

THE WILLIAMSON-DICKIE  
MANUFACTURING COMPANY,  
Opposer,

INTER PARTES CASE NO. 1619

OPPOSITION TO:

- versus -

Application Serial No. 40013  
Filed : November 22, 1979  
Applicant : Suresh Daswani  
Trademark : "DICKIES AND DEVICE  
WITH "D"AND PORTION  
OF THE U.S. FLAG"  
Used on : Jackets, T-shirts, shorts,  
pajamas for men, women  
and children

SURESH DASWANI  
Respondent-Applicant.

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DECISION NO. 89-32 (TM)  
June 13, 1989

#### DECISION

This is an Opposition filed by William-Dickie Manufacturing Company (herein Opposer) to trademark Application Serial No. 40013 filed on November 22, 1976 by Suresh Daswani (herein Respondent-Applicant) for the trademark "DICKIES AND DEVICE WITH "D"AND PORTION OF THE U.S. FLAG" for use on jackets, T-shirts, shorts, pajamas for men, women and children.

Opposer is a foreign corporation organized and existing under the laws of Texas, U.S.A., holding office and doing business at 509 West Vickery Boulevard, Fort Worth, Texas, U.S.A, while Respondent-Applicant is a citizen of the Philippines, residing at R-205 Natividad Building, T. Pinpin corner Escolta Streets, Manila, Philippines.

The grounds alleged in the Verified Opposition filed on April 1, 19823 are as follows:

"1. The Opposer is the owner of the trademark "DICKIES and DICKIES WITH HORSESHOE DEVICE" in trade and in commerce in the Philippines in International Class 25 of the International Classification of Goods and Services long prior to the alleged date of first use of respondent-applicant.

2. The trademark 'DICKIES and DICKIES WITH HORSESHOE DEVICE` which the opposer has created and adopted is well-known in the Philippines and throughout the world."

In its Answer, Respondent-Applicant alleged that the registration of the mark will not result in damage to the Opposer, the goods of the parties being not the same, or non-competing, and importation is banned of Opposer's goods.

At the pre-trial conference on September 2, 1982, the parties failed to arrive at a compromise; hence, the case proceeded to trial.

Opposer presented as evidence of ownership over the mark U.S Patent Office Registration No. 609, 147 dated July 19, 1955 for the mark DICKIES for outer pants and other shirts for men, women and children, showing first use on March 8, 1954 (Exh. D); U.S. Patent Office Registration No. 609, 638 dated July 26, 1955 for the mark DICKIES and DICKIES WITH

HORSHOE DEVICE` for outer pants and outer shirts for men, women and children since March 8, 1954 (Exh."E"); and West German Certificate of Registration No. 979059 dated November 23, 1978 for "DICKIES AND DEVICE WITH "D"AND PORTION OF THE U.S. FLAG" used for clothing under Class 25 (Exh. "F"). The same trademark is also registered in the United Kingdom of Great Britain under Registration No. 109.5176 on May 5, 1978 (Exh. "G").

In addition, Opposer presented photocopies of foreign magazines showing advertisements of the alleged trademarks (i.e. Sports Illustrated, Esquire Magazine, Playboy Magazine, and People Magazine, all under Exh. "C"; Men`s wear Magazine and Super style Magazine in Exh. "I").

Respondent-applicant made no objections to Opposer`s evidence and did not present any evidence in his behalf (Transcript of stenographic notes taken on October 28, 1982).

Opposer has admitted that the subject trademark is neither sold nor registered in the Philippines. Respondent-Applicant raised the issue of whether or not a foreign corporation in such factual context would be damaged by the registration of a similar trademark. If not, then the Opposition should be dismissed.

