

MISS ASIA PACIFIC INTERNATIONAL, LTD. Petitioner)	IPC No. 14-2014-00437 Petition for Cancellation Reg. No. 4-2011-000546 Date Issued: 31 May 2012 TM: "Miss Asia Pacific International and Device"
	}	
- versus -	}	
	}	
ELITE ASIA PACIFIC GROUP, INC, Respondent-Registrant.	}	
	}	
X-----X		

NOTICE OF DECISION


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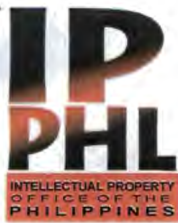
ESCAÑO SARMIENTO AND PARTNERS
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GREETINGS:

Please be informed that Decision No. 2016 - 285 dated August 16, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, August 16, 2016.


Atty. Leonardo Oliver Limbo
 Adjudication Officer
 Bureau of Legal Affairs



MISS ASIA PACIFIC INTERNATIONAL, LIMITED,

IPC NO. 14 – 2014 - 00437

Petitioner,

Cancellation of:

TM Registration No. 4-2011-000546

- versus -

TM: “Miss Asia Pacific International and Device”

ELITE ASIA PACIFIC GROUP INC.,

DECISION NO. 2016 - 285

Respondent Registrant.

x-----x

DECISION

MISS ASIA PACIFIC INTERNATIONAL, LIMITED, (Petitioner)¹, filed a Petition for Cancellation of Trademark Registration No. 4-2011-000546. The subject trademark registration issued to ELITE ASIA PACIFIC GROUP, INC. (Respondent-Registrant)², covers the mark “Miss Asia Pacific International and Device” for use on services dealing with “arranging beauty contests, organizing beauty contests, party planning (entertainment), party arranging and conducting, arranging fashion shows, organizing fashion shows” under Class 41 of the International Classification of Goods.³

The pertinent allegations in the Verified Petition for Cancellation are quoted as follows:

3. Certificate of Registration No. 4-2011-000546 was issued to Respondent on 31 May 2012 for Class 41 services i.e. arranging beauty contests, organizing beauty contests, party planning (entertainment), party arranging and conducting, arranging fashion shows, organizing fashion. Pursuant to Section 151 (a) of the Intellectual Property Code and Section 151 (a) of the Intellectual Property Code and Section 2(a), Rule 8 of the Regulations on Inter Partes Proceedings, as amended, Petitioner has five years from said date of registration, or until 31 May

¹ A corporation organized under the laws of British Virgin Islands with business address 2207 China Insurance

² A corporation incorporated in Republic of Korea, with business address at Suite 204, Isville2, 527-3 Gojan-dong, Danwon-gu, Ansan-si, Gyeonggi-do, Republic of Korea

³ The Nice Classification of Goods and Services is for registering trademarks and service marks based on multilateral treaty administered by the World Intellectual Property Office, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

2017, within which to file a petition for the subject trademark's cancellation. The instant Petition is thus seasonably filed.

x x x

4. Petitioner is the organizer of the Miss Asia Pacific International pageant, a beauty pageant participated in by nearly fifty countries in Asia, the Pacific and the rest of world. The pageant was known as Miss Asia Quest (from 1968 to 1984), Miss Asia Pacific Quest (from 1985 to 2004) and Miss Asia Pacific International (from 2004 to 2005).

4.1. The first Miss Asia Quest pageant was held on 8 December 1968 at the Araneta Coliseum. Candidates from Australia, Borneo, Burma, Ceylon, Guam, Hong Kong, India, Indonesia, Israel, Japan, Korea, Laos, Macao, Malaysia, Nepal, New Zealand, Okinawa, Pakistan, Philippines, Singapore and Thailand participated in the said pageant. x x x

4.2. From 1968 to 1980, the Miss Asia Quest pageant continued to be held in different venues in the Philippines. The pageant was then hosted in Malaysia in 1981 and 1982.

