





PETER KAWSEK JR.,  
Petitioner,

-versus-

AMBICA INTERNATIONAL TRADING  
CORPORATION,  
Respondent-Registrant.

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}IPC NO. 14-2011-00384  
}Petition for Cancellation  
}Reg. No. 4-2010-011361  
}Date registered: 21 April 2011  
}  
}Trademark: "NOCAL"  
}  
}  
}Decision No. 2016- 494

**DECISION**

PETER KAWSEK, JR., (Petitioner)<sup>1</sup> filed a petition for cancellation of Trademark Registration No.4-2010-011361. The registration, in the name of AMBICA INTERNATIONAL TRADING CORPORATION (Respondent-Registrant)<sup>2</sup>, covers the mark "NOCAL", for use on "non-nutritive sweetener" under Class 30 of the International Classification of Goods<sup>3</sup>.

The Petitioner anchors his petition on the following grounds:

- "1. That the Petitioner here is the first one to registered the same trademark, since March 20, 2005 (Registration No. 4-2002-000267/03-21-2005);
- "2. That prior application of Ambica of said trademark, it is still registered in the name of the petitioner, since they were filed an application on October 15, 2010 or during the grace period for the petitioner to renew the said registration;
- "3. That when it cancelled because it expires the petitioner through its representative, it was refiled again for the re-application of the registration of the said mark after it was due (Application No. 04-2011-006760/6-10-2011);

<sup>1</sup> Philippine resident with address at 415 Arayat St., Mandaluyong City

<sup>2</sup> A domestic corporation duly organized and existing under Philippine laws with business address at #9 Amsterdam Extension, Merville Park Subd., Paranaque City

<sup>3</sup> The Nice Classification of Goods and Services is for registering trademarks and service marks based on multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

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“4. That as of the time, our application is still pending as a result thereto, but it is already registered in the name of Ambica (Registration No. 42010011361);

“5. That Ambica take advantage even before the expiration of the registration;

“6. That Ambica playing mockery to the rules and regulation of the Intellectual Property Office when they applied of said marks although the subsequent registration was otherwise in full force during the grace period to renewed;

“7. That according to the Intellectual Property Code, no one can register the trademark, tradenames, patents, and/or copyright during the existence of the registered one of the same class, trademark, tradenames, patents and/or copyright. Thus, we construed that the filing of the application for registration is a registration thereto since it follows registration from the application, hence Ambica registration of the mark ‘NOCAL’ must be defective and should be declare NULL and VOID from the very beginning.xxx

“10. That the petitioner do not intend to abandoned the said trademark, evidenced by this petition, but he only forgot to monitor its registration, until it lapses the period when the petitioner should file a Declaration of Actual Use;

“11. That the petitioner continuously used the mark, in fact the product is still in the market;

“12. That we acknowledged the carelessness of the monitoring of the registration of this mark as a part of our private right, but the actuation of Ambica is playing beyond their backyard to offend others.”

To support its petition, the Petitioner submitted as evidence the following:

1. Print –out from IPO website of status of registration of “NOCAL” with Reg. No. 4-2002-000267 (filing date January 11, 2002) for goods under class 30 in the name of Peter Kawsek, Jr.;
2. Copy trademark application form 4-2011-006760 for the mark “NOCAL”;  
and
3. Print –out from IPO website of status of registration of “NOCAL” with Reg. No. 4-2010-011361 (filing date October 15, 2010) for goods under class 30 in the name of Ambica International Trading Corp.<sup>4</sup>

The Respondent-Applicant filed its Answer on 26 April 2013, alleging among other things, the following affirmative defenses:

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<sup>4</sup> Annexes “A” to “C”

“8. The Petition should be dismissed outright as it fails to state a cause of action against Respondent-Registrant.

First, while Petitioner claims to be a prior registrant of the mark NOCAL, he admitted that the same already expired through his own fault or ‘carelessness of the monitoring of the registration of this mark as part of his private right’.

Second, petitioner admitted that he failed to file a Declaration of Actual Use and proof of use within one (1) year from the 5<sup>th</sup> anniversary date of registration of the mark as required by Sec. 145 of R.A. No. 8293. As a consequence, the Hon. Office cancelled the petitioner’s claimed mark from the Register.

Third, petitioner further admitted that after it was cancelled, he re-applied for his claimed mark only on June 10, 2011 or after Respondent-Registrant’s mark was already registered on April 21, 2011.

“9. By Petitioner’s own admissions, he has not shown any right better than the Respondent-Registrant over the mark NOCAL that should be protected by the Honorable Office.

“10. On the other hand, Respondent-Registrant acquired its rights over the mark NOCAL by virtue of the registration thereof on April 24, 2011 in accordance with the provisions of RA No. 8293. Accordingly, it is entitled to all the rights of a registrant pursuant to Section 145 of R.A. No. 8293.

“11. Truth to tell, Respondent-Registrant is the actual user of the NOCAL mark in the Philippines as shown by (a) Certificates of Products Registrations issued by the Food and Drug Administration (b) copy of actual products being distributed.”

The Respondent-Registrant submitted as evidence, the following:

1. Copy of Certificate of Product Registration with BFAD Reg. No. 008859 issued on 11 September 2014;
2. Copy of Certificate of Product Registration with BFAD Reg. No. 008851 issued on 7 August 2014; and
3. Copy of actual packaging and label with the mark “NOCAL”

The Preliminary Conference was held on 14 May 2014 wherein the parties were directed to file their position papers. Petitioner and Respondent-Registrant filed their respective position papers on 28 May 2014 and 7 April 2014, respectively.

Should the Respondent-Registrant’s trademark registration "NOCAL" be cancelled?

Section 151 of the IP Code provides:

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 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 obtained fraudulently, or contrary to the provisions of this Act, or if the registered mark is 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.

Records show that the Petitioner secured his registration for the mark NOCAL under Registration No. 4-2002-00267 on 21 March 2005<sup>5</sup>. The Respondent-Registrant Petitioner secured Registration No. 4-2010-011361 on April 21, 2011.<sup>6</sup>

The subject marks depicted below are identical:

**NOCAL**

**NOCAL**

Petitioner's mark

Respondent-Registrant's

Admittedly, Petitioner's registration was cancelled because his failure to renew/ file the required Declaration of Actual Use. He filed a new application on 16 June 2011 under Application No. 4-2011-00760.<sup>7</sup> Apart from the new application and record of his previous registration, sans declaration of actual use, the evidence is bereft of any proof of his commercial use of the mark NOCAL. For its part, Respondent-Registrant was able to obtain its own registration for the mark NOCAL, showing its use by securing registrations from the Bureau of Food and Drugs and sample packages.<sup>8</sup> As between the parties, Respondent-Registrant has proved its right to the trademark NOCAL by its registration and actions that signify commercial use of the mark NOCAL. Section Sec. 138 of the IP Code states:

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 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.

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<sup>5</sup> Annex "A"

<sup>6</sup> Annex "C"

<sup>7</sup> Annex "B"

<sup>8</sup> Annex "2"- "3"

**WHEREFORE**, premises considered, the instant Petition for Cancellation of Trademark Registration No. No.4-2010-011361 is hereby DENIED. Let the filewrapper of the subject trademark 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. ADORACION U. ZARE, LL.M.**  
Adjudication Officer  
Bureau of Legal Affairs