

JOSE P. STA. ANA, PETITIONER, VS. FLORENTINO MALIWAT AND TIBURCIO S. EVALLE, IN HIS CAPACITY AS DIRECTOR OF PATENTS, RESPONDENTS.

G.R. No. L-23023. August 31, 1968

Ponente: REYES, J.B.L., J.

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REYES, J.B.L., J.:

Petition for review of the decision of the respondent Director of Patents in an interference proceeding[1] (Inter Partes Case No. 291) finding for the senior party applicant, Florentino Maliwat, the herein private respondent, and against the junior party applicant[2], Jose P. Sta. Ana, the herein petitioner.

On 21 June 1962, Florentino Maliwat filed with the Patent Office an application for registration of the trademark FLORMANN, which is used on shirts, pants, jackets and shoes for ladies, men, and children, claiming first use in commerce of the said mark on 15 January 1962. The claim of first use was subsequently amended to 6 July 1955.

On 18 September 1962, Jose P. Sta. Ana filed an application for the registration of the trade-name FLORMEN SHOE MANUFACTURERS (SHOE MANUFACTURERS disclaimed)[3], which is used in the business of manufacturing ladies' and children's shoes. His claim of first use in commerce of the said tradename is 8 April 1959.

In view of the admittedly confusing similarity between the trade mark FLORMANN and the tradename FLORMEN, the Director of Patents decreed an interference. After trial, the respondent Director gave due course to Maliwat's application and denied that of Sta. Ana. The latter, not satisfied with the decision, appealed to this Court.

The petitioner assigned the following errors:

"I. The Director of Patents erred in not finding that respondent (senior party-applicant) failed to establish by clear and convincing evidence earlier date of use of his mark FLORMANN than that alleged in his application for registration, hence, respondent is not entitled to carry back the date of first use to a prior date.

"II. The Director erred in holding that respondent is the prior adopter and user of his mark and in concluding that this is strengthened with documentary evidence that respondent has been using his mark since 1953 as tailor and haberdasher.

"III. The Director of Patents erred in not finding false and fabricated respondent's testimonial and documentary evidence and Director should have applied the rule 'Falsus in uno, falsus in omnibus' and should have disregarded them.

"IV. The Director of Patents erred in declaring that Maliwat has the prior right to the use of his trademark on shoes and such right may be carried back to the year 1953 when respondent started his tailoring and haberdashery business, and in holding that the manufacture of shoes is within the scope of natural expansion of the business of a tailor and haberdasher.

"V. The Director of Patents erred in failing to apply the stricture that parties should confine use of their respective marks to their corresponding fields of business, and should have allowed the concurrent use of trade-name FLORMEN SHOE MANUFACTURERS and the trademark FLORMANN provided it is not used on shoes."

The findings of the Director that Malivvat was the prior adopter and user of the mark cannot be contradicted, since his findings were based on facts stipulated in the course of the trial in the interference proceedings. The recorded stipulation is as follows:

"ATTY. FRANCISCO: Your honor please, with the mutual understanding of the counsel for the Junior Party and the counsel for the Senior Party in their desire to shorten the proceedings of this case, especially on matters that are admitted and not controverted by both parties, they have agreed and admitted that Mr. Jose P. Sta. Ana, the Junior Party Applicant in this case, is engaged solely in the manufacture of shoes under the firm name FLORMEN SHOE MANUFACTURERS since April 1959; that the name FLORMEN SHOE MANUFACTURERS is registered with the Bureau of Commerce on April 8, 1959, as shown by Exhibits 'A' and 'A-2'. That Mr. Florentino Maliwat has been engaged in the manufacture and sale of men's wear, shirts, polo shirts, and pants, since 1953, using FLORMANN as its trademark. That Mr. Florentino Maliwat began using the trademark FLORMANN on shoes on January 1962 and the firm name FLORMANN SHOES under which these shoes with the trademark FLORMANN were manufactured and sold was first used on January 1962, having also been registered with the Bureau of Commerce on January 1962 and with other departments of the government, like the Bureau of Labor, the Social Security System and the Workmen's Compensation in 1962.

ATTY. MARA VILLA: On behalf of the Senior Party Applicant, represented by this humble representation, I respectfully concur and admit all those stipulations abovementioned.

HEARING OFFICER: The court reserves the resolution on those stipulations. We can proceed now with the redirect examination." (T.s.n., 9 August 1963, pp. 33-34)

And the Rules of Court provide:

"SEC. 2. Judicial admissions.— Admissions made by the parties in the pleadings, or in the course of the trial or other proceedings do not require proof and can not be contradicted unless previously shown to have been made through palpable mistake." (Rule 129, Revised Rules of Court)

Since the aforequoted stipulation of facts has not been shown to have been made through palpable mistake, it is vain for the petitioner to allege that the evidence for respondent Maliwat is false, fabricated, inconsistent, indefinite, contradictory, unclear, unconvincing, and unsubstantial.

