



VICENTE CAMPOS,
Opposer,

-versus-

MOSLER PHILIPPINES, INC.,
Respondent- Applicant.

X-----X

} IPC No. 14-2013-00363
} Opposition to:
} Appln. Serial No. 4-2012-012873
} Date Filed: 19 October 2012
} TM: "MOSLER"

NOTICE OF DECISION

ATTY. ESTRELLITA BELTRAN-ABELARDO

Counsel for Opposer
Blk. 22, Lot 13 Singkil Street
Lagro Subdivision, Novaliches
Quezon City

HECHANOVA BUGAY VILCHEZ & ANDAYA-RACADIO

Counsel for Respondent- Applicant
GF Salustina D. Ty Tower
104 Paseo de Roxas, Makati City

GREETINGS:

Please be informed that Decision No. 2016 - 237 dated June 30, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, July 01, 2016.

For the Director:


Atty. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

Intellectual Property Center # 28 Upper McKinley Road, McKinley Hill Town Center, Fort Bonifacio,
Taguig City 1634 Philippines • www.ipophil.gov.ph
T: +632-2386300 • F: +632-5539480 • mail@ipophil.gov.ph

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MOSLER PHILIPPINES, INC.

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IPC No. 14-2013-00363

Opposition to:

Application No. 4-2012-012873

Date Filed: 19 October 2012

Trademark: "MOSLER"

Decision No. 2016- 237

DECISION

VICENTE CAMPOS¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-012873. The application, filed by Mosler Philippines, Inc.² ("Respondent-Applicant"), covers the mark "MOSLER" for use on "metal vault, safe, safety deposit box, metal vault doors" under Class 6 and "concrete vaults, not of metal" under Class 19 of the International Classification of Goods and Services.³

The Opposer alleges:

x x x
"I.

"GROUNDS FOR OPPOSITION

"1. The registration of the mark MOSLER in favor of Mosler Philippines, Inc. (Respondent-Applicant, for brevity) is contrary to Secs. 123 and 123.1(d) of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines as amended (IP Code) which provide that:

x x x

"2. Respondent-Applicant Mosler Philippines, Inc., is not entitled to register the mark MOSLER for goods under Class 6 for metal vault, safe, safety deposit box, metal vault doors and under Class 19 for concrete vaults, not of metal, as it is identical to Opposer Vicente K. Campos's duly registered trademark Mosler bearing Registration no. 4-2009-010929 issued on August 26, 2010 for goods under International class 6 for safes, vault doors, safety deposit box, which certificate of registration is marked and submitted as Exhibit 'B' and the mark itself as depicted, Mosler, as Exhibit 'B-1';

"3. Respondent-Applicant's MOSLER is proscribed registration under Section 123.1(d) of R.A. No. 8293 for being not only confusingly similar but identical to Opposer's registered mark Mosler not only as to the mark MOSLER but also as to the goods covered by both marks and therefore, likelihood of confusion is presumed under

¹A Filipino citizen with address located at #22 N. Domingo Street, Valencia, Quezon City.

²With address at Elisco Road, Brgy. Ibayo Tipas, Taguig City, Metro Manila, Philippines.

³The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on a multilateral treaty administered by the World Intellectual Property Organization. The treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks concluded in 1957.

Sec. 147.1 of R.A. No. 8293 otherwise known as the Intellectual Property Code of the Philippines which provides that:

x x x

"4. In fact, the Opposer has been using the trademark Mosler in commerce in the Philippines as early as December 2009 up to the present, through East Richwood Safe Company, Inc., the company to which he assigned his rights to the exclusive use to the trademark Mosler even prior to the filing of Respondent-Applicant's application for MOSLER, subject of Opposition, as shown by the Assignment of Rights To Use marked and submitted as Exhibit 'C';

"4.1. Opposer has been using the trademark Mosler since December 2009 or two months after he applied for registration of the mark Mosler with the Bureau of Trademarks of the Intellectual Property Office on October 26, 2009, up to the present, as shown by the sales invoices of East Richwood Safe Company, Inc. the company to which he assigned his rights to the exclusive use of the trademark Mosler.

"5. Being the prior actual user of the trademark Mosler in the Philippines in the concept of an owner, after Mosler Safe Company U.S.A's non-use of the mark Mosler in commerce in the Philippines for goods under class 6 namely: for safes, vault doors, safety deposit box, under the law and jurisprudence, the Opposer is the rightful owner of the mark MOSLER.