4.3. In 1984, the organizers began to invite countries and territories in the Pacific to participate in the pageant. The new participants included Colombia, Ecuador, Guatemala, Mexico, Canada and North America. To celebrate the participation of this new group of countries, the pageant was renamed "Miss Asia Pacific Quest" and held in New Zealand in October 1984. x x x

4.4. By 1985, "Miss Asia Pacific Quest" had registered close to forty (40) affiliate countries or territories. From 1985 to 1989, the pageant was held in Hongkong.

4.5. In 1990 and 1991, the pageant went on a two-year hiatus. In 1992, it returned to its original home, the Philippines. Beginning that year until 1993, the pageant was held in various places in the country: Manila 1993 and 2004, Cebu in 1994, Baguio in 1995, Subic in 1996, Davao in 1997, Pampanga in 1998, Quezon City in 1999, 2000 and 2002, and Makati City in 2001. x x x

4.6. In 2003, the pageant began utilizing the design in the Subject Mark as its distinct device. x x x

4.7. On 6 August 2004, the organizers of the pageant formally changed their name to Miss Asia Pacific International, Limited. In 2005, the pageant followed suit and adopted the name "Miss Asia Pacific International." The pageant was held in Guangzhou, China.

4.8. At present, Petitioner has a network of more than 70 countries and territories and is acknowledged as the first and oldest international beauty pageant in Asia.

5. Despite having changed its name twice, the pageant has maintained its identity by always retaining the dominant feature of its name "Miss Asia Pacific."

5.1. The Petitioner through the use of marketing and advertising materials, promoted the use of the term "Miss Asia Pacific," to refer to the pageant and its winners. x x x

5.2. In the Philippines, in particular, Petitioner's pageant was referred to by the media and the public as "Miss Asia Pacific." x x x

6. On 24 October 2013, Petitioner filed an application with the Bureau of Trademarks (BOT) for the registration of the mark "Miss Asia Pacific International and Device." However, the trademark examiner did not give due course to Petitioner's application because another entity, Respondent Elite Asia had already registered the "Miss Asia Pacific International" mark, albeit with a different design.

6.1. Based on Petitioner's investigation, Respondent was the organizer of a new pageant named "Miss Asia Pacific World Supertalent." According to its website (www.missasiapacificworldstar.com), the said pageant was first held in 2011. All four pageants to date have been held in South Korea.

The Petitioner based its petition on the following grounds:

1.) The cancellation of Respondent's "Miss Asia Pacific International & Device" registration is warranted, as the said registration was made in violation of the rights of Petitioner, the true owner of the "Miss Asia Pacific Quest" and "Miss Asia Pacific International" marks;

2.) Respondent's registration violates Petitioner's right as true owner, by prior adoption and use, of the "Miss Asia Pacific Quest" and "Miss Asia Pacific International" marks;

3.) Respondent's registration and use of a mark, which contains "Miss Asia Pacific" as the dominant feature, will prejudice Petitioner. It will cause confusion to the public and erode the reputation of the "Miss Asia Pacific" pageant organized by Petitioner for over four decades; and

4.) Respondent's Registration infringes upon Petitioner's registered business name "Miss Asia Pacific International, Limited."

The Petitioner submitted the following evidence:

