

BAYER AKTIENGSELLSCHAFT,
Opposer,

INTER PARTES CASE NO. 3011

- versus

OPPOSITION TO:

Application Serial No. 49907
Filed : December 16, 1982
Applicant : Recordati, Chiasso of
Switzerland
Trademark : "FONLIPOL"
Used on : Pharmaceutical,
veterinary and sanitary substances;
infants' and invalids' foods; plasters,
material for bandaging; material for
sopping teeth, dental wax; disinfectants,
preparation for killing weeds and
destroying vermin

RECORDATI, CHIASSO OF
SWITZERLAND,
Respondent-Applicant.

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DECISION NO. 88-104 (TM)

October 13, 1988

DECISION

On December 1, 1987, Bayer Aktiengesellschaft, a German corporation, filed an Unverified Notice of Opposition to Application Serial No. 49907 for the trademark "FONLIPOL" used on goods under Class 5, which application was filed on December 16, 1982 by Recordati S.A Chemical & Pharmaceutical Co., a Swiss corporation, and published in the Official Gazette (Supplement to O.G., Vol. 82, No. 10, page 60) on March 10, 1986 and officially released on October 29, 1987.

A Notice to Answer dated December 15, 1987 was sent to Respondent-Applicant. On December 29, 1987, Respondent-Applicant filed its Answer alleging, among others, that the Notice of Opposition did not conform with the requirements of law. Thereafter, Notices of Pre-Trial were sent to both parties.

A Motion to Dismiss, however, was filed by Respondent-Applicant on the ground that the Notice of Opposition was not verified. It argued that Opposer's failure to comply with the requirements of Section 8 of Republic Act 166, as amended, and Rule 187 of the Rules of Practice in Trademark Cases rendered the Unverified Opposition null and void.

On August 2, 1988, Opposer filed a duly authenticated Verified Notice of Opposition. It likewise filed an Opposition to Motion to Dismiss with Omnibus Motions arguing as follows: (1) that Respondent-Applicant's Answer and Motion to Dismiss which were filed by its counsel, the law firm G. Gonzales & Associates, should be considered as not filed because such filing or representation is contrary to the norms of Philippine Law practice in view of the death of Atty. Gonzalo W. Gonzalez prior thereto; (2) that this Bureau committed an error when it did not issue a notice of unverified opposition but, instead, immediately issued a Notice to Answer and, after the Answer was filed, set the case for pre-trial; and 3) that the admission of the Verified Opposition at this stage of the proceedings will not affect any substantial rights or result in any injustice considering that Opposer can still file a petition for cancellation in case the decision be adverse and Respondent-Applicant's trademark is eventually registered.

Respondent-Applicant, on the other hand, filed a Reply to Opposition raising the following arguments: 1) that Respondent-Applicant's counsel, G. Gonzalez & Associates, is the law firm of

Atty. Gizela M. Gonzalez and which daughter of the late Atty. Gonzalo W. Gonzalez, and which law firm has been duly authorized to represent Respondent-Applicant in the case; 92) that Opposer's failure to file the Verified Opposition within the period prescribed by Rule 187(c) of the Rules of Practice in Trademark Cases rendered the Unverified Opposition null and void and deprived this Bureau of jurisdiction to resolve this case on the merits or act on Opposer's alternative motion for admission of the Verified Opposition; and (3) that this Bureau did not commit an error when it required Respondent-Applicant to file an Answer to the Unverified Opposition since Opposer is presumed to know said Rule 187 (c), and assuming arguendo that there has been such an error, the same could not have cured the fatal infirmity or failure to file the Verified Opposition within the prescribed period.

The main issue to be resolved is whether or not this case should be dismissed for failure of Opposer to file the Verified Notice of Opposition within reglementary period.

Records show that Respondent-Applicant, in applying for the registration of the trademark "FONLIPOL", was represented by the law firm Atty. Gonzalo W. Gonzalez, Gonzalo W. Gonzalez & Associates, as evidenced by the Special Power of Attorney and telexes attached to the Reply to Opposition Annexes "I", "II" and "II-A". Thus, the objection raised by Opposer to the representation of Respondent-Applicant by Atty. Gizela M. Gonzales is unjustified.

There is no question that the Verified Notice of Opposition was filed out of time. Oppose, however, raised the arguments that it decided not to file any motion for extension to file its Verified Opposition because Respondent-Applicant already filed its Answer and this Bureau already set the case for pre-trial, and that the admission of the Verified Opposition will not affect any substantial rights or result in any injustice.

The sending of the Notice to Answer instead of a Notice of Unverified Opposition, and the filing of the Answer and setting of this case for pre-trial prior to the filing of the Verified Opposition are circumstances that would not justify or excuse Opposer's failure to file the Unverified Opposition within the reglementary period. While a procedural error may have been committed, the sending of the notice to Answer and the setting of the case for pre-trial after Answer was filed is not incompatible with the provisions of Section 8, Republic Act 166 which requires, among others, the verification of an opposition, and Rule 187 of the Rules of Practice in Trademark Cases which likewise requires such verification and provides, among others, that an unverified opposition will be null and void unless verified within sixty (60) days after the filing of the unverified opposition and that this verification period may be extended for an additional thirty (30) days upon written request. In fact, Memorandum-Circular No. ISS/88-8 which was issued on August 3, 1988 reads as follows:

"x x x Upon filing of an unauthenticated or unverified notice of opposition, as aforestated, the Legal Division, simultaneously with the sending of a notice to the applicant of such filing, will require the applicant to file an answer on responsive pleading within the period fixed by law, otherwise he may be declared in default, without prejudice to dismissal of the opposition motu proprio upon failure of the oppose to file an authenticated opposition to verify, in person or by any person on his behalf who knows the facts, the notice of opposition within sixty days from date of filing of the unauthenticated or unverified opposition. In no case shall the period within which to file the authenticated or verified opposition exceed 120 days from the aforesaid date of release of the BPTTT Official Gazette. This rule is intended to expedite the opposition proceedings. x x x

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x

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This Memorandum-Circular takes effect immediately and shall apply to pending opposition cases." (Underscoring supplied)

Therefore, the error allegedly committed by this Bureau when it required Respondent-Applicant to file an Answer to the Unverified Opposition would not constitute "mistake or excusable negligence" which would justify the failure of Opposer to file the Verified Opposition within the reglementary period.

To admit the Verified Notice of Opposition despite the lapse of the reglementary period, or to relax the above requirements, would render nugatory the aforesaid law and rules of this Bureau and set an unwarranted precedent causing unnecessary delay in the disposition of opposition cases. The above rules, therefore, should be strictly complied with.

WHEREFORE, Inter Partes Case No. 3011 is DISMISSEED; Application Serial No. 49907 is given due course.

Let the records of this case be remanded to the Application, Issuance and Publication Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO
Director