"5.1. In the case of Bata Industries, Ltd. versus The Honorable Court of Appeals, Tiburcio S. Evalle, Director of Patents, Ne Olympian Rubber Products Co., Inc., G.R. No. L-53672, May 31, 1982, relating to the trademark BATA used on rubber shoes, a Czechoslovakian product, the Supreme Court categorically held that 'any slight goodwill generated by the Czechoslovakian product during the commonwealth years was completely abandoned and lost in the more than 30 years that have passed since the liberation of Manila from the Japanese troops. The appellant has no Philippine goodwill that would be damaged by the registration of the mark in appellee's favor x x x"

"5.1.1. Applying the aforequoted decision of the Supreme Court to the case at hand, the registration by Opposer Vicente K. Campos after more than ten (10) years non-use of the trademark MOSLER by Mosler Safe Co. Inc. of U.S.A., no damage will be caused to said foreign company as it has no Philippine goodwill to protect as its registration of the mark MOSLER has already expired and is no longer valid and existing.

"5.2. Being the registered owner of the mark and the prior user of the mark MOSLER in the Philippines in the concept of an owner after it has been abandoned by Mosler Safe Company, Inc. of U.S.A., the Opposer Vicente K. Campos is entitled to its registration in the Philippines.

"6. Moreover, because of the later adoption by Respondent-Applicant Mosler Philippines, Inc. which company was only registered with the Securities and Exchange Commission on May 4, 2012, of Opposer's trademark Mosler, the buying public will easily be deceived or confused into believing that Respondent-Applicant's product also bearing the same trademark MOSLER, is a product of Opposer using the

same as a word mark hence, the likelihood of confusion not only of goods but also of the business is not only a probability but is a strong possibility.

x x x

"7. Likewise, Respondent-Applicant's adoption of Opposer's trademark MOSLER on goods/products under international classes 6 and 19 that are identical, similar or closely related to Opposer's products belonging to the same international class 6, demonstrates bad faith on the part of the Respondent-Applicant as it is done deliberately precisely to ride on the popularity and goodwill of the mark MOSLER which is Opposer's registered trademark.

x x x

"8. The resulting likelihood of confusion and assumption by the buying public that Respondent-Applicant's products bearing the mark MOSLER and Opposer's Mosler's products belongs to one source or origin or that it belongs to the same proprietor or business will cause substantial damage to the goodwill and reputation associated with the trademark Mosler of Opposer, hence, the registration of the Respondent-Applicant's mark MOSLER is contrary to the above quoted provision, Sec. 123.1 (d) of the IP Code.

"8.1. On the other hand, Articles 28 of the Civil Code and Section 168 of the IP Cod provide:

x x x

"8.2. Moreover, whether or not Opposer's trademark Mosler is registered, it is still protected under Section 168 of R.A. No. 8293, otherwise known as the Intellectual Property Code which provides that-

x x x

"8.3. The use of the identical trademark Mosler which is a registered trademark of Opposer as Respondent-Applicant's MOSLER is likely to influence purchasers to believe that the goods of which the Respondent-Applicant's MOSLER mark is applied are those of or come from, Opposer or a variant or new product of the Opposer.

"8.4. If allowed to proceed registration, the consequent use of the mark MOSLER by Respondent-Applicant will constitute unfair competition against Opposer' registered trademark Mosler, which has attained valuable goodwill and reputation through the years of extensive use. This is prohibited under the above-quoted provisions of the Paris Convention, Civil Code, and the Intellectual Property Code.

"9. Likewise, the use by the Respondent-Applicant of the mark MOSLER in relation to goods covered under the same international classes 6 and 19, the same class of goods which are related to that the Opposer's registered trademark Mosler, will take unfair advantage of, dilute, and diminish the distinctive character or reputation of Opposer's registered trademark Mosler, which is a valued asset of Opposer, and will clearly result in irreparable damage to Opposer's goodwill and reputation.

"9.1. In the recent case of Societe des Produits Nestle S.A. v. Martin T. Dy Jr., G.R. No. 172276 promulgated on August 8, 2010 the Supreme Court HELD that-

x x x

"10. The denial of the application for MOSLER for use on products under Classes 6 and 19 subject of this opposition which are identical, closely related and competitive to Opposer's Mosler also used under Class 6 is authorized under other provisions of Sec. 123.1 (d), Secs. 138, and 147 of R.A. 8293.

x x x

"II.

