

DENNIS LADDARN,
Opposer,

INTER PARTES CASE NO. 3877
Opposition to:

- versus-

Appln. No.77196
Filed: 09 August 1991
Trademark: "BOSSINI"

VICTOR S. CUA
Respondent-Applicant.
x-----x

DECISION NO. 97-16

DECISION

This is an Opposition filed by Dennis Laddaran, of legal age, a Filipino citizen, and with business address at 919 Dagupan Street, Tondo, Manila to Application Serial No. 77196 for the registration of the trademark "BOSSINI" used on watches and clocks, filed on August 9, 1991 by Victor S. Cua, of legal age, a Filipino citizen and a resident of 54 7th Street between 8th and 9th Avenues, Caloocan City, Metro Manila.

The grounds of the Opposition are as follows:

- "1. The approval of the application in question is contrary to Section 4(d) of Republic Act No. 166, as amended;
- "2. The approval of the application in question will violate Opposer's right to the exclusive use of the trademark BOSSINI which is duly registered in his favor and the extension of the use of said registered mark to other goods;
- "3. The approval of the application in question has caused and will continue to cause great and irreparable damage and injury to herein Opposer;
- "4. Respondent-Applicant is not entitled to register the trademark BOSSINI in his favor.

Opposer relied on the following facts to support his Opposition:

- "1. That long before August 9, 1991 when Respondent-Applicant filed his application in question for the registration of the trademark BOSSINI, Opposer and his predecessor-in-interest had adopted and since then have been using the trademark BOSSINI for a variety of goods;
- "2. That Opposer has not abandoned the use of the trademark "BOSSINI". On the contrary, he has continued such use up to the present and has, in fact extended the use thereof to other goods;
- "3. That the trademark "BOSSINI" is duly registered in favor of Opposer under Registration Certificate No. SR-7922 issued on 12 August 1987, attached as Annex "A" and made an integral part hereof,
- "4. That in addition, Opposer has also applied for the registration of the trademark "BOSSINI" for use on a variety of goods, which application has been assigned Serial No. 79689;
- "5. That the trademark "BOSSINI" being applied for registration by Respondent-Applicant is identical to the trademark "BOSSINI" duly registered in favor of Opposer and which

Opposer has been using since long before 09 August 1991 and which use has been continuous up to the present.

"6. That the approval of the application in question is contrary to Section 4(d) of Republic Act No. 166, as amended-,

"7. That the approval of the application in question is violative of the right of Opposer to the exclusive use of the trademark "BOSSINI" and the right to extend the use of said mark to other goods;

"8. That Opposer has spent a substantial amount of money to popularize and promote his BOSSINI branded products;

"9. That through extensive advertising and promotional campaigns and because of the high quality of the Opposer's product bearing the trademark "BOSSINI", said mark BOSSINI has become distinctive of Opposer's products and established valuable goodwill in favor of Opposer;

"10. That the approval of the application in question has caused and will continue to cause great and irreparable damage and injury to Opposer and will likely cause confusion, mistake, and deceive the consuming public as to the source of origin of Respondent Applicant's goods.

"11. That Respondent-Applicant is not entitled to register the trademark "BOSSINI" in his favor."

Immediately upon receipt of the verified Notice of Opposition, this Office sent to Respondent a Notice to Answer requiring him to answer the Notice of Opposition within fifteen (15) days from receipt thereof, which Notice was received by him on April 5, 1993.

On 11 June 1993, Respondent-Applicant filed his Answer to Opposition where he raised the following Issues:

"1. That the application for the trademark "BOSSINI" on watches and clocks was classified as luxury item while the Opposer's registration was classified as necessity item;

"2. That the Opposer Serial No. 79689 for supplemental trademark "BOSSINI" for variety of goods was applied after the filing of said trademark for watches and clocks item under luxury item classification.

"3. That all the allegations presented by Opposer, Mr. Dennis Laddaran, for the registration of the trademark 'BOSSINI' for luxury item watches and clocks will not cause irreparable damage and injury to the Opposer."

Notice of Pre-Trial Conference dated 17 June 1993 was served to the opposing parties and their respective counsels directing them to appear in the pre-trial conference set on 15 July 1993 at 2:30 P.M. Counsel for Opposer appeared with a Special Power of Attorney to represent client while neither Respondent-Applicant nor Counsel attended the pre-trial conference.

On 15 March 1995, Opposer moved to declare Respondent-Applicant as in default for failure to appear in the aforementioned Pre-Trial Conference. However, the Bureau again reset the Pre-Trial Conference to 27 August 1993 and 01 October 1993, respectively. On both occasions, Respondent-Applicant and Counsel continued to veer away from the conference. The Pre-Trial Conference was again reset to 12 November 1992 upon request of Respondent-Applicant's Counsel but neither Respondent-Applicant nor Counsel show up prompting Counsel for Opposer to again move that Respondent Applicant be declared as in default.

Consequently, in its Order No. 94-243, the Bureau declared Respondent-Applicant as in default for failure to attend the scheduled Pre-trial conferences and Opposer was allowed to present its ex-parte. Correspondingly, on 25 August 1994 Counsel for Opposer made his Formal Offer of Evidence in open court which admitted Court at the same hearing. On August 29, 1994, Opposer submitted his Memorandum in support of his position in this case.

