

## DECISION OF THE PHILIPPINE PATENT OFFICE

*Mensi and Co., Inc., Opposer, vs. Andres Co, Respondent-Applicant, T. M. Dec. No. 10, s. 1952.*

**TRADEMARK ACT; SOURCE OF OWNERSHIP OF A TRADEMARK.**—The ownership of a trademark springs from its adoption and use. Ownership does not arise from its registration. He who first adopts and uses a trademark is considered the owner thereof (Act No. 666, sec. 2, 3; Rep. Act No. 638, sec. 1; Recamier v. Ayer, 59 F (2d) 802, 806; Keystone v. Arena, 27 F. Supp. 290, 293; McLean v. Fleming, 24 L. ed. 828).

**IBID; EFFECT OF REGISTRATION OF A TRADEMARK.**—Registration produces for the owner of a trademark only procedural advantages in court — advantages which spring from the statutory declaration that a certificate of registration is *prima facie* evidence of the registrant's ownership of the trademark, of his exclusive right to use it on certain products, and of certain other matters (Rep. Act No. 166, sec. 20; Act No. 666, sec. 16).

**IBID; FAILURE TO REGISTER ONE'S TRADEMARK.**—A person's failure to register his trademark under the Trademark Act does not affect his rights of ownership over it. (Ansehl v. Williams, 267 F. 9, 14, and cases cited). Such failure to register does not of itself result in the abandonment and in the relinquishment of his proprietary rights thereover.

**IBID; ABANDONMENT OF A TRADEMARK.**—Abandonment is a matter not only of the non-user of a trademark but of the actual intent to abandon it, as well, both of which factors need be established by evidence by him who asserts it (Ansehl v. Williams, *supra*; p. 13; Saxlehner v. Eisner, 45 L. ed. 60; Wallace v. Repetti, 266 F. 807).

**IBID; CLAIM TO THE EXCLUSIVE USE OF TRADEMARK.**—The claim to the exclusive use, or ownership, of a trademark is a continuing right in the owner (Heger v. Polk, 47 F (2d) 966, 969 and cases cited).

**IBID; MEANING OF THE TERM "MARK" AS USED IN SECTION 8.**—The broad term "mark" used in Sec. 8 of the Trademark Act (Rep. Act No. 166, as amended) means a "trademark" or a "service mark."

**IBID; PERSONS WHO MAY OPPOSE REGISTRATION OF TRADEMARK.**—There is nothing in the language of Sec. 8 of our statute that would justify the interpretation that no person may oppose a registration, unless he owns a trademark and that trademark is registered; and, if the same is not registered, that he must at least, have *exclusive* rights to it. The fact that the statute directs that copies of foreign certificates of registration should be attached to the opposition, does not necessarily mean that the ownership of a registered trademark or of an *unregistered* exclusive trademark, is required as a basis for opposition. All that appears necessary is that the opposer allege in the opposition that he is using something or other on his goods *by way of a mark*; that the trademark sought to be registered by the applicant so closely resembles this mark, that he believes that he would be damaged by the registration of the applicant's trademark.

**IBID; UNFAIR COMPETITION; JURISDICTION OF THE PATENT OFFICE.**—The Principal Register of the trademark statute, on which the Respondent-Applicant seeks registration of his trademark *Señorita*, is not concerned with labels or their appearances; it is concerned exclusively with trademarks. The appearance of labels falls under the law of unfair competition, not under the trademark law proper. Over matters of unfair competition, the Patent Office has no jurisdiction (Sec. T. M. Dec. No. 2, s. 1951).

### ORDER

The Respondent-Applicant moves that the Opposition filed by

the Opposer be dismissed on the ground that, upon the facts set forth in said Opposition, the Opposer is not entitled to oppose the registration in favor of the Respondent-Applicant of the trademark under dispute.

The Respondent-Applicant has applied, under the current Trademark Act (Rep. Act. No. 166, as amended), for the registration of a trademark, *Señorita*, which he claims to have used on bobby pins since the year 1948. Under Sec. 8 of the Act, the Opposer has opposed the registration upon the ground that it would be damaged by the said registration, having used the same trademark, *Señorita*, on identical articles, since the year 1932.