The rule on judicial admissions was not found or provided for in the old Rules but can be culled from rulings laid down by this Court previous to its revision (*Irlanda v. Pitargue*, 22 Phil. 383; 5 Moran 57-59, 1963 Ed.). It was the law, then and now, being an application of the law on estoppel.

To be true, petitioner Sta. Ana, through counsel, filed with this Court, on 24 December 1964, a motion entitled "MOTION TO ORDER STENOGRAPHER TO PRODUCE STENOGRAPHIC NOTES AND TO CORRECT TRANSCRIPT OF STENOGRAPHIC NOTES; TO ALLOW PETITIONER TO WITHDRAW FROM STIPULATION OF FACTS AND BE ALLOWED TO PRESENT ADDITIONAL EVIDENCE; AND TO SUSPEND PERIOD FOR FILING PETITIONER'S BRIEF." The reason given was that "counsel for Mr. Jose P. Sta. Ana does not recall making any stipulation or agreement of facts with the counsel of Mr. Florentino Maliwat on 9 August 1963". Opposition thereto was filed by Maliwat, asserting that the stenographer took down notes on those things which were stated and uttered by the parties; the movant should have moved for reconsideration in

the Patent Office, instead of here in the Supreme Court, which is both untimely and unhonorable.

Upon requirement by this Court, stenographer Cleofe Rosales commented on petitioner's motion that what she had taken down were actually uttered by counsel for Sta. Ana, no more, no less; that it was practically and highly impossible for her to have intercalated into the records the questioned stipulation of facts because of the tength of counsel's manifestations and the different subject matters of his statements, aside from the concurrence of Maliwat's counsel and the reservation on the resolution made by the hearing officer; and that despite her length of service, since 1958, as stenographic reporter, there had been no complaint against her, except this one.

Counsel for Sta. Ana replied to the foregoing comments, alleging, among others, that after his receipt of the decision, after 5 May 1964, he bought the transcript and requested the stenographer to verify the contents of pages 33 and 34 of her transcript but, despite several requests, and for a period of seven (7) months, for her to produce the stenographic notes, she has failed to produce said notes.

On 2 April 1965, stenographer Rosales sent to the clerk of this Court the transcript of stenographic notes.

This Court, on 2 February 1965, denied, for being late, the motion to present additional testimonial and documentary evidence, and, on 8 April 1965, deferred action on the objection to a portion of the transcript until after hearing.

We find no substantiation of the charge that the stipulation of facts appearing on pages 33 to 34 of the transcript of stenographic notes taken on 9 August 1963 had been intercalated; hence, the presumption that the stenographer regularly performed her duty stands. The integrity of the record being intact, the petitioner is bound by it. We can not overlook that even if his charges were true, it was plain and inexcusable negligence on his part not to discover earlier the defect he now complains of, if any, and in not taking steps to correct it before the records were elevated to this Court.

An applicant for registration is not bound by the date of first use as stated by him in his application, but is entitled to carry back said stated date of first use to a prior date by proper evidence; but in order to show an earlier date of use, he is then under a heavy burden, and his proof must be clear and convincing (*Anchor Trading Co., Inc. vs. The Director of Patents, et. al.*, L-8004, 30 May 1956; *Chung Te vs. Ng Kian Ciab, et al.*, L-23791, 23 November 1966). In the case at bar, the proof of date of first use (1953), earlier than that alleged in respondent Maliwat's application (1962), can be no less than clear and convincing because the fact was stipulated and no proof was needed.

Petitioner would confine the respondent to the use of the mark FLORMANN to tailoring and haberdashery only, but not on shoes, on the ground that petitioner had used the name FLORMEN on shoes since 1959, while the respondent used his mark on shoes only in 1962; but the Director ruled:

"... .I believe that it is now the common practice among the local tailors and habardashers to branch out into articles of manufacture which have, one way or another, some direct relationship with or appurtenance to garments or attire to complete one's wardrobe such as belts, shoes, handkerchiefs, and the like. It goes without saying that shoes on one hand and shirts, pants and jackets on the other, have the same descriptive properties for purposes of our Trademark Law."