"FACTS TO SUPPORT THE OPPOSITION

"11. The records of the Intellectual Property will show that the trademark MOSLER was originally registered in 1952 in the name of Mosler Safe Company Inc., for goods under Class 6 for portable and built in place safes, safety cabinets, bank vault and safe, bank vault and safe doors, gates for vaults and safes, safe deposit boxes, steel cabinets for safety deposit and built in place, chests and boxes for safekeeping of various articles, lockers money chests, night deposit safe, chutes and receiving chests for use with and forming parts of night deposit safe fire proof safe and filing cabinets; locks and keys for safe and forming part thereof, vaults, desks, drawers and inside safe doors and gates classified according to the official classification of merchandise, locks and safes, bearing registration No. 001055 issued February 1952 which was effective twenty years counted from registration, or until February 12, 1972. However, said registration was not renewed by registrant Mosler Safe Company Inc. due to bankruptcy up to the present.

"12. Due to import restrictions, Mosler Safe Company, Inc. U.S.A. agreed to license Elizalde Security Group to undertake the manufacturing of Mosler safe and same vault doors in the Philippines sometime in the 60's up to 1998.

"13. In 1999, the Elizalde Security Group ceased to operate and its' employees set up Total Security Systems Inc. (TSSI) to take over the operations of Elizalde Security Group. However, Mosler Safe Company Inc., of U.S.A. did not renew its license to Elizalde Security Group nor to TSSI.

"14. The use of Elizalde Security Group of the mark MOSLER under a licensing agreement will not inure to its benefit as under the trademark law, the use of the trademark must be use in the concept of an owner, not under a license nor use without the consent or agreement of then owner, Mosler Safe Company Inc.

"15. In the meantime, TSSI developed and introduced a new brand 'DEFENDER' for its safes and vault doors in the Philippines.

"16. Because of the non-renewal by Mosler Safe Company, Inc. U.S.A. due to bankruptcy, of its Registration No. 001055 issued February 1952 which was only effective twenty years counted from registration, or until February 12, 1972, and which was not renewed up to the present, its registration has expired and is no longer valid and existing as of February 13, 1972.

"17. Moreover the non-renewal of its license to use the trademark MOSLER to the Elizalde Security Group nor to TSSI, the trademark MOSLER constitutes an abandonment of said trademark under Section 151.1 (c) of R.A. No. 8293 or the Intellectual Property Code of the Philippines.

"18. Due to Mosler Safe Company Inc.'s abandonment of use of the trademark MOSLER in the Philippines since 1999 or more than ten (10) years non-use in the Philippines, on October 26, 2009, Opposer Vicente K. Campos applied for the registration of the mark MOSLER in his favor and was granted Registration no. 4-2009-010929 issued on August 26, 2010 for goods under international class 6 for safes, vault doors, safety deposit box, which certificates of registration is marked and submitted as Exhibit 'B' and the mark itself as depicted Mosler, as Exhibit 'B-1';

19. Opposer has been using the trademark Mosler in the Philippines since December 2009 up to the present, through East Richwood Safe Company, Inc., the company which he assigned his rights to the exclusive use of the trademark Mosler prior to the filing date of Respondent-Applicant's application for MOSLER, subject of Opposition as shown by the attached Assignment of Rights to Use, likewise marked and submitted as Exhibit 'C';

"20. In fact, Mosler was first used in commerce in the Philippines by Mosler Vicente K. Campos as early as December 2009 or two months after he applied with the Bureau of Trademarks of the Intellectual Property Office for the registration of his trademark Mosler in the Philippines on October 26, 2009, up to the present, as shown by the sales Invoices of East Richwood Safe Company, Inc. the company to which he assigned his rights to the exclusive use of the trademark Mosler, marked and submitted in evidence as Exhibit 'D' for Summary of Sales and the duplicate original of the sales invoices marked and submitted as Exhibits 'D-1' to 'D-12.'