The Opposer alleges that its trademark *Señorita* was registered in 1934 under the old trademark Act No. 666, which was repealed on June 20, 1947, by the current Trademark Act, Rep. Act No. 166, approved on the same date. It admits that the said trademark has not been re-registered under the current Act either under its Sec. 41(a) or as a new, original registration.

It is because of this fact that the Opposer's trademark *Señorita* has not been re-registered under the current Act, and because nobody, according to him, can have exclusive rights to the designation *Señorita*, as used on bobby pins, that the Respondent-Applicant moves that the Opposition be dismissed. The Respondent-Applicant understands that by its failure to re-register its trademark *Señorita* under the current Act, the Opposer should be deemed to have abandoned and relinquished all its rights to said trademark; and, being deemed to have abandoned and relinquished said rights, it is now not entitled to oppose the registration of the same trademark *Señorita*, for the same goods, to the Respondent-Applicant. The Respondent-Applicant also understands that a person who has no exclusive rights to a mark he is using on certain goods may not be allowed to oppose the registration, in favor of another, of the same mark used on similar articles.

Whether or not the positions taken by the Respondent-Applicant are correct, is the issue for decision in this Order.

The Opposer alleges that it is the owner of the trademark *Señorita*. The ownership of a trademark springs from its adoption and use. Ownership does not arise from its registration. He who first adopts and uses a trademark is considered the owner thereof (Act No. 666, sec. 2, 3; Rep. Act No. 638, sec. 1; Recamier v. Ayer 59 F(2d) 802, 806; Keystone v. Arena, 27 F. Supp. 290, 293; McLean v. Fleming, 24 L. ed. 828). Registration produces for the owner of a trademark only procedural advantages in court — advantages which spring from the statutory declaration that a certificate of registration is *prima facie* evidence of the registrant's ownership of the trademark, of his exclusive right to use it on certain products, and of certain other matters (Rep. Act No. 166, sec. 20; Act No. 666, sec. 16). A person's failure to register his trademark under the Trademark Act does not affect his rights of ownership over it. (Ansehl v. Williams. 267 F 9, 14, and cases cited). Such failure to register does not of itself result in the abandonment and in the relinquishment of his proprietary rights thereover. Abandonment is a matter not only of the non-user of a trademark but of the actual intent to abandon it, as well, both of which factors need be established by evidence by him who asserts it (Ansehl v. Williams, *supra*, p. 13; Saxlehner v. Eisner, 45 L. ed. 60; Wallace v. Repetti, 266 F 807). The claim to the exclusive use, or ownership, of a trademark is a continuing right in the owner (Heger v. Polk, 47 F(2d) 966, 969 and cases cited).

The claim, therefore, of the Respondent-Applicant that the Opposer has no right to make opposition in this case, because it has lost its proprietary rights to the trademark *Señorita*, through its failure to register it under the current Trademark Act, cannot be sustained.

The section of the current Trademark Act relating to opposition provides as follows:

"Sec. 8. *Opposition* — Any person who believes that he would be damaged by the registration of a mark or tradename may, upon payment of the required fee and within thirty days after the publication under the first paragraph of section

seven hereof, file with the Director an opposition to the application. Such opposition shall be in writing and verified by the oppositor, or by any person on his behalf who knows the facts, and shall specify the grounds on which it is based and include a statement of the facts relied upon. Copies of certificates of registration of marks or trade-names registered in other countries or other supporting documents mentioned in the opposition shall be filed therewith, together with the translation thereof into English, if not in the English language. For good cause shown and upon payment of the required surcharge, the time for filing an opposition may be extended for an additional thirty days by the Director, who shall notify the applicant of such extension."

The broad term "mark" used in this Section means a "trademark" or a "service mark."

