

PATRICIO UBEDA, PLAINTIFF AND APPELLANT, VS. AGAPITO ZIALCITA, DEFENDANT AND APPELLEE.*G.R. No. 4392. February 17, 1909*

Ponente: ARELLANO, C.J.

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Patricio Ubeda, owner of the registered trade-mark "Ginebra Tres Companas" claims and alleges loss and damages by reason of the imitation of his trademark by the defendant, who has been selling gin in bottles bearing said trade-mark, and using a label design that greatly resembles his; that the only difference between them is that of the defendant, instead of bearing the words "Ginebra Tres Campanas," reads "Ginebra de Dos Campanas," and in the center thereof, instead of "Patricio Ubeda," it reads "Gavino Barreto;" that the remainder of the trade-mark is a copy of his own; and that as the defendant, the plaintiff avers, has thus sold gin to the value of not less than P50,000, from which he has obtained a profit of P10,000, the plaintiff's sales have decreased by that amount and he has failed to receive the said profit of P10,000 which he would have obtained if he had made such sales. In conclusion he prayed that the defendant be ordered to account for all sales made by him of gin put up in bottles bearing the trade-mark, design, or any of the distinctive marks belonging to the plaintiff, and that, after the extent of such sales has been ascertained, the said defendant be ordered to pay the plaintiff double the amount thereof as indemnity for loss and damages; that the defendant be forever prohibited from using the device or trade-mark of the plaintiff, or any other trade-mark or design bearing any resemblance to those of the plaintiff, and that he be sentenced to pay the costs of the proceeding.

The defendant, Agapito Zialcita, opposed the demand for various reasons which he advanced as a special denial to the complaint, and the Court of First Instance of Manila, after hearing the evidence adduced at the trial, absolved him from the complaint filed by the plaintiff herein, Patricio Ubeda, with the costs against the latter. The plaintiff appealed from the judgment and moved for a new trial; his motion was overruled, to which motion he excepted, and submitted a bill of exceptions to this court for the purposes of his appeal and a review of the facts and evidence offered in the first instance.

On the appeal it appears:

That the plaintiff is the owner of a trade-mark described in the third clause of his complaint as:

"Two concentric circles, the larger fifty millimeters in diameter, and the smaller thirty-three, eight millimeters apart. In the upper part of the ring formed by the imposition of one circle over the other, are the words 'Ginebra de Tres Campanas' and in the lower part, the name of the plaintiff, 'Patricio Ubeda.' Inside the smaller or center ring there are three bells, tied together at the top by a ribbon, and an ear of some cereal, the ends of which fall over the two posterior and lateral bells. On the lower part of said bells the words 'Extra Superior' are written. Above the two circles and almost diametrically crossing them, the facsimile of the signature and rubric of the plaintiff, that is 'Patricio Ubeda,' is stamped in black ink; said facsimile commences on the three first letters of the word 'Ginebra,' and ends at the letter 'P' of the word 'Campanas,' crossing the three bells; the rubric terminates on the lower part of the bell at the right of the other two, viewed from the front, though skirting it a

little at the left. Outside, and above the larger ring, are the following words in small print: 'Para evitar la falsificacion, nuestras etiquetas se hallan depositadas y llevan nuestra firma.' (To prevent falsification, our labels are registered and bear our signature), and below and also outside is the word 'Manila.' "

That said mark was registered at the office of the late Direccion General de Administracion Civil of the Spanish Government on December 24, 1898; that on July 31, 1905, the plaintiff cautioned the defendant to stop using a mark similar to his own, but, notwithstanding the warning, the defendant continued to use said mark; that the defendant, in addition to a general denial in his answer, alleged as a special defense: (1) That no similarity or resemblance exists between the trade-marks used by him and those of the plaintiff; (2) that long prior to 1880, the distinctive device or trade-mark "Ginebra de la Campana" of Van Den Bergh & Co. was entered and registered in the old Direccion General de Administracion Civil, at present the division of patents, copyrights, and trade-marks of the Executive Bureau, which trade-mark is similar to or greatly resembles the one described by the plaintiff in his complaint; and (3) that the device now used by the plaintiff, which is different from that registered by him, is also another falsification of that of Van Den Bergh & Co., and which he managed to register by taking advantage of the first days of the American occupation of the city of Manila; said plaintiff has been using both marks, one after the other, for the purpose of defrauding and deceiving the public as to the nature, origin, and properties of his gin, mixing it with that of Van Den Bergh & Co., and thus selling a cheap product at the same price as the gin of Van Den Bergh & Co., which, for the reason that it is imported from Europe, costs more than his.