There are two main issues to be resolved in this case:

Firstly, whether or not Respondent-Applicant had actual use of the trademark prior to the adoption and actual use of the Opposer; and

Secondly, whether or not the classification of Respondent-Applicant goods, i. e. watches into LUXURY and NECESSARY items is sufficient to make the Opposition fall outside the context of Section 4(d) of RA 166 as amended.

As to the first issue, in *Sterling Products International, Inc, vs. Faren Fabrieken Bayer Aktiengesellschaft* (27 SCRA 1214, 1233), the Supreme Court held, thus:

“A rule widely accepted and firmly entrenched because it has come down through the years is that actual use in commerce or business is prerequisite to the acquisition of the right of ownership over a trademark”.

This rule is spelled out in our Trademark Law. Sec. 2-A of Republic Act 166 in turn, provides, thus

“Sec. 2-A Ownership of trademarks, tradenames and service marks how acquired. - Anyone who lawfully produces or deals in merchandise of any kind or who engages in any lawful business, or who renders any lawful service in commerce, by actual use thereof in manufacture or trade, in business, and in the service rendered, may appropriate to his exclusive use a trademark, a tradename, or service mark not so appropriated by another, to distinguish his merchandise, business or service of others. The ownership or possession of a trademark, tradename, service mark, therefore or hereafter appropriated, as in this section provided, shall be recognized and protected in the same manner and to the same extent as are the property rights to the law”.

As shown by the evidence, the actual use by Opposer of the trademark “BOSSINI” for jeans, shirts, socks, briefs, jackets, leather bags, shoes and other goods including watches was on 01 September 1982 and for watches, clocks, wrist watches, belts and other products was on 12 August 1987 as shown by Exhibits “C” to “L”, including sub-markings.

Opposer has caused the registration of the mark “BOSSINI” for use on jeans, slacks, polo shirts, T-shirts, skirts, blouses, socks, briefs, dresses, jackets, leather bags, shoes in the Supplemental Register under Certificate of Registration No. 7922 on August 12, 1987 (Exhibit “B”) which is proof that he has been using the mark on August 12, 1987.

On the other hand, as appearing in the trademark Application No. 77196 dated August 9, 1991 of Respondent-Applicant, his alleged date of first use of the mark “BOSSINI” was on December 14, 1990. However, this cannot be admitted in evidence considering that Respondent-Applicant had lost his legal standing in this case by reason of his being, declared as in default, and considering further that our Rules of Practice in Trademark Cases proscribe the offering of allegations in the trademark application as evidence.

Thus, Rule 173, of the Revised Rules of Practice in Trademark Cases provides that-

“173 Allegations in the application not evidence on behalf of the applicant. In all Inter Partes proceedings, THE ALLEGATIONS OF THE DATE OF USE IN THE APPLICATION FOR REGISTRATION OF THE APPLICANT OR OF THE REGISTRANT

CANNOT BE USED AS EVIDENCE OF THE PARTY MAKING THE SAME. In case no testimony is taken as to the date of use, the party will be limited to the filing date of the application as the date of his first use (underscoring provided).

Hence, in the absence of any testimonial evidence as to the date of actual use by Respondent-Applicant of the mark "BOSSINI", his date of first use of the mark "BOSSINI" is limited to his date of filing of the trademark application which is August 9, 1991. Therefore, it is crystal clear that Opposer has prior and actual use of the mark "BOSSINI" by virtue of his adoption of the same on September 01, 1982 and August 12, 1987 respectively.

In regard to the argument of variation in the classification of items between Opposer's and Respondent's products, Rule 82 of the Rules of Practice in Trademark Cases as amended by Patent Office Administrative Order No. 20, as approved on 17 February 1978, to conform with International Classification No. 14, does not distinguish between a luxury and a necessary item. As a matter of fact, the goods "Watches and clocks" explicitly appear in the applications of both the Opposer and the Respondent-Applicant. Furthermore, as shown by Exhibits "D", "G", "I" to "L" Opposer has been using the mark BOSSINI on watches and clocks as early as September 1, 1982.

Finding, Opposer's prior and actual use of the mark "BOSSINI" and holding that the goods subject of this opposition are almost the same or similar, the approval of the application in question would be contrary to Section 4(d) of Republic Act No. 166 as its registration would likely cause confusion or mistake or deceive purchasers To avoid such injury, the exclusive use of the trademark "BOSSINI" should be upheld in favor of the Opposer Thus, this Office holds that Respondent-Applicant is not entitled to register the trademark "BOSSINI" in his favor.

WHEREFORE, the Notice of Opposition is as it is hereby, SUSTAINED. Accordingly, application Serial No. 77196 filed by Victor S. Cua on August 9, 1991 for the trademark "BOSSINI" used on watches and clocks is hereby REJECTED.

Let the filewrapper of this case be remanded to Application, Issuance and Publication Division for appropriate action in accordance with this Decision with a copy of this Decision to be furnished the Trademark Examining Division for information and to update its record.

SO ORDERED.

Makati City, November 08, 1997.

EMMA C. FRANCISCO
Director