Sec. 6 of the U.S. Trademark Act of Feb. 20, 1905, declares:

"Sec. 6. \*\*\* Any person who believes he would be damaged by the registration of a mark may oppose the same by filing notice of opposition, stating the grounds therefor, in the Patent Office within thirty days after publication of the mark sought to be registered, which said notice of opposition shall be verified by the person filing the same before one of the officers mentioned in section two of this Act. An opposition may be filed by a duly authorized attorney, but such opposition shall be null and void unless verified by the opposer within a reasonable time after such filing. If no notice of opposition is filed within said time, the commissioner shall issue a certificate of registration therefor, as hereinafter provided for.\*\*\*"

Sec. 13 of the current U.S. Trademark Act of 1946, reads:

"Any person who believes that he would be damaged by the registration of a mark upon the principal register may, upon payment of the required fee, file a verified notice of opposition in the Patent Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 12 of this Act of the mark sought to be registered. For good cause shown, the time for filing notice of opposition may be extended by the Commissioner, who shall notify the applicant. An unverified opposition may be filed by a duly authorized attorney, but such opposition shall be null and void unless verified by the opposer within a reasonable time after such filing to be fixed by the Commissioner."

There is nothing in the language of the above Sec. 8 of our statute that would justify the interpretation that no person may oppose a registration, unless he owns a trademark and that trademark is registered; and, if the same is not registered, that he must, at least, have exclusive rights to it. The fact that the statute directs that copies of foreign certificates of registration should be attached to the opposition, does not necessarily mean that the ownership of a registered trademark or of an unregistered exclusive trademark, is required as a basis for opposition. All that appears necessary is that the opposer allege in the opposition that he is using something or other on his goods by way of a mark; that the trademark sought to be registered by the applicant so closely resembles this mark, that he believes that he would be damaged by the registration of the applicant's trademark.

Construing the above cited Sec. 6 of the U.S. Trademark Act of Feb. 20, 1905, the Court of Appeals of the Dist. of Columbia said in *Broderie v. Mitchell*, 289 F 618, 619 (1923):

"Section 6 of the Trade-Mark Act (Comp. St. § 9491), as construed by this court in *Arkell Safety Bag Co. v. Safepack Mills*, — App. D. C. —, 289 Fed. 616, decided at this sitting, gives the right to any one who believes that the mark of an applicant would damage him the right to oppose its registration. In order that he may maintain his opposition it is not necessary that he should have a registered mark, or one that is registrable. *Atlas Underwear Co. v. B. V. D. Co.*, 48 App. D. C. 425 *McIlhenny Co. v. Trappey*, 51 App. D. C. 216, 277 Fed. 615. If the mark of the applicant is so nearly like his as to be likely to lead intending purchasers to believe that the goods of the applicant were put out by the opposer, and to buy them on that assumption, thereby damag-

ing the latter, the statute affords him a right to object to the applicant's mark being registered. It may be that the opposer is not entitled to the exclusive use of his mark. None the less he has the right to resist the applicant's attempt to appropriate to himself its exclusive use where, as here, the use of the two marks would probably deceive" (underscoring supplied)

In another case, *Touraine v. Washburn*, 286 F 1020, 1022 (1923), the same court said:

"The trademark statute (section 6, 33 Stat. 726) is our chart. There is nothing in it which says that a person must own a trademark, registered or not, before he can oppose the registration of the mark of another person. All that the statute requires of him, according to our interpretation, is to prove facts, which, if true, would tend to show that he would probably be damaged by the registration."

To the same effect are the decisions in the following cases: *California Cyanide v. American Cyanamid*, 40 F(2d) 1003, 1005 (1930); *Trustees v. McCreery*, 49 F(2d) 1068, 1071 (1931); *Helsberg v. Katz*, 73 F(2d) 626, 628 (1934); *Pep Boys v. Fisher*, 94 F(2d) 204, 209, (1938); *Vi-Jon v. Lenthric*, 133 F(2d) 947, 948 (1943); *Weinberg v. Riverside*, 76 USPQ 218, 219 (1948); *Juillard v. American Woolen* 77 USPQ 21, 22 (1948); *Raymond v. Duart*, 77 USPQ 662, 663 (1948); *First Industrial v. Pierce* 78 USPQ 152 (1948); *Goldring v. Adler*, 78 USPQ 290 (1948); *Denny v. Elizabeth Arden*, 79 USPQ 214, 215 (1948); *Seek v. Moran*, 84 USPQ 249, 250 (1950); *Packwood v. Cofax* 86 USPQ 410, 413 (1950); *Noma Electric v. On-A-Lite Corp.*, 92 USPQ 283 (1952).