Modern law recognizes that the protection to which the owner of a trademark is entitled is not limited to guarding his goods or business from actual market competition with identical or similar products of the parties, but extends to all cases in which the use by a junior appropriator of a trade mark or trade-name is likely to lead to a confusion of source, as where prospective purchasers would be misled into thinking that the complaining party has extended his business into the field (see 148 ALR 56 et seq; 52 Am Jur. 576) or is in any way connected with the activities

of the infringer; or when it forestalls the normal potential expansion of his business (v. 148 ALR., 77, 84; 52 Am. Jur. 576, 577). It is on this basis that the respondent Director of Patents adverted to the practice "among local tailors and haberdashers to branch out into articles of manufacture which have some direct relationship". . . "to garments or attire to complete one's wardrobe". Mere dissimilarity of goods should not preclude relief where the junior user's goods are not too different or remote from any that the owner would be likely to make or sell: and in the present case, wearing apparel is not so far removed from shoes as to preclude relief, any more than the pancake flour is from syrup or sugar cream (Aunt Jemima Mills Co. vs. Rigney & Co. LRA 1918C 1039), or baking powder from baking soda (Layton Pure Food Co. vs. Church & Co., 182 Fed. 35), or cosmetics and toilet goods from ladies' wearing apparel and costume jewelry (Lady Esther Ltd. vs. Lady Esther Corset Shoppe, 148 ALR 6). More specifically, manufacturers of men's clothing were declared entitled to protection against the use of their trademark in the sale of hats and caps [Rosenberg Bros. vs. Elliot, 7 Fed. (2d) 962] and of ladies shoes (Forsythe & Co. vs. Forsythe Shoe Corp., 254 NYS 584). In all these cases, the courts declared the owner of a trade mark from the first named goods entitled to exclude use of its trademark on the related class of goods above-referred to.

It may be that previously the respondent drew a closer distinction among kinds of goods to which the use of similar marks could be applied; but it can not be said that the present ruling under appeal is so devoid of basis in law as to amount to grave abuse of discretion warranting reversal.

Republic Act No. 166, as amended, provides:

"SEC. 4. ... The owner of a trade-mark, trade-name or service-mark used to distinguish his goods, business or services from the goods, business or services of others shall have the right to register the same on the principal register, unless it:

"(d) Consists of or comprises a mark or trade-name which resembles a mark or trade-name registered in the Philippines or a mark or trade-name previously used in the Philippines by another and not abandoned, as to be likely, when applied to or used in connection with the goods, business or services of the applicant, to cause confusion or mistake or to deceive purchasers:

Note that the provision does not require that the articles of manufacture of the previous user and the late user of the mark should possess the same descriptive properties or should fall into the same categories as to bar the latter from registering his mark in the principal register (Chua Che vs. Phil. Patent Office, et al., L-18337, 30 Jan. 1965[4], citing Application of Sylvan Sweets Co., 205 F. 2nd, 207[5]). Therefore, whether or not shirts and shoes have the same descriptive properties, or whether or not it is the prevailing practice or the tendency of tailors and haberdashers to expand their business into shoemaking, are not controlling. The meat of the matter is the likelihood of confusion, mistake or deception upon purchasers of the goods of the junior user of the mark and the goods manufactured by the previous user. Here, the resemblance or similarity of the mark FLORMANN and the name FLORMEN and the likelihood of confusion, one to the other, is admitted; therefore, the prior adopter, respondent Maliwat, has the better right to the use of the mark.

FOR THE FOREGOING REASONS, the appealed decision is hereby affirmed, with costs against the petitioner.

Concepcion, C.J., Dizon, Makalintal, Zaldivar, Sanchez, Ruiz Castro, Angeles and Fernando, JJ., concur.

Judgment affirmed.

[1] "An interference is a proceeding instituted for the purpose of determining the question of priority of adoption and use of a trade-mark, trade-name, or service-mark between two or more parties claiming ownership of the

same or substantially similar trade-mark, trade-name or service-mark." (Sec. 10-A, Republic Act No. 166, as amended)

[2] "The party whose application or registration involved in the interference has the latest filing date is the junior party . . ." (Rule 184, Rev. Rules of Practice in the Philippines Patent Office)

"Any junior party in an interference proceeding, . . ., shall be deemed to be in the position of plaintiff, and the other parties to such proceedings, to the position of defendants, with respect thereto. . . ." (Rule 167, Ibid)

[3] At any time, upon application of the registrant and payment of the required fee, the Director may permit any registration to be surrendered, cancelled, or for good cause shown to be amended, and he may permit any registered mark or tradename to be disclaimed in whole or in part: ..." (Sec. 14, Republic Act No. 166, as amended)

[4] between toiletries and laundry soap.

[5] between candies and cigarettes.

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