21. However, despite the fact that Opposer Vicente K. Campos continuously use in commerce the trademark MOSLER for the products under Class 6, as shown by the sales invoices marked as Exhibits 'D', 'D-1' to 'D-12', he inadvertently failed to file the Declaration of Actual Use which is due to be filed from October 26, 2009 up to October 26, 2012 and that was when herein Respondent filed the application subject of this Notice of Opposition. The records of the Intellectual Property Office will however, show that no cancellation order was issued by the Bureau of Trademarks. Considering that there was no cancellation order issued for his registration of the trademark Mosler, the mark is still registered as of the present, as cancellation of the mark cannot be presumed under the present IP Code, it has to be issued.

"22. In order to anticipate and ensure the continuity of his registration and to prove that he is the prior actual user of the trademark MOSLER in the concept of an owner in commerce in the Philippines after it was abandoned through non-use by Mosler Safe Company of U.S.A., Opposer filed an application for re-registration on January 4, 2013 bearing Application No. 42013000077, the printout of which is marked and submitted as Exhibit 'F'.

"23. On the other hand, Respondent-Applicant Mosler Philippines, Inc. filed its application for the registration of the mark MOSLER for the goods covered by its application under international Class 6 for metal vault, safe, safety deposit box, metal vault doors and Class 19 for concrete vaults, not of metal only on October 19, 2012 which company, Mosler Philippines, Inc., was registered with the Securities and Exchange Commission only on May 4, 2012, as shown by its Certificate of Incorporation issued by the Securities and Exchange Commission marked and submitted as Exhibit 'G'.

The Opposer's evidence consists of the Special Power of Attorney executed by Opposer Vicente K. Campos in favor of Atty. Estrellita Beltran-Abelardo of Estrellita Beltran-Abelardo Law Office; copy of Certificate of Registration No. 4-2009-010929 for the trademark MOSLER issued to Vicenke K. Campos on 26 August 2010 for goods under Class 6 namely safes, vault doors, safety deposit box; copy of the Assignment of Rights to use the trademark Mosler executed by Opposer Vicente K. Campos in favor of East Richwood Company, Inc.; copy of Summary of Sales Invoices showing sales of Mosler products and the sales invoices issued by East Richwood Co., Inc.; print-out of publication for opposition of the trademark MOSLER filed by Mosler Philippines, Inc. in the IPO e-gazette; copy of the application for re-registration on January 4, 2013 bearing Application No. 42013000077 for the trademark MOSLER filed by Opposer; copy of Certificate of Incorporation of Mosler Philippines Inc. as of May 4, 2012, issued by the Securities and Exchange Commission and Affidavit of Opposer, Vicente K. Campos.⁴

This Bureau issued a Notice to Answer and sent a copy thereof upon Respondent-Applicant on 22 November 2013. The Respondent-Applicant filed their Answer on 20 February 2014 and avers the following:

x x x

"AFFIRMATIVE ALLEGATIONS

"In support of the foregoing Specific Denials, and by way of qualification to the above admissions, Respondent-Applicant respectfully states:

"2.1 Sometime in the 1960's up to 1998, Mosler Safe Company, Inc. (USA) licensed the Elizalde Security Group to undertake the manufacturing and commercial distribution and sale of 'MOSLER' safes and vaults. In 1999, the Elizalde Security Group ceased to operate and its employees set up Total Security Systems, Inc. (TSSI) to take over the operations of the Elizalde Security Group. TSSI was licensed by Mosler Safe Company, Inc. (USA) to continue undertake the manufacturing and commercial distribution and sale of 'MOSLER' safes and vaults from 1999 until 2003, when Mosler Safe Company, Inc. (USA) totally ceased operations due to bankruptcy. In so doing, Mosler Safe Company, Inc. (USA) allowed TSSI to continue using the 'MOSLER' mark as its own for the manufacturing and commercial distribution and sale of 'MOSLER' safes and vaults. Sales invoices evidencing sales by TSSI of Mosler safes and vaults to various clients for the year 2003 are attached hereto as Exhibits '3' to '3-h'.

"2.2 Since 2004 up to its assignment of the mark MOSLER to Mosler Philippines, Inc. in May 2012, TSSI has been using the mark MOSLER in the concept of owner, in connection with the manufacturing, commercial distribution and sale of 'MOSLER' safes and vaults.

⁴Marked as Exhibits "A" and "H", inclusive.

"2.2.1 Notice of Award, purchase orders and sales invoices evidencing sales by TSSI of Mosler safes and vaults to Land Bank of the Philippines for the years 2004 are attached hereto as Exhibits '4' to '4-d'.