- Exhibit "A" - Judicial Affidavit of Mr. Roberto de Venecia;
- Exhibit "B" - Copy of the Memorandum of Association of Miss Asia Pacific International Limited;
- Exhibit "C" - Copy of Miss Asia Pacific International Limited Profile;
- Exhibit "D" - Copy of the poster of the 1968 Miss Asia Pageant;
- Exhibit "E to E-13" - Photograph Copy of the front cover pages of the Miss Asia Pacific Quest souvenir program;
- Exhibit "F to F-44" - Copy of the Selected Picture of Miss Asia Pacific pageant winners;
- Exhibit "G to G-7" - Pictures of the Miss Asia Pacific Beauty Pageant Activities;
- Exhibit "H to H-5" - Copies of the Miss Asia Pacific Beauty Pageant Souvenir Programs;
- Exhibit "I" - Copies of Miss Asia Pacific International Official Delegate's Handbook;
- Exhibit "J to J-13" - Copies of newspaper articles on the Miss Asia Pacific Pageant held in the Philippines;
- Exhibit "K to K-2" - Copies of the Pictures of the Winners of Miss Asia Pacific;
- Exhibit "L" - Compact Disc of the Video Coverage of the Mutya ng Pilipinas 2014;
- Exhibit "M" - Copy of the Application Documents of Miss Asia Pacific International Limited for the mark Miss Asia Pacific International;
- Exhibit "N to N-1" - Print out of the Miss Asia Pacific World Supertalent Website;
- Exhibit "O to O-2" - Copy of Trademark Examiner Registrability Report and subsequent action for the trademark application of the Petitioner for the mark Miss Asia Pacific International and Device mark; and
- Exhibit "P to P-1" - Copy of Responsive Actions filed by the Petitioner with respect to Miss Asia Pacific International and Device mark.

This Bureau issued a Notice to Answer dated 9 October 2014 and received by the Respondent-Registrant on 13 October 2014. However, the Respondent-Registrant did not file an Answer to the Petition. In view of the failure to file an Answer, an Order declaring the Respondent-Registrant in default was issued and received by Respondent-Registrant on 11 February 2015. Consequently, this case was deemed submitted for decision.

The issue to be resolved in this case is whether the trademark "Miss Asia Pacific International and Device" covered by Trademark Registration No. 4-2011-000546 should be cancelled.

Under the Intellectual Property Code, it provides that:

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. x x x [emphasis supplied]

The actual competing marks of both parties are reproduced below for comparison.



MISS ASIA PACIFIC INTERNATIONAL

Respondent-Registrant's Mark



MISS
ASIA PACIFIC
INTERNATIONAL

Petitioner's Mark

The above competing marks contain an identical word mark "Miss Asia Pacific International." While there is variance in the devices used in the trademarks, the difference is merely negligible considering that the devices has no distinct and separate identity apart from the labeling word marks. Thus, the two competing trademarks are similar and leave the same impression that would result to public confusion.

A perusal of the records shows that Petitioner has been organizing beauty pageants with participants coming from different countries as early as 1968.⁴ Its pageant was first named Miss Asia Quest, then change to Miss Asia Pacific Quest in 1984, and finally, Miss Asia Pacific International sometime in 2005.⁵ The Petitioner has shown that it was the first one to use the "Miss Asia Pacific"⁶ mark and the "Miss Asia Pacific International"⁷ mark as the title of beauty pageants. The pageants were

⁴ Exhibits "A", "C" "D" and "F"

⁵ Exhibits "A", "D" and "E to E-13"

⁶ Exhibits "E" to "E-13"

⁷ Exhibit "I"

held in different parts of the Philippines and abroad.⁸ The said events were advertised in the national newspapers and magazines.⁹ On the other hand, it was only on 18 January 2011, when the trademark “Miss Asia Pacific International and Device” was applied for registration by Respondent-Registrant, to cover the similar and related services of: arranging beauty contests, organizing beauty contests, party planning (entertainment), party arranging and conducting, arranging fashion shows, and organizing fashion shows.

Clearly, the Petitioner has sufficiently shown that it was the prior adopter and user of the wordmarks “Miss Asia Pacific” or the “Miss Asia Pacific International,” which are confusingly similar to the Respondent’s registered mark “Miss Asia Pacific International and Device.” Notably, the Respondent-Registrant did not controvert the same nor present evidence to support its own claim over the mark.

Moreover, the Petitioner has also shown that the wordmark “Miss Asia Pacific International” was also the Petitioner’s trade name.

Under Section 165.2 of the IP Code expressly provides:

“Sec. 165.2 (a) Notwithstanding any laws or regulations providing for any obligation to register trade names, such names shall be protected, even prior to or without registration, against any unlawful act committed by third parties.

