

ELPIDIO VALENTINO
Opposer,

INTER PARTES CASE NO. 1760

- versus -

OPPOSITION TO:
Application Serial No. 35963
Filed : August 4, 1978
Applicant : Roeba International
Garment Corporation
Trademark : VALENTINO & LINES
DESIGN
Used on : Shirts and pants

ROEBA INTERNATIONAL
GARMENT CORPORATION,
Respondent-Applicant

x-----x

- and -

ELPIDIO VALENTINO
Petitioner,

INTER PARTES CASE NO. 1485

- versus -

PETITION FOR CANCELLATION

Cert. of Regn. No. SR-4213
Issued : September 5, 1979
Registrant : Cone Industries, Inc.,
assignee of Roeba
International Garment
Corporation
Trademark : VALENTINO & DESIGN
Used on : Shirts and pants

CONE INDUSTRIES, INC.,
assignee of Roeba International
Garment Corporation,
Respondent-Applicant

x-----x

DECISION NO. 89-103 (TM)

December 19, 1989

DECISION

This is a consolidation of two (2) inter partes cases, namely:

- (1) Inter Partes Case No. 1485 re Petition filed by Elpidio Valentino on January 20, 1981 for the cancellation of Trademark Registration No. SR-4213 in the Supplemental Register of the Bureau bearing the trademark "VALENTINO & DESIGN" used on pants, shirts slacks and jeans registered on September 5, 1979 in favor of Roeba International Garment Corporation, assignor to Cone Industries, Inc.; and
- (2) Inter Partes Case No. 1760 re Notice of Opposition filed by Elpidio Valentino on July 20, 1983 against the registration of the trademark "VALENTINO" used on shirts and pants applied for by Roeba International Garment Corporation on August 4, 1978 under Application Serial No. 35963 published on Page 1600, Volume 79, No. 11 of

the March 14, 1983 issue of the Official Gazette which was released for circulation on May 31, 1983.

Petitioner/Opposer is a Filipino and a resident of 83 Malanday, Marikina, Metro Manila, while Respondent-Registrant is a corporation organized and existing under the laws of the Philippines, doing business at 994 Amelia Apartment, Paris Street, Malate, Manila.

The grounds alleged in the Petition for Cancellation are:

- (a) That the mark registered in favor of respondent consists of or comprises a mark which so resembles a mark previously used by petitioner and not abandoned, as to be likely, when applied to or used in connection with the goods of respondent, to cause confusion or mistake or to deceive purchasers”
- (b) That neither respondent nor its assignor was entitled to register the mark at the time of its application or at the time of its assignment;
- (c) That the registration was obtained fraudulently or contrary to the provisions of Section 4 and 19-A of Republic Act No. 166, as amended.”

The grounds alleged in the Notice of Opposition are:

“1. That the trademark VALENTINO which respondent-applicant seeks to register is identical to or at the very least, confusingly similar to, opposer’s trademark VALENTINO, presently registered in his name and previously used by him and not abandoned, that the use by respondent-applicant of said mark on its goods will very likely cause confusion or mistake, or will deceive the purchasers thereof, such that the public may be misled to believe that the goods upon which respondent-applicant uses its mark are those of or come from opposer;

2. That the trademark VALENTINO which respondent-applicant seeks to register forms part of the business name of opposer, as well as of the corporate name of opposer’s Company;

3. That respondent-applicant is not entitled to register the trademark VALENTINO in its favor;

4. That the registration of the trademark VALENTINO in favor of respondent applicant will cause great and irreparable injury and damage to herein opposer pursuant to Section 8 of Republic Act No. 166, as amended.”

In its Answer to the Petition for Cancellation, Respondent-Registrant denied all the material allegations made therein and alleged the following special affirmative defenses:

“10. That petitioner’s trademark is used solely on ‘shoes’ while respondent uses the said trademark subject of the instant petition on ‘pants, shirts, slacks and jeans’ as clearly indicated in the Certification of Registration No. 4213 in the Supplemental Register; that these are two entirely different products and no confusion would likely arise therefrom as to the source of said two products;

11. That respondent/applicant has spent huge amounts of money advertising ‘Valentino’ jeans and it is petitioner who now wants to ride on that popularity and presumably, would like to go into the manufacture of identical products, precisely after respondent has made its Valentino jeans so popular among the jeans-buying public;

12. That the Certificate of Registration sought to be cancelled was issued some two years ago and yet it was only after respondent's products have become household by-words that petitioner deemed it wise to file the instant petition, notwithstanding knowledge thereof as clearly advertised by respondent in all forms of media;

13. That the instant petition was filed to harass the respondent and is purely 'speculative' as the petitioner is not selling the same line of products as those manufactured and sold by respondent.