"2.2.2 Purchase orders and sales invoices evidencing sales by TSSI of Mosler safes and vaults to various clients for the year 2005 are attached hereto as Exhibits '5' to '5-e'.

"2.2.3 Purchase orders and sales invoices evidencing sales by TSSI of Mosler safes and vaults to various clients for the year 2006 are attached hereto as Exhibits '6' to '6-I'.

"2.2.4 Purchase orders and sales invoices evidencing sales by TSSI of Mosler safes and vaults to various clients for the year 2007 are attached hereto as Exhibits '7' to '7-s'.

"2.2.5 Purchase orders and sales invoices evidencing sales by TSSI of Mosler safes and vaults to various clients for the year 2008 are attached hereto as Exhibits '8' to '8-y'.

"2.2.6 Purchase orders and sales invoices evidencing sales by TSSI of Mosler safes and vaults to various clients for the year 2009 are attached hereto as Exhibits '9' to '9-u'.

"2.2.7 Purchase orders and sales invoices evidencing sales by TSSI of Mosler safes and vaults to various clients for the year 2010 are attached hereto as Exhibits '10' to '10-w'.

"2.2.8 Purchase orders and sales invoices evidencing sales by TSSI of Mosler safes and vaults to various clients for the year 2011 are attached hereto as Exhibits '11' to '11-y'.

"2.2.9 Purchase orders and sales invoices evidencing sales by TSSI of Mosler safes and vaults to various clients for the year 2012 are attached hereto as Exhibits '12' to '12-s'.

"2.3 The original Certification from Goldilocks as to their purchase of MOSLER safes and vaults since 1998 from TSSI is attached hereto as Exhibit '13'.

"2.4 On 04 May 2012, Mosler Philippines, Inc. was incorporated. On 20 May 2012, TSSI, in order to streamline its operations, assigned its rights as prior user and owner of the mark 'MOSLER' to Mosler Philippines, Inc. It was agreed between the parties that TSSI can continue to sell 'MOSLER' safes and vaults until TSSI has depleted its inventory of 'MOSLER' safes and vaults. An original of the Deed of Assignment is attached hereto as Exhibit '14'.

"2.5 The truth of these claims are attested to by Mr. Rufino Fajardo, General Manager of TSSI and Operations Manager of Mosler Philippines, Inc., whose Affidavit Testimony is attached hereto as Exhibit '15'.

"SPECIAL AND AFFIRMATIVE DEFENSES

"3.1 MOSLER is Respondent's registered business name. Sight should not be lost on the fact that such corporate name/service mark is also protected under the Paris Convention and the IP Code, without need of registration. Article 6sexies and Article 8 of the Paris Convention provide:

x x x

"3.2 Under the Intellectual Property Code of the Philippines, a trade name is defined as the name or designation identifying or distinguishing an enterprise while the mark means any visible sign capable of distinguishing the goods (trademark) or service (service mark) of an enterprise and shall include a stamped or marked container of goods. Trade name refers to the business and its goodwill; a trademark refers to the goods.

"3.3 In Philips Export B.V. vs. Court of Appeals, the Supreme Court enunciated the right of a corporation to use its corporate and trade name. The Court held:

x x x

The Respondent-Applicant's evidence consists of the Special Power of Attorney and Secretary's Certificate executed and issued by Respondent-Applicant, Mosler Philippines, Inc., in favor of the Law Firm of HECHANOVA, BUGAY & VILCHEZ; copy of the Certification issued by the Bureau of Trademarks as to the removal of Certificate of Registration No. 4-2009-010929; sales invoices evidencing sales by TSSI of Mosler sales and vaults to various clients for the year 2003; notice of award, purchase orders and sales invoices evidencing sales by TSSI of Mosler safes and vaults to Land Bank of the Philippines for the years 2004; purchase orders and sales invoices evidencing sales by TSSI of Mosler safes and vaults to various clients for the years 2005-2012; copy of Certification from Goldilocks as to their purchase of MOSLER safes and vaults since 1998 from TSSI; copy of the Deed of Assignment wherein TSSI assigned its rights as prior user and owner of the mark MOSLER to Mosler Philippines, Inc.; and Affidavit-Testimony of Mr. Rufino Fajardo, General Manager of TSSI and Operations Manager of Mosler Philippines, Inc.⁵

On 25 March 2015, the Preliminary Conference was terminated and the parties were directed to file their respective position papers. Thereafter, the case was deemed submitted for resolution.