In the cited *Packwood v. Cofax* case (1950) the U.S. Court of Customs and Patent Appeals said:

"Appellant, as the opposer, to the registration of a trademark is entitled in such proceedings to rely not only upon its previously registered trademark, but also upon tradenames and designs previously used on labels and in advertising literature in a manner analogous to a trademark use. (*Wood v. Servel*, 77 F(2d) 946, 25 USPQ 488; *Virginia Dare v. Dare*, 70 F(2d) 118, 21 USPQ 334)" (underscoring supplied)

The objection, therefore, that the Opposer has no right to make opposition because it has no exclusive rights to the designation *Señorita*, as used on bobby pins, cannot be sustained.

Another ground advanced by the Respondent-Applicant for the dismissal of the Opposition is that the label bearing his *Señorita* and the label displaying the Opposer's *Señorita* are so distinctly dissimilar in appearance that the use of both trademarks cannot possibly produce any confusion in the public mind, and cannot, therefore, damage the Opposer.

The Principal Register of the trademark statute, on which the Respondent-Applicant seeks registration of his trademark *Señorita*, is not concerned with labels on their appearances; it is concerned exclusively with trademarks. The appearance of labels falls under the law of unfair competition, not under the trademark law proper. Over matters of unfair competition, the Patent Office has no jurisdiction (See T. M. Dec. No. 2, s. 1951). Because the Patent Office has no jurisdiction over the appearance of labels, it does not take the same into account when considering whether or not a given trademark is registrable. Besides, what assurance is there that the appearance of the label bearing the trademark sought to be registered would not be changed, in the future, by the applicant?

In *Tungsten, etc. v. Sureline, etc.*, 79 USPQ 272, 273 (1948), the U. S. Commissioner of Patents said:

"Applicant emphasizes the fact that in actual use the marks of the parties are applied to packages, and that the packages of the respective parties are entirely different in color, type of printing and general appearance. The record clearly discloses that there is no similarity between these packages. The question involved in this proceeding is, however, limited to applicant's right to register the mark shown in its application. While applicant has used this mark for a considerable period

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Besides, Justice Reyes fails to grasp the method of the new Civil Code in Sec. 2 — "Order of Intestate Succession". By Articles 978, 985, 988, 995, 1001, and 1103, the Code names the relatives who, in the order stated, inherit the whole estate. Article 978 assumes that there is no surviving spouse.  
(To be Continued)

## A CRITICAL STUDY...

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### CONCLUSIONS AND RECOMMENDATIONS

Much of the possible difficult situations we have endeavored to present which cannot be adequately solved by the present provisions of the Code without absurd results may be remedied by eliminating the conclusive presumption of legitimacy provided for in Article 258 of the present Civil Code in any of the three cases therein mentioned. This will make the present rigors of the law more flexible to permit its rigidity yield to the realities of life.

The *prima facie* presumption of illegitimacy provided for in Article 267 (C. C.) should be reversed. The presumption of legitimacy should be the rule, but its rebuttal should be allowed under the conditions and circumstances mentioned in Article 257 (C. C.) and adding thereto the case of rape of the wife during the same period of time. Articles 255 and 259 may remain as they are subject to a modification of Article 259 (C. C.) for clarity only by incorporating to the opening paragraph thereof the following phrase, "notwithstanding the provisions of Article 255".

It is, therefore, recommended that Articles 257, 258 and 259 of the Civil Code be redrafted to read as follows:

"Art. 257. In case of the commission of adultery by the wife or rape of the wife at or about the time of conception of the child, but there was no physical impossibility of access by the husband to the wife as set forth in Article 255, the presumption of legitimacy therein provided, may be overcome by proof that it is highly improbable for ethnic reasons that the child is that of the husband. For purposes of this Article the adultery or the rape as the case may be need not be proved in a criminal case." (Patterned after House Bill No. 1019; Francisco, I Civil Code of the Philippines 683).

"Art. 258. A child born within one hundred eighty days following the celebration of the marriage is *prima facie* presumed to be legitimate."

"Art. 259. If the marriage is dissolved by the death of the husband, and the mother contracted another marriage within three hundred days following such death, these rules shall govern, notwithstanding the provisions of article 255:

(1) A child born before one hundred eighty days after the solemnization of the subsequent marriage is disputably presumed to have been conceived during the former marriage, provided it be born within three hundred days after the death of the former husband;

(2) A child born after one hundred eighty days following the celebration of the subsequent marriage is *prima facie* presumed to have been conceived during such marriage, even though it be born within the three hundred days after the death of the former husband."

