



INTELLECTUAL PROPERTY OFFICE OF THE PHILIPPINES

R-113

JEETENDAR N. NEBHWANI,
Petitioner,

-versus-

PETER PARKASH MOTWANI,
Respondent-Registrant.

IPC No. 14-2015-00235
Cancellation of:
Reg. No. 4-2014-005030
Date Issued: 13 November 2014

TM: TRIDENT

X-----X

NOTICE OF DECISION

~ **CORDOVA AND ASSOCIATES**
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CORDOVA & ASSOCIATES
NATL. LAWYERS **JAN 03 2017**
RECEIVED

*Recd. by
wanna law
01/14/2017*

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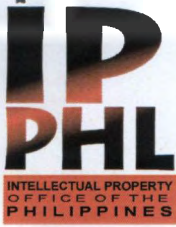
GREETINGS:

Please be informed that Decision No. 2016 - 436 dated 02 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, 05 December 2016.

Marilyn F. Retutal
MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs



JEETENDAR N. NEBHWANI
Petitioner,

versus-

PETER PARKASH MOTWANI,
Respondent-Registrant.

x-----x

IPC NO. 14-2015-00235

Cancellation of:
Registration No. 4-2014-005030
Date Issued: 13 November 2014
Trademark: **TRIDENT**

Decision No. 2016 - 436

DECISION

JEETENDAR N. NEBHWANI¹ ("Petitioner") filed on a Petition for Cancellation of Trademark Registration No. 4-2014-005030. The registration issued to PETER PARKASH MOTWANI² ("Respondent-Registrant") covers the mark "TRIDENT" for use on "Inverter; TV/cable inverter; automatic voltage regulator; CATV signal amplifier; CATV line amplifier; microphone coil; DVD lens; CPU coin selector; waistband amplifier; portable amplifier; portable DVD with built in TV; car capacitor; wiring kit gauge 8/gauge4; optical cord for audio (1.8M) (3M); PA amplifier; motor amplifier; car amplifier; speaker stand; microphone stand; USB/SD player with FM or without FM; DVD power board; capacitor"; mixer amplifier; power amplifier; power inverter; cable wire; DMX controller; wireless microphone; telephone unit; loud speaker " under Class 09 of the International Classification of goods³.

The Petitioner alleges the following grounds:

"1. The registration by the Respondent of the mark TRIDENT was issued in contravention of Section 151.1 of the Intellectual Property Code, and should be cancelled since the *registration was obtained fraudulently* by the Respondent on the false representation that it is the owner of the mark TRIDENT and such 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;*

"2. Petitioner through his company Sunil Shiela Enterprises, Inc. is the owner, prior user and the first to register the TRIDENT mark for goods under class 09 giving Petitioner proprietary rights over the TRIDENT mark. Hence, Petitioner should be protected against any subsequent attempt to register a confusingly similar or identical mark on the basis of Section 123.1(d) of the Intellectual Property Code.

"3. The registration of Respondent's mark 'TRIDENT' is contrary to the other provisions of the Intellectual Property Code of the Philippines. The registration of the Respondent's mark 'TRIDENT' will cause confusion, mistake and deception on the part of the purchasing public when applied to or used in connection with the goods of Respondent-

¹ A resident of the Philippines with address at 97 Magallanes Avenue, Magallanes Village, Makati City

² A resident of the Philippines with address at 625 Ronquillo Street, Sta. Cruz, Manila.

³ The Nice Classification is a classification of goods and services for the purpose of registering trademark and service 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
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purchasing public when applied to or used in connection with the goods of Respondent-Applicant. Under Sec. 147 of the Intellectual Property Code it states that: *in case of the use, of an identical sign for identical goods or services, a likelihood of confusion shall be presumed.*

"4. The Respondent's appropriation and registration of the TRIDENT mark is intended to ride on the reputation and goodwill of the TRIDENT mark and to mislead the Petitioner's customers and the public in general into the false belief that its products are part of the Petitioner's line of TRIDENT products, when in fact it is not. Such fraud and deceit is designed to compete unfairly with the Petitioner which is what the Intellectual Property Code seeks to prevent."

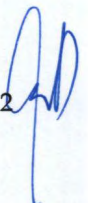
The Petitioner's evidence consists of the following:

1. Affidavit-Testimony of Jeetendar N. Nebhwani;
2. Certified copy of Registration No. 4-2006-013304 for the mark TRIDENT issued in the name of Sunil Sheila Enterprises, Inc. on 26 November 2007;
3. Certified copy of Registration No. 4-2010-010194 for the mark TRIDENT issued in the name of Sunil Sheila Enterprises, Inc. on 10 March 2011;
4. Printout of Trademark Application Serial No. 4-2014-504692 for the mark TRIDENT in the name of Petitioner filed on 07 October 2014 for Class 09;
5. Printout of details of Trademark Registration No. 4-2014-005030 for the mark TRIDENT in the name of Respondent-Registrant issued on 13 November 2014;
6. Company Profile of Sunil Sheila Enterprises, Inc.
7. Representative samples of Invoices and Packing List issued Sunil Sheila Enterprises microphones, speakers, wall clocks, etc.;
8. Representative samples of Bill of Lading, Import documents of TRIDENT products issued to Sunil Sheila Enterprises;
9. List of TRIDENT products of Petitioner;
10. History of Trident Brand;
11. Various Sales Invoices issued by Sunil Sheila Enterprises to its customers for the purchase of its TRIDENT products;
12. Photos of Petitioner's TRIDENT products as well as promotional materials and
13. Certified copy of Articles of Partnership of Metal Craft & Co.

