3. bills of lading dated 01 December 2011, 15 December 2011 and 22 December 2011 (Exhibits "E", "E-1", "E-4", "E-5", "E-8", "E-9" and "E-10");
4. SPA in favor of Renato Antonia (Exhibit "F");
5. Application for Search Warrant No. 12-19725 (Exhibit "H-3");
6. Registrability Report for "SUMAX" (Exhibit "J");
7. letter signed by Respondent-Registrant to the OMB (Exhibit "L"); and
8. Corporate Secretary's Certificate dated 02 May 2011 (Exhibit "M").

Section 7(c) of Rule 2 (General Provisions; Proceedings) of the Amendments to the Rules and Regulations on Inter Partes Proceedings⁵ provides that:

"Section 7. Filing Requirements for Opposition and Petition –

⁴ Marked as Exhibits "A" to "M".

⁵ Office Order No. 99, Series of 2011.

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(c) For the purpose of the filing of the opposition, the oppose may attach, in lieu of the originals or certified copies, photocopies of the affidavits of its witnesses and other documentary evidence, and photographs of object evidence subject to the presentation or submission of the originals and/or certified true copies thereof under Section 13 of this Rule."

This Bureau also issued Order No. 2014-1042 directing the Petitioner to provide the correct/accurate address where the Notice to Answer can be served to the Respondent-Registrant or cause the notice by publication. On 29 October 2014, the Petitioner filed its compliance. The Respondent-Registrant, on the other hand, did not file an Answer. Accordingly, the Hearing Officer issued on 21 April 2015 Order No. 2015-604 declaring the Respondent-Registrant in default and the case submitted for decision.

Essentially, the issue to be resolved is whether Registration No. 4-2011-015433 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 "MR. DATA". 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 151.1 of the IP Code, to wit:

"Section 151. Cancellation. - 151.1. 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. 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 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."

The Petitioner asserts that the subject registration should be cancelled as it is he or, in alternative, Blue Ray DVD-R, Inc., is the owner of the mark "MR. DATA".

Anent Petitioner's contention that he is the owner of the trademark "MR. DATA", the same must fail. His claim that he is the author, creator and/or prior user of the said mark is baseless and self-serving. He submitted import documents (Exhibits "A", "A-1" "A-3" to "A-5") supposedly to corroborate the same and yet, nowhere in those documents does his name, "Shen Li Ming", appear. No other evidence is presented to support his claim.

As to the Petitioner's claim that it is the corporation Blue Ray DVD-R, Inc. which is the true owner of the subject mark, this Bureau finds that the same is likewise unsupported by substantial evidence. The affidavit and Applications for Search Warrants executed by one Renato Antonio and Police Inspector Allan A. Uy, respectively, merely proves that the Respondent-Registrant is the General Manager of the said corporation. These documents do not establish that the corporation contests the authority of the latter to register the mark "MR. DATA" under his name. Nor do these documents prove the corporation's use of the subject mark.

Therefore, 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.⁶ The burden of proof still rests on the shoulder of

⁶ Primo C. Miro vs. Marilyn Mendoza Vda. De Erederos, G.R. No. 172532, 172544-55, 20 November 2013.

the Petitioner, notwithstanding the fact that the Respondent-Registrant has been declared in default.

WHEREFORE, premises considered, the instant petition for cancellation is hereby **DISMISSED**. Let the filewrapper of Trademark Registration No. 4-2011-015433 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 11 November 2015.


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