14. That the Honorable Director of this Office, upon recommendation of the Trademark Examiner, has seen it fit to allow the registration of Valentino on 'pants, shirts, slacks and jeans' precisely because of the diversity of the products manufactured by both parties and in allowing the same, the possibility of 'likely confusion' has been eliminated; otherwise, such registration would not have been allowed."

Respondent-Applicant filed no Answer to the foregoing Notice of Opposition. However, since on motion of Opposer, the herein Notice of Opposition (Inter Partes Case No. 1760) was consolidated to the Petition for Cancellation (Inter Partes Case No. 1485) per Order No. 84-29 dated February 8, 1984 the Answer made in Inter Partes Case No. 1485 is considered adopted in Inter Partes Case No. 1760.

The pre-trial conference of Inter Partes Case No. 1485 was set to September 15, 1981 but was reset to December 18, 1981, February 10, 1982, March 16, 1982, all at the instance of Respondent, April 15, 1982 upon agreement of the parties; May 21 to June 9, 1982 due to Special Meeting of Hearing Officers; June 9 to August 4, 1982 on Motion of Respondent; August 4 to August 10, 1982 for non-appearance of Respondent; August 10 to September 10, 1982 and then September 10 to September 30, 1982 upon agreement of the parties; September 30 to November 4 to December 7, 1982 for non-appearance of Respondent; December 7, 1982 to January 20, 1983, February 18 to March 18, 1983, March 18 to April 26, 1983 and April 26 to May 24, 1983, all upon agreement of the parties; May 24 to June 14, 1983 on motion of Petitioner; June 14 to July 6, 1983 upon agreement of the parties; no record of hearing from July 6, 1983 to April 19, 1985; April 19 to May 9, 1985 on motion of Petitioner; February 26, 1986; no record of hearing for the year 1987; June 7, 1988 to July 7, 1988 for non-appearance of Respondent; September 23 to October 27, 1988 upon agreement of the parties; April 24 to May 26, 1989 and May 26 to June 23, 1989 upon agreement of the parties; June 23 to July 21, 1989 at the instance of Respondent; July 21 to August 18, 1989 and August 18 to September 13, 1989, both due to the non-appearance of Respondent, and from September 13 to October 20, 1989.

Foregoing data show that this case has been dragging unduly for a long, long time already.

On September 28, 1989, Petitioner/Opposer filed a Motion to Dismiss the herein cases for failure of Respondent-Registrant to file the legally required Affidavit of Use within the prescribed period, in connection with Registration Certificate No. 4213, subject of herein Petition.

A check was done with the Patent/Trademark Registry and EDP Division and their records show that subject Registration Certificate No. 4213 was issued on September 5, 1979 and the Registrant was supposed to file its Affidavit of Use September 5, 1984 to September 5, 1985 but failed to do so in violation of the law. Considering that the period to file the said Affidavit of Use has long lapsed (it is now December 19, 1989) and no action in connection thereto has been received by the Office to show concern and protection of its interests thereon, the subject mark is deemed abandoned. It follows that, for non-use of said mark, Respondent-Applicant has likewise

already abandoned its application for registration of subject mark in the Principal Register.

WHEREFORE, Petition for Cancellation (Inter Partes Case No. 1485) and Notice of Opposition (Inter Partes Case No. 1485) and Notice of Opposition (Inter Partes Case No. 1760) are both DISMISSED for having become moot. Registration Certificate No. SR-4213 and Application Serial No. 35963, both for the mark "VALENTINO & DESIGN" are hereby declared ABANDONED.

Let the records of these cases be forwarded to the Trademark/ Patent Registry & EDP Division (Inter Partes Case No. 1485) and the Application, Issuance and Publication Division (Inter Partes Case No. 1760) for appropriate action in accordance with this Decision.

SO ORDERED.

IGNACIO S. SAPALO
Director

SO ORDERED.

IGNACIO S. SAPALO
Director