The imitation charged by the plaintiff to the defendant was the subject of argument and proof, in the consideration of which the judgment appealed from deals at length; but for the purposes of the law, the following conclusions contained in the said judgment suffice to determine the question :

"First. That the title of ownership of the plaintiff, Exhibit A, was issued to the plaintiff on December 16, 1898, for a trade-mark which is not exactly the same as the one described in the complaint, because, although the said titles or trade-marks bear the same circular form, and around the two concentric circles the words 'Patricio Ubeda,' 'Ginebra de Tres Campanas' and 'Extra Superior' appear, and on the outside are the words 'para evitar la falsificacion nuestras etiquetas se hallan depositadas y llevan nuestra firma,' and the center is of a gold color, which is the color of the entire label 'Tres Campanas,' and the signature 'Patricio Ubeda' in black, yet on the lower part of said label, outside of the larger circle of the trade-mark is seen the word 'Amberes,' (Antwerp), whereas on the other, in lieu thereof is printed the word 'Manila;' this difference was explained at the trial as follows: That the said title was issued to the plaintiff to sell gin in these Islands imported from Antwerp, with the said label, but not manufactured by the plaintiff as stated in his complaint; the difference between the registered trade-mark and the other is also noticeable because on the latter the words or legends previously described are not embossed, nor is the gold coloring in the one of the same shade as in the other.

"Second. That on the other hand there appears from the certified copy, Exhibit 8, that a certificate was issued on the 11th of December, 1873, by the Ministerio de Fomento in Spain to Van Den Bergh & Co., manufacturers of wines at Antwerp, according them the use of the mark 'Ginebra de la Campana, Van Den Bergh & Co.' with the right to use said trade-mark in Spanish territory and foreign possessions; said mark appears as Exhibit 3, and bears a great resemblance to Exhibit A, the title of ownership of which, according to said exhibit, was issued to said plaintiff by the aforesaid Direccion General de Administracion Civil; the only difference between the two trade-marks being that three bells are printed on that of the plaintiff, in the center of the two circles, with the signature of Patricio Ubeda in black ink crossing the two circles, while that of Exhibit 3 has only one bell inside the circles, with the signature of Van Den Bergh & Co. crossing the said circles; there has been and there still is on sale in this market bottled gin bearing the said trade-mark, as was also proven at the trial; said trade-mark was registered in the Bureau of Archives in November, 1903, in view of the fact that no record could be found of the registration of the trade-mark 'Tres Campanas,' and for the reason that said trade-mark of Van Den Bergh & Co. had already been registered in the United States.

"Third. That the similarity existing between the trade-mark 'Ginebra dela Campana, Van Den Bergh & Co.,' and the trade-mark 'Ginebra de tres Campanas Patricio Ubeda' under the circumstances mentioned with respect to the registration or issuance of the title of ownership of the second of the said trade-marks in favor of the plaintiff, should be taken into account for the due appreciation of the acts of the parties herein, and their respective rights in this litigation, because it all tends to explain in some way the conduct of the defendant * * * and at the same time shows that all the trade-marks bearing more or less bells, familiar to the trade here on gin bottles, are nothing more than a variation of the mark 'Ginebra de la Campana, Van Den Bergh & Co.,' or bear some resemblance thereto, and shows that if it was a matter of judging simply from the similarity or resemblance between two trade-marks, the plaintiff has no right to charge the defendant with being a competitor in bad faith for having used the trade-mark 'Dos Campanas.'"

In effect, the following communication received by the plaintiff on the 12th of December, 1898, from the Direccion General de Administracion Civil, is one of the documents offered by him as a preliminary title:

"By a resolution of the 5th inst. * * * this Direccion General has been pleased to grant you the ownership of the inclosed trade-mark for wines denominated Tres Campanas,' of which you are the importer in this market, upon payment of the corresponding fees."

But the said trade-mark reads on the outside lower part, "Amberes" and in diminutive characters toward the right hand bears the lithographer's name, "Litografia Ramirez y Ca., Madrid." So that the license granted him was for the use of an Antwerp trade-mark, for gin imported into these Islands, while the trade-mark described in the complaint as being imitated, is one for gin manufactured in these Islands, for which the license granted was not obtained; and according to a certificate of the Bureau of Archives of this Government, there is only one entry on file, as follows:

"Registro Publico y General de Comercio.-Section 2, folio 3, 8.-Under date of December 16, 1898, His Excellency, the Governor-General, issued a title of ownership of a trade-mark in favor of Don Patricio Ubeda Gallego, as importer in this market of the wine denominated 'Tres Campanas.' "

This entry is not exactly that of the title, Exhibit A, issued on the 16th of December, 1898, but of its recording in the division of agriculture, industry, and commerce of the said Direccion which actually appears under entry No. 8 on folio 3 of the second register of industrial and commercial trade-marks, dated December 24, 1898.