Since the Opposer has no registered mark or used DICKIES & DEVICE in the Philippines, it has not established any property right in the Philippines. Consequently, Opposer should not claim that it suffered any damage. The protection under foreign registrations could not extend to the Philippines because the law of trademarks rests upon the doctrine of nationality or territoriality. The United States, from which our Trademark Law has been copied, and most other countries respect the basic premise. The scope of protection is determined by the law of the country in which the protection is sought, and international agreements for the protection of Industrial property are predicated upon the same principle. x x x The use required as the foundation of the trademark rights refers to local use at home and not abroad. X x x (2 Callman, Unfair Competition and Trademarks, Par. 76.4, p. 1006). Further, as held in Sterling Products International, Inc. vs. Farbenfabriken A.G., 44 SCRA 1226-1227:

“(t) he United States is not the Philippines. Registration in the United States is not registration in the Philippines. x x x Plaintiff itself concedes that the principle of territoriality of trademark law has been recognized in the Philippines. Accordingly, the registration in the United States of the Bayer trademark would not of itself afford plaintiff protection for use by the defendants in the Philippines of same trademark for the same or different goods. “(Emphasis ours)

And in later decision, the Supreme Court held that a foreign company selling a brand of shoes abroad but not in the Philippines has no goodwill that would be damaged by registration of the same trademark in favor of the domestic corporation which has been using it for years here (Bata Industries Ltd. Vs. Court of Appeals, 114 SCRA 318).

As provided in Section 8 of Republic Act 166, (a)ny person who believes that he would be damaged by the registration of a mark or tradename may x x x file with the Director an opposition to the application”. Considering that the claim of the Opposer that it will be damaged by the registered of the mark is without any basis, this Opposition should be, as it is hereby DISMISSED.

Be that as it may, trademark Application Serial No. 40013 cannot be given due course. Respondent-Applicant did not present any evidence to prove his ownership over “DICKIES AND DEVICE”. Thus, it may not invoke the decision in Bata Industries vs. Court of Appeals, p. 320, supra, where the Supreme Court, in upholding the right of the appellee (New Olympian Rubber Products co., Inc.) to the registration of the trademark “BATA” for shoes cited the following findings of fact:

“(The respondent-applicant) has overwhelmingly and convincingly established its right to the trademark BATA and consequently, its use and registration in its favor. There is no gainsaying the truth that the respondent has spent considerable amount of money and effort in popularizing the trademark BATA for shoes in the Philippines through the advertising media since it was lawfully used in commerce on July 1, 1970. It cannot be denied, therefore, that it is the respondent-applicant’s expense that created the enormous goodwill of the trademark BATA in the Philippines and not the oppose as claimed in its opposition to the registration of the BATA mark by the respondent.”(Underscoring supplied)

In the case at bar, Respondent, despite the well high identity of the mark he was applying for with that of the Opposer who had therefore reason to strongly challenge his right to the mark, took a passive stance. Not only did he fail to present any evidence to establish his right to the mark; he also failed to file a Demurrer to evidence. The situation demands that his right to the mark be clearly established. As aptly held by the Supreme Court in the case of *Sterling vs. Farbenfabriken A.G.*, p. 1224, supra:

“x x x (i)t would seem quite clear that adaption alone of a trademark would not give exclusive right thereto. Such right ‘grows out of their actual use. Adoption is not use. One may make advertisements, issue circular, give out price lists n certain goods; but this alone would not give exclusive right of use. For trademark is creation of use. xxx” (Underscoring supplied).

Further to this point, upon the question of priority of appropriation, in *Hanover Star Milling Co. vs. Metcalf*, 60 L. Ed., 713, 719, the Court said:

“x x x (b)ut where two parties independently are employing the same mark upon goods of the same class, but in separate markets wholly remote the one from the other, the question of prior appropriation is legally insignificant; unless, at least, it appears that the second adopter has selected the mark with some design inimical to the interest of the first user, such as to take the benefit of the reputation of his goods, to forestall the extension of his trade, or the like (Underscoring Supplied)

On another point, it has been impliedly admitted by the parties that the device adopted by Respondent-Applicant is a simulation of the U.S. flag; hence, not registrable as provided for under Section 4(b) of Republic Act 166.

WHEREFORE, the herein Notice of Opposition is hereby DISMISSED and Respondent-Applicant’s Application Serial No. 40013 for the registration of the mark “DICKIES AND DEVICE WITH “D”AND PORTION OF THE U.S. FLAG” is hereby REJECTED.

Let the records of this case be forwarded to the Trademark Examining Division for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO  
Director