On 22 May 2015, this Bureau issued a Notice to Answer and served a copy thereof to the Respondent-Registrant thru private courier DHL on 02 June 2015. On 23 June 2015, Respondent-Registrant filed his Answer. Respondent-Registrant argues that he is the first user of the mark TRIDENT in Manila since 1984. Respondent-Registrant also posits that he did not fraudulently obtained his registration of the mark TRIDENT. To support his contention, Respondent-Registrant submitted representative samples of sales invoices issued in 1984.

Pursuant to Office Order No. 154, s. 2010, the case was referred to the Alternative Dispute Resolution ("ADR") for mediation. However, the parties refused to undergo mediation. Upon the termination of the preliminary conference, the parties were directed to submit position papers. On 17 May 2016, Respondent-Registrant filed its Position Paper while Petitioner did so on 18 May 2016.

Should the Certificate of Registration No. 4-2014-005030 for the mark **TRIDENT** be cancelled?

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Section 138 of the IP Code provides, to wit:

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.

Since a certificate of registration is merely prima facie evidence of the validity of registration, it may be challenged or controverted. It means that the presumption can be overcome by proof of the nullity of the registration in an appropriate action. In this regard, Section 151 of the Intellectual Property Code of the Philippines ("IP Code") provides:

Sec. 151. Cancellation. -151.1 A petition to cancel a registration of 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:

x x x

(b) At any time, if the registered mark becomes 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 or in connection with which the mark is used. xxx

Petitioner is seeking the cancellation of Respondent-Registrant's TRIDENT mark on the ground that it is owner and prior user of the mark TRIDENT and that it is confusingly similar to its mark TRIDENT citing Sec. 123.1 (d) of the IP Code, to wit:

Section 123.Registrability. - 123.1. A mark cannot be registered if it:

- (d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:
- i. The same goods or services, or
 - ii. Closely related goods or services, or
 - iii. If it nearly resembles such a mark as to be likely to deceive or cause confusion;

The prohibition under the above quoted provision applies only if the competing marks are identical or confusingly similar. In this regard, the marks of the parties are depicted below for comparison:

TRIDENT

Petitioner's Mark

TRIDENT

Respondent-Registrant's Mark

Indubitably, the marks of the parties are identical. Moreover, the goods of the parties are closely related, that is, Petitioner's mark TRIDENT is used in "radio, microphone, earphones, tv, speaker, cable, rca cord, auto voltage regulator (avr), television, microphones, dvd player, tapes, radio" under

Class 9 while that of Respondent's is used in *Inverter; TV/cable inverter; automatic voltage regulator; CATV signal amplifier; CATV line amplifier; microphone coil; DVD lens; CPU coin selector; waistband amplifier; portable amplifier; portable DVD with built in TV; car capacitor; wiring kit gauge 8/gauge4; optical cord for audio (1.8M) (3M); PA amplifier; motor amplifier; car amplifier; speaker stand; microphone stand; USB/SD player with FM or without FM; DVD power board; capacitor; mixer amplifier; power amplifier; power inverter; cable wire; DMX controller; wireless microphone; telephone unit; loud speaker* "also under Class 9. As such, the use of an two identical mark for related products in the market will likely cause confusion, mistake or deception in the mind of the consumers. Thus, it behooves this Bureau to determine, who between Petitioner and Respondent-Registrant is the real and true owner of the mark TRIDENT.

Records show that Petitioner was granted registration of the mark TRIDENT in 2006. But even before the mark was registered, Petitioner was already using the mark in 2005 as shown by the sales invoice. On the other hand, Respondent-Registrant was only granted registration in 2014. So as between Petitioner and Respondent, the former is prior user and registrant of the mark TRIDENT and therefore has a better right over the subject mark. Although Respondent submitted sales invoices dated 1984, this Bureau cannot give credence to its claim of prior use. Aside from the said invoices which were issued in October and November 1984, no other proof was presented by Respondent to support that it has used the mark TRIDENT in its business. As correctly pointed out by Petitioner, P.M. Metalcraft was a partnership engaged in the business of manufacturing metal products such as baby strollers, baby walkers and other related items not microphones and other electronic products it purports to sell. On the other hand, Petitioner has presented overwhelming evidence that it has been engaged in selling microphones and other electronic products since 2005 up to the present as evidence by the sales invoices, bill of lading and other import documents and promotional materials of TRIDENT products.

Further, even assuming that Respondent sold trident microphones in 1984, still there is no evidence to show that he continued to use the mark TRIDENT after that year. Thus, at the time Petitioner applied for the mark TRIDENT in 2006, there was no bar to the registration of its mark TRIDENT. Even when Petitioner's mark TRIDENT was removed from the Register due to the non-filing of declaration of actual use (DAU), he did not abandon the use of the mark but continued to use it in its various products in commerce up to the present. This only bolsters the fact that Petitioner is real and true ownership of the mark TRIDENT and therefore, Respondent has no right to register the mark in its name.

The essence of trademark registration is to give protection to the owners of trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him who has been instrumental in bringing into the market a superior article of merchandise, the fruit of his industry and skill; to assure the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product.⁴

The intellectual property system was established to recognize creativity and give incentives to innovations. Similarly, the trademark registration system seeks to reward entrepreneurs and individuals who through their own innovations were able to distinguish their goods or services by a visible sign that distinctly points out the origin and ownership of such goods or services.⁵


⁴ *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.

⁵ See Decision, IPC No. 14-2008-00046, 21 January 2013, available at <http://onlineservices.ipophil.gov.ph/ipcaselibrary/> <accessed 28 March 2016.

WHEREFORE, premises considered, the instant petition for cancellation is hereby **GRANTED**. Let the filewrapper of Trademark Registration No. 4-2014-005030, together with a copy of this Decision, be returned to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City 02 DEC 2016


MARLITA V. DAGSA
Adjudication Officer
Bureau of Legal Affairs