

**HONGKONG JIA YI ELECTRONICS INDUSTRIES
COMPANY LIMITED,**

Opposer,

-versus-

JIQUAN LIN & WENPING CAI,
Respondent-Applicant.

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IPC No. 14-2011-00274

Opposition to:
Appl. Serial No. 4-2010-013124
Date Filed: 03 December 2010

TM: JIAYI GOLD AND DEVICE

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2016 - 536 dated 23 December 2016 (copy enclosed) was promulgated in the above entitled case.

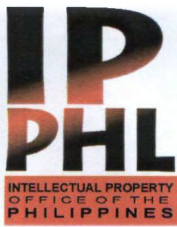
Pursuant to Section 2, Rule 9 of the IPOPHL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, 06 January 2017.

MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs

**Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE**

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HONG KONG JIA YI ELECTRONICS INDUSTRIES COMPANY LIMITED,
Opposer,

IPC No. 14-2011-00274
Opposition to:

- versus -

Appln. No. 4-2010-013124
Date Filed: 03 December 2010
Trademark: "**JIAYI GOLD AND DEVICE**"

JIQUAN LIN & WENPING CAI,
Respondents-Applicants.

Decision No. 2016 - 536

X ----- X

DECISION

HONG KONG JIA YI ELECTRONICS INDUSTRIES COMPANY LIMITED ("Opposer")¹, filed an opposition to Trademark Application Serial No. 4-2010-013124. The application, filed by JIQUAN LIN & WENPING CAI ("Respondents-Applicants")², covers the mark "JIAYI GOLD AND DEVICE" for use on *"bags and cases specially adapted for holding or carrying portable telephones and telephone equipment and accessories, cable connectors for cellular phones, carrying cases for cell phones, cases for mobile phones, cell phone back plates, cell phone battery chargers for use in vehicles, cell phone battery chargers, cell phone covers, cell phone faceplates, cell phones, cellular phone accessory charms, decorative charms for cellular telephones, devices for hands-free use of mobile phones, headsets for cellular or mobile phones, memory cards for cell phone & amp, LCD and frames for cell phone and parts"* under Class 09 of the International Classification of Goods and Services.³

The Opposer alleges that it is the adopter, prior owner and first-user of the famous trademark Jia Yi with design logo which is registered before the Trademark Bureau of the People's Republic of China covering Class 09 goods. Opposer was also issued Registration No. 4-2010-004899 on 17 February 2011 for Class 09 goods under the name HONG KONG JIA YI ELECTRONICS COMPANY LIMITED for DESIGN LOGO in the Intellectual Property Office of the Philippines. In fact, the Opposer's mark Jia Yi with design logo is well-known in China and is gaining popularity in the Philippines. The brand is recognized for its quality. Hence, the registration of the Respondent-Applicant's mark JIAYI GOLD AND DEVICE will constitute a violation of Articles 6bis and 10bis of the Paris Convention in conjunction with Sections 123.1(a) and (e) of Republic Act No. 8293.

Opposer avers to be the true owner of the mark Jia Yi with design logo since it has used the mark Jia Yi with design logo in the Philippines prior to the filing date of application of the subject mark. Opposer supplied and continuously supply goods and products containing the Jia Yi with design logo

¹ A corporation organized under the laws of Hong Kong, People's Republic of China and with main address at Flat/Rm. 915 9/F Kenning Ind. Bldg. 19 Wang Hoi Rd., Kowloon Bay, Kowloon Hong Kong.

² Represented by Atty. Jackson P. Lee with office address at 8/F Unit 603 Park Lane Tower 1107 Mayhaligue St. Tondo, Manila.

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

directly to different electronic establishments in the Philippines. The Opposer and one of its subsidiaries, Guangzhou Jia Yi Electronic Company Co. Ltd. has extensively promoted the mark Jia Yi with design logo and maintained a website www.jiayielectron.com which obtained significant exposure for the goods upon which the mark Jia Yi with design logo is used.

