

GITANO LICENSING, LTD.,
Petitioner,

INTER PARTES CASE NO. 3417

PETITION FOR CANCELLATION

- versus -

Cert. of Regn. No. 34072

Issued : March 6, 1985

Registrant : Ruggers Garments
Manufacturing, Inc.

Used on : Garments, particularly
jeans

RUGGERS GARMENTS MANUFACTURING
INC.,

Respondent-Registrant.

x-----x

DECISION NO. 89-95 (TM)

November 16, 1989

DECISION

On July 3, 1989, Guano Licensing, Ltd. filed a Petition for the cancellation of Certificate of Registration No. 34072 for the trademark "GITANO" used on garments, particularly jeans, issued to Ruggers Garments Manufacturing, Inc. on March 6, 1985.

Petitioner is a foreign corporation organized and existing under the laws of the State of Delaware, U.S.A. with principal offices at 300 Delaware Avenue, Wilmington, Delaware 19899, United States of America, while Respondent-Applicant is a domestic corporation organized and existing under Philippine laws with principal office at 984 Ilaya, 2nd Floor, Philippine Textile Building, Tondo, Manila Philippines.

The grounds alleged in the Petition are:

- “1. That the registration of the trademark ‘Gitano’ for ‘garments particularly jeans’ is contrary to the provisions of Section 4 (d), Chapter II-A of Republic Act No. 166, as amended;
2. That the petitioner is the owner of the trademark ‘Gitano with 4 bar design’ used on all goods (clothing) under Class 25 long prior to that of respondent, and thereafter when it was incorporated in the United States after having assigned in its favor said mark is adopted the tradename ‘Gitano Licensing, Ltd.’ which was subsequently made known in the Philippines and throughout the world.
xxx.
3. That under the treaty of Paris for the protection of Industrial Property which took effect in the Philippines on September 27, 1965, the said trademark ‘Gitano Licensing, Ltd.’ is protected by said treaty, the word or name ‘Gitano’ being the dominant portion thereof. xxx.
4. That, in view of the illegal use and registration by respondent-registrant of petitioner’s trademark and tradename in connection with goods under Class 25, the same causes confusion and mistake, and deceive unscrupulous dealers into believing that the goods of the respondent-registrant originated from the petitioner or its Philippine representative to the damage and injury of the latter and the buying public.”

On July 21, 1988, Respondent-Applicant was notified of this Petition and was required to file its Answer thereto within fifteen (15) days from receipt of said notice.

For failure to file its Answer, Respondent-Registrant was declared in default in Order No. 89-727 dated September 14, 1989 and Petitioner was allowed to present its evidence ex parte.

Petitioner presented its evidence on September 28, 1989 and October 10, 1989, consisting of Exhibits "A" to "S-1", inclusive, pursuant to the above-cited default order. On October 17, 1989, Petitioner formally offered the above exhibits and were all admitted in evidence for the Petitioner in Order No. 89-835 dated October 18, 1989.

Since the trademark commonly claimed by the Petitioner and the Respondent-Registrant are identical, the ultimate issue to be resolved is: Which of the parties is the first/ prior adopter, user and owner of the trademark "GITANO" in contest? Was there violation of the provisions of Section 4 (d) of Republic Act No. 166, as amended, by the herein Respondent-Registrant?

Petitioner alleges that it is the prior adopter, user and owner of the trademark "GITANO WITH 4 BAR DESIGN" and the Respondent's later registration of the mark in its favor is in violation of Section 4 (d) of Republic Act No. 166, as amended.

To prove its case, Petitioner presented evidence that its tradename is "GITANO LICENSING, LTD." filed with the State of Delaware, U.S.A. on July 27, 1984 (Exhs. "A" and "A-1"); that in 1977, the "GITANO" brand has been introduced, launched and began to carve its niche in the market place by Orit Corporation which it conceived in its "packaged goods" in 1976 (Exh. "J" back over); that its predecessor, Orit Imports, Inc., first registered the mark "GITANO" in the United States Patent and Trademark Office on June 5, 1979 followed by 7 more registration therefrom and assigned them all to Gitano Licensing, Ltd. on December 23, 1987 (Exhs. "D", "E", "F" and "G"); that it has manufactured products bearing the mark "GITANO WITH 4 BAR DESIGN" and sold them to different countries as early as July 25, 1978 (Exhs. "K" to "K-13"); that the Petitioner's products bearing the mark "GITANO WITH 4 BAR DESIGN" have been manufactured in the Philippines through the Litton Mills, Inc. of Manila for sale abroad as early as June 13, 1979 (Exhs. "L" to "L-38"); the different labels/ tags that Petitioner uses on its various products (Exhs. "M" to "Q"); and advertisement made on the trademark "GITANO" by the Petitioner (Exhs. "S" and "S-1", pp. 166 to 167).

Petitioner has already filed its application for the registration of its trademark "GITANO WITH 4 BAR DESIGN" with this Bureau on March 24, 1988 (Exh. "R") to do full-swing business in the Philippines through the Gitano Sportswear (Philippines), which business name has already been registered with the Department of Trade and Industry on January 13, 1989 (Exhs. "C" and "C-1").

With the foregoing exhibits, Petitioner has convincingly proved its ownership prior and continuous use of the mark "GITANO" in its home country and in The Philippines, while Respondent-Registrant, despite receipt of notice of controversy, never exerted efforts to defend its interests and rights over the registration under contest.

WHEREFORE, this Petition is GRANTED. Accordingly, Certificate of Registration No. 34072 for the trademark. "GITANO" in the name of Respondent-Registrant is CANCELLED from t the Principal Register of this Bureau.

Let-the records of this case be forwarded to the Patent/ Trademark Registry and EDP Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO
Director