Should the Respondent-Applicant be allowed to register the trademark MOSLER?

The Opposer anchors its opposition on Sections 123.1, paragraph (d) , 138 and 147 of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), to wit:

Sec. 123.Registrability. - 123.1. A mark cannot be registered if it:

⁵Marked as Exhibits "1" and "15", inclusive.

x x x

(d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of :

- (i) The same goods or services, or
- (ii) Closely related goods or services, or
- (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion;"

Sec. 138. *Certificates of Registration.* – A certificate of registration of a mark shall be *prima facie* evidence of the validity of the registration, the registrant's ownership of the mark, and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate.

Sec. 147. *Rights Conferred.* – 147.1. The owner of a registered mark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs or containers for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use, of an identical sign for identical goods or services, a likelihood of confusion shall be presumed.

Records show that at the time the Respondent-Applicant filed its trademark application on 19 October 2012, the Opposer has existing trademark registration for MOSLER under Trademark Reg. No. 4-2009-010929 issued on 26 August 2010. The registration covers "safes, vault doors, safety deposit boxes" in Class 06. Due to Opposer's failure to file the required Declaration of Actual Use, the said registration is now subject for removal from the Registry for Non-filing of Declaration of Actual Use within three (3) years from the filing date. This Bureau noticed that the goods covered by the Respondent-Applicant's trademark application is identical and/or closely-related to the Opposer's.

A comparison of the competing marks reproduced below:

Mosler

Opposer's trademark

MOSLER

Respondent-Applicant's mark

shows that the marks are obviously identical and used on similar and/or closely related goods, particularly, safes, vaults and safety deposit box. Thus, it is likely that the consumers will have the impression that these goods originate from a single source or origin. The confusion or mistake would subsist not only on the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinary prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Here, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.⁶

Public interest therefore requires, that two marks, identical to or closely resembling each other and used on the same and closely related goods, but utilized by different proprietors should not be allowed to co-exist. Confusion, mistake, deception, and even fraud, should be prevented. It is emphasized that the function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him, who has been instrumental in bringing into the market a superior article of merchandise, the fruit of his industry and skill; to assure the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product.⁷

As stated, the "MOSLER was originally registered in 1952 in the name of Mosler Safe Company Inc. U.S.A.....Because of the non-renewal by Mosler Safe Company, Inc. U.S.A., due to bankruptcy, of its Registration No. 001055 issued in 1952, its registration has expired and is no longer valid and existing as of February 13, 1972...On October 26, 2009, Opposer applied for registration of the mark MOSLER in his favor and was granted Registration No. 4-2009-010929. Due to his failure to submit the Declaration of Actual Use, Opposer filed an application for re-registration on January 4, 2013. Opposer has been using the trademark MOSLER in the Philippines since December 2009 up to the present..."⁸ On the other hand, the Respondent-Applicant, Mosler Philippines, Inc. after it was incorporated in May 2012, applied for registration of the MOSLER mark in October 2012. No evidence was presented by Respondent-Applicant to show that it was licensed by Mosler Safe Company, Inc. U.S.A. after the termination of the licensing agreement between the latter and Elizalde Security Group in 1998. Opposer applied for registration of the mark MOSLER in 2009 and was eventually granted registration under Trademark Registration No. 4-2009-010929 in 2010, which to date, has not been removed from the Register.

In conclusion, because of Opposer's earlier filing date, Respondent-Applicant's trademark application is covered by the proscription under Sec. 123.1(d) of the IP Code.

⁶ *Converse Rubber Corp. v. Universal Rubber Products, Inc. et. al.*, G.R. No. L-27906, 08 Jan. 1987.

⁷ *Pribhas J. Mirpuri v. Court of Appeals*, G.R. No. 114508, 19 November 1999, citing *Ethepa v. Director of Patents, supra*, *Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).

⁸ Paragraphs 11, 16, 18, 19 and 22 of the Opposition.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2012-012873 is hereby SUSTAINED. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 30 JUN 2018.


ATTY. NATHANIEL S. AREVALO
Director IV, Bureau of Legal Affairs