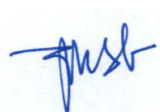
The Opposer further accounts that the subject mark JIAYI GOLD AND DEVICE was previously applied for registration but was later on changed to "Jia Yi Gold and device", removing the drawing, during the course of its examination. It is a pure reproduction and imitation of the Opposer's mark and its company name. Thus, the grounds for this instant case are as follows: (1) The Opposer did not give consent to the Respondent-Applicant for the use and registration of the trademark JIAYI GOLD AND DEVICE, or any other mark identical or similar to the Opposer's mark Jia Yi with design logo; (2) The use by the Respondent-Applicant of the mark JIAYI GOLD AND DEVICE for Class 09 products, which are identical to the goods on which the Opposer's mark Jia Yi with design logo is used, will mislead the purchasing public into believing that the Respondent-Applicant's goods are produced by, originate from, or are under the sponsorship of the Opposer; and, (3) Potential damage to the Opposer will also be caused as a result of its inability to control the quality of the products offered or put on the market by Respondent-Applicant under the imitated mark JIAYI GOLD AND DEVICE. It will take unfair advantage of, dilute and diminish the distinctive character and reputation of the Opposer's mark Jia Yi with design logo.

The Opposer's evidence consists of the following:

1. Affidavit of Mr. Yin Ri Zuo;
2. Secretary's Certificate;
3. Authentication of Trademark Registration No. 5533069 for the mark JIA YI issued by the Trademark Bureau of the National General Administration for Industry and Commerce of the People's Republic of China, including English translation;
4. Certificate of Registration No. 4-2010-004899 for the mark DESIGN LOGO issued by the Intellectual Property Office of the Philippines; and,
5. Letter dated 18 January 2011 from the Law Offices of King Capuchino Tan & Associates to the Director of Trademarks regarding third party adverse information for the mark JIAYI GOLD AND DEVICE .

On 31 August 2011, the Respondents-Applicants filed an Answer. According to Respondents-Applicants, the authority of a certain YIN RI ZUO to represent the Opposer for the purpose of filing this instant opposition is fatally defective and is therefore null and void. Opposer purportedly executed two (2) Secretary's Certificates on the same date, pertaining to as Special Board Meeting on 10 February 2011. The first one is attached to a Complaint-Affidavit dated 31 March 2011 which was filed before the Office of the City Prosecutor of Manila against Respondent-Applicant. It made no mention of giving YIN the authority to file a Verified Notice of Opposition. It was also alleged in the said Certificate that the Opposer was organized and existing under Philippine law. The second Certificate is presented in this opposition case, dated 12 July 2011. In this instance, the Opposer admitted to be a foreign corporation.

Thus, it is impossible for the members of the Board of Directors of the Opposer to come up with such a resolution, considering that on 10 February 2011, there was nothing yet to oppose. In fact, the Opposer came to know that a Notice of Allowance for the use of the trademark JIA YI GOLD AND DEVICE was issued in favor of the Respondents-Applicants only on June 2011, and the subject mark was published for opposition in the Official Gazette only on 6 June 2011. In other words, the foregoing matters all happened clearly after and much later than 10 February 2011.



Moreover, the Secretary's Certificate was not signed by the Corporate Secretary. Rather, it was merely signed by an "assistant" without showing her authority or any documentary proof in support thereto. This apparent defect can be clearly seen in the said Secretary's Certificate. The Opposer did not attach its Articles of Incorporation and the Board Resolution/s dated 10 February 2011. There is no way to find out the composition of the Board of Directors of the Opposer and the name of its Corporate Secretary and whether or not there was quorum in the alleged Special Board Meeting/s held on 10 February 2011.

It was also alleged that the Opposer, a foreign corporation, is clearly doing business in the Philippines albeit without license. In several claims and transactions, there could be no doubt that the Opposer is doing/transacting business in the Philippines.