(b) In particular, any subsequent use of the trade name by a third party whether as a trade name or a mark or collective mark, or any such use of a similar trade name or mark, likely to mislead the public shall be deemed unlawful.” (Emphasis supplied)

The Supreme Court has defined trade name as any individual name or surname, firm name, device or word used by manufacturers, industrialists, merchants and others to identify their businesses, vocations, or occupations.¹⁰ The petitioner was incorporated under the tradename “Miss Asia Pacific International, Limited” on August 6, 2004,¹¹ while the application of Respondent-Registrant for the subject trademark came only seven (7) years after.¹² Verily, the appropriation of a mark which is already a trade name belonging and used by another could likely result in the public being misled on the goods or services and on the origins thereof. This is especially true in the instant case, since both of the competing marks covers the same or very much related services and industry.

⁸ Exhibits “A”, “G to G-7” “H to H-5”, “I” and “J to J-13”

⁹ Exhibits “A”, “J-1 to J-13” and “L”

¹⁰ Converse Rubber Corporation vs. Universal Rubber Products, G.R. No. L-27906, 8 January 1987

¹¹ Exhibit “B”

¹² Trademark Application Documents filed by the Respondent-Registrant

The protection to trademarks and trade names was emphasized by the Supreme Court in *U.S. v. Kyburz*,¹³ to wit:

“Trade names are protected against use or imitation upon the ground of unfair competition, and an examination of the statute clearly indicates its purpose to protect the manufacturer or dealer as well as the public.

The rule which protects against unfair competition is primarily for the protection of the party against whom such competition is directed, and only incidentally for the protection of the public. In some of the case language is used which would suggest that the public is under the protection of the court, but in fact the liability of the article to mislead the public from being misled, except in so far as it is necessary to protect the owner of a business from its fraudulent invasion by others. If what is done tends to mislead the public, it naturally diverts customers from the complaint, to the injury of his business. The prohibition is upon so acting as to beguile the public, and thus mislead an intending purchaser into buying the goods of one person under the belief that he is buying those of a rival. (Paul on Trademarks, sec. 215.) xxx”

The Supreme Court further explained the importance of protecting trade names, to wit:

“The purpose of such suit is to protect its reputation, corporate name and good will which has been established through the natural development of its trade for a long period of years, in the doing of which it does not seek to enforce any legal or contract rights arising from or growing out of any business which it has transacted in the Philippine Islands. The right to the use of the corporate or tradename is a property right, a right in rem, which it may assert and protect in any of the courts of the world – even in jurisdictions where it does not transact business – just the same as it may protect its tangible property, real or personal against trespass or conversion.”¹⁴

¹³ G.R. No. L9458, 24 November 1914


¹⁴ General Garments Corporation vs. The Director of Patent and Puritan Sportswear, G.R. No. L 24295, 30 September 1971

Finally, it is well-settled that registration of a trademark merely creates a prima facie presumption of the validity of the registration, of the registrant's ownership of the trademark, and of the exclusive right to use thereof.¹⁵ Such presumption is rebuttable and must give way to the evidence to the contrary.¹⁶ In the instant case, the Petitioner has sufficiently proven its better right over the subject trademark. Thus, the registration of the Respondent's trademark was contrary to the provision of the IP Code and should be cancelled.

WHEREFORE, premises considered, the instant Petition for Cancellation is hereby **GRANTED**. Accordingly, the Certificate of Registration No. 42011000546 is **CANCELLED**. Let the filewrapper be returned together with a copy of this Decision to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Taguig City, **16 AUG 2016**


Leonardo Oliver Limbo
Adjudication Officer
Bureau of Legal Affairs

¹⁵ Birkenstock Orthopaedic GMBH and Co. KG vs. Philippine Shoe Expo Marketing Corporation, G.R. No. 194307, 20 November 2013.

¹⁶ *ibid*