\* \* \*

## DECISION OF THE...

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of time on a particular style of packages any registration which might issue upon its application would not be limited to use upon such packages, and the packages used could be changed by either party at any time. *Ambrosia Chocolate Co. v. Myron Foster*, 608 O. G. 545, 74 USPQ 307. *Under well settled authority* (General Food Corporation v. Casein Company of America, Inc. 27 C.C.P.A. 797, 108 F.2d 261 (44 USPQ 33); *Barton Mfg. Co. v. Hercules Powder Co.*, 24 C.C.P.A. 982, 88 F.2d 708 (33 USPQ 105); *Sharp & Dohme, Incorporated v. Abbott Laboratories*, 571 O. G. 519, 64 USPQ 247), *the differences in packaging can not affect the right to registration.*" (underscoring supplied)

In view of the well-settled principle that an opposer need not own a trademark; a registered trademark; or have exclusive rights

## FOR THE SAKE OF TRUTH

BY PORFIRIO C. DAVID

I wish to make a vigorous exception to Mr. Federico B. Moreno's article ROLL OF HONOR (of judges of First Instance) as published in the Sunday Times Magazine of May 9, 1954.

I do not question Mr. Moreno's right to praise a particular judge or group of judges. For the consumption of the public, he can even raise them to the level of an Arellano, a Cardozo or Holmes. But, he has no right to do so at the expense of other judges whom he had degraded and ridiculed by publishing his conclusions about their efficiency on the basis of half-truths and mis-truths.

The proficiency of a judge cannot be correctly measured by the precise action of the Supreme Court on his appealed decisions and orders for only one year (last year) and on the applications for writs of certiorari, prohibition and mandamus decided in the preceding three years and on the basis of important cases settled by the Court of Appeals in 1952 and 1953 as published in the Official Gazette. One who is familiar with the machinery of justice, like Mr. Moreno, who is a lawyer, should know that not all decisions are published in the Official Gazette. Hence, to rate a judge on what might have been published of his appealed decisions in the Official Gazette alone would be the height of irresponsibility.

Take, for instance, the particular cases of Judges Barot, Moscoso and Ocampo, who are represented to have had no affirmed decisions of any sort during the period given. This is unbelievable. I regret that I do not have offhand the records of Judge Moscoso, who is in the Visayas, and of Judge Barot, who is in Pampanga. But from the records alone of Judge Ocampo as available in the Office of the Clerk of Court of the Court of First Instance of Manila, where said judge has been presiding since 1951, I can say that the conclusions of Mr. Moreno about these judges are at once preposterous and gratuitous, if not libelous.

In this connection, I am supporting my stand with the facts and figures appearing on the correct copies of Reports of Cases decided by Judge Ocampo and brought to the Appellate Courts, duly certified by the clerks in charge, which are self-explanatory.

Summarizing, I find:

Criminal cases appealed .....	34
Affirmed .....	8
Modified .....	3
Appeal abandoned .....	8
Reversed .....	2
Pending .....	13
Civil cases appealed to Supreme Court .....	4
Pending .....	2
Affirmed .....	2
Reversed .....	None
Civil cases appealed to the Court of Appeals ..	19
Pending .....	13
Appeal dismissed or abandoned .....	4
Affirmed .....	2
Reversed .....	None

If only to set the record straight and to correct any wrong impression which Mr. Moreno's article may have produced on the readers' minds, I have taken pains to dig up the above facts and figures.

to a trademark, registered or unregistered; all he needs being something which is analogous to a trademark, and a showing that he would probably be damaged by the registration sought; and in view of the equally well-settled principle that the appearance of the labels bearing the rival trademarks cannot affect the right to registration of one of them, the motion to dismiss the Opposition is rejected, and the Respondent-Applicant is directed to answer the same within fifteen (15) days of his receipt of a copy hereof.

SO ORDERED.

Manila, Philippines, October 31, 1952.

(SGD.) CELEDONIO AGRAVA  
Director of Patents