Finally, the Respondents-Applicants alleged that they were clearly ahead of time in terms of use for the trademark JIA YI GOLD AND DEVICE. They showed samples of their old batteries and presented an affidavit of a witness in support thereto. The Opposer on the other presented no competent proof to support its allegation of a well-known mark internationally and in the Philippines, including all

The Respondents-Applicants evidence consists of the following:

1. Secretary's Certificate dated 10 February 2011 and attached to Opposer's Complaint-Affidavit;
2. TSN dated 22 March 2011 in People vs. Yeng Yong, Lin;
3. Certification dated 07 March 2011, issued by Yin Ri Zuo regarding fake/counterfeit items bought/purchased from M ZONE Mobile Phone;
4. Certification dated 07 March 2011, issued by Yin Ri Zuo regarding fake/counterfeit items bought/purchased from K & R;
5. Depositions of Applicant executed by SPO3 Joselito M. Villorente;
6. Applications for Search Warrant;
7. Complaints-Affidavit of Yin Ri Zuo;
8. Affidavits of Jiquan Lin and Wenping Cai;
9. Machine prints of the Respondent-Applicants' old batteries with production/batch date;
10. Affidavit of Mary Guillan Lagamayo;
11. Copy of Yin's Chinese Passport;
12. Articles of Incorporation of HONGKONG JIA YI ELECTRONICS INDUSTRIES COMPANY LIMITED; and,
13. Trademark Registration Certificate (Translation) of Opposer in China.

Opposer submitted its Reply on 12 September 2011; whereas, Respondents-Applicants submitted their Rejoinder on 23 September 2011. Thereafter, the Preliminary Conference was held and terminated. Position papers were submitted by parties within the allowed time.⁴

Without delving into the merits of the case, the instant opposition should be dismissed for failure to comply with the fundamental rules of procedure.

The Respondents-Applicants raised the issue that the instant opposition should be dismissed on the ground that the "Verification and Certificate of Non Forum Shopping" attached to the Notice of Opposition is fatally defective. According to the Respondents-Applicants, the authority of the person

⁴ Oppose submitted its position paper on 02 March 2012; Respondents-Applicants submitted their position paper on 01 March 2012.

who executed the Secretary's Certificate in favor of one who signed the Verification and Certification of Non Forum Shopping has not been properly established or shown.

The records show that a certain ZHANG YATING, allegedly the Assistant Corporate Secretary of the Opposer, executed and signed the Secretary's Certificate, constituting and appointing as its authorized representative, YIN RI ZUO, Operations Manager-Philippines of the Opposer . The latter signed the Verification and Certification of Non Forum Shopping on the basis of the said Secretary's Certificate. However, no document was submitted showing ZHANG YATING's authority to sign the Secretary's Certificate in behalf of the Opposer.

There being no clear proof that ZHANG YATING was authorized to sign the Secretary's Certificate, and the fact that he is not the Corporate Secretary, but only identified himself as Assistant Secretary, then the authority given by ZHANG YATING to YIN RI ZUO to sign the Verification and Certification against Forum Shopping is likewise defective.

Rule 2, Sec. 7.3 of the Rules and Regulations on Inter Partes Cases, as amended, provides:

7.3 If the petition or opposition is in the required form and complies with the requirements including the certification of non-forum shopping, the Bureau shall docket the same by assigning the Inter Partes Case Number. Otherwise, the case shall be dismissed outright without prejudice. A second dismissal of this nature shall be with prejudice.

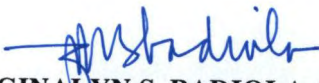
Time and again, the Supreme Court has ruled many times that "it is obligatory for the one signing the verification and certification against forum shopping on behalf of the principal party or the other petitioners that he/she has the authority to do the same."⁵ If the real party-in-interest is a corporate body, an officer of the corporation can sign the certification against forum shopping so long as he has been duly authorized by a resolution of its board of directors.⁶ If the certification against forum shopping signed by a person on behalf of a corporation, is unaccompanied by proof that said signatory is authorized to file a petition on behalf of the corporation, the same shall be sufficient ground to dismiss the case.⁷

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2010-013124 is hereby **DISMISSED**. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City

23 DEC 2016


Atty. GINALYN S. BADIOLA, LL.M.
Adjudication Officer, Bureau of Legal Affairs

⁵ Fuentebella vs Rolling Hills Memorial Park, Inc., G.R. No. 150865, 30 June 2006.

⁶ Id.

⁷ Mediserv, Inc. vs Court of Appeals, et al., G.R. No. 161368, 05 April 2000.