On December 2, 1904, in reply to a communication from Van Den Bergh & Co. of Antwerp, Patricio Ubeda told the said gentlemen that he was the proprietor of the trade-mark "Ginebra Tres Campanas" for the Philippine Islands under entry No. 8, folio 3, of the second register of industrial and commercial trade-marks.

Upon comparing the trade-mark that appears at the foot of the title of ownership presented by the plaintiff, and which bears the word "Amberes" on the lower outer part thereof with the real and undisputed mark of Van Den Bergh & Co., of Antwerp, also bearing the said word upon the lower outer part, it is found that the description given in clause 3 of the complaint applies to the salient features of both, and that when viewed from a distance they appear alike; even to the characters used in the respective autographs stamped across both marks, the resemblance is perfect, and the type employed in the legend, the caution, class, and place of origin is the same in both. So that it may be said of Van Den Bergh & Co's trade-mark (Exhibit 3), as of that of Patricio Ubeda's (Exhibit A): Two concentric circles, the larger of 50 millimeters in diameter and the smaller 33, 8 millimeters apart. On the lower part of the bell the words "Extra Superior" are written. Above the two circles and almost diametrically crossing them, the facsimile of the signature and rubric of Van Den Bergh & Co. is stamped in black ink; said facsimile commences on the first letter of the word "Ginebra" and ends at the letter "P" of the word "Campana." Outside and above the larger ring and in small letters (identical in both) are the following words; "Para evitar la falsificacion nuestras etiquetas se hallan depositadas y llevan nuestra firma." Below, and also

outside, is the word "Amberes," of the same type and size (in both trade-marks), not "Manila" as described in clause 3 of the complaint. The whole of the substitution consists of "Tres Campanas" for "La Campana" and "Patricio Ubeda" in lieu of "Van Den Bergh & Co.," both in the text and the signature; all are of the same color, and, viewed from a certain distance as a whole, of exactly the same appearance; in other words such a mark as is applied to a bottle of characteristic design as that used for putting up gin.

The conclusion contained in the judgment appealed from, "that all the labels with more or less companas (bells) used in this market on gin bottles are nothing more than a variation of the trade-mark 'Ginebra de la Camptana, Van Den Bergh & Co.,' or bear a great resemblance thereto," is Correct.

The plaintiff presents a registered trade-mark which can be seen at the foot of the title of ownership obtained for imported gin. According to the registered mark it would be gin imported from Antwerp. As the plaintiff was well aware, this mark existed here, although he says he was given to understand that the copyright had expired. Ernest Appel, of the firm of C. Heinszen & Co. of this city, testified that he did not know when the "Ginebra de Una Campana" was first imported in these Islands, but, according to the books of said firm, which is the importer of it, the latter received a shipment of 500 cases on the 15th of January, 1892.

The trade-mark of this gin was produced in evidence (Exhibit No. 3) prior to that of the plaintiff which, as stated by the latter "was registered in Spain," and he believed that it existed in the Islands, according to his declaration at folio 19 of the record all the objection raised against its admission was based, first, in that the plaintiff did not derive any right from the mark of Van Den Bergh & Co.; second, in that said mark was not valid in the Philippines, because at the time when that of the plaintiff was registered the defendant had no right therein for the reason that any right which he might have possessed had expired; and third, in that this matter was foreign to the suit between the plaintiff and the defendant as *res inter olios acta*. Thus he assigns as error in the judgment "in admitting as proof the certificate issued in 1873 by the Ministerio de Fomento of Spain to Van Den Bergh & Co. for the use of the mark 'Ginebra de la Campana.'" (Brief, 2.) He added:

"So that although it be considered that the plaintiff's mark is an imitation of that of Van Den Bergh & Co., yet from the fact that the mark of the latter had lapsed, it is evident that since 1898 the plaintiff was the only one who could lawfully use the mark 'Ginebra Tres Campanas,' and all other variations of the same were illegal * * *

* In the said year 1898, apart from the said double expiration (through prescription of ownership and use) of the trade-mark 'Ginebra de la Campana' no one claimed to have any right thereto, and consequently the plaintiff, like any other person, could ask for, and the ownership could be granted him, not of a mark similar to that of Van Den Bergh & Co., but one exactly the same as the mark 'Ginebra de la Campana,' and the grantee could not be charged with bad faith." (Brief, 7 and 8.)

But by sections of Act No, 666:

"No action, or suit, or criminal prosecution shall be maintained under the provisions of this Act * * * in any case where the trade-mark, trade-name, or the indicia of origin, ownership, or manufacture have been used by the complaining and injured party for the purpose of himself deceiving the public with respect to the character of the merchandise sold by him or of the business or profession or occupation carried on by him."

This is one of the defenses utilized by the defendant so far as he alleged that a party who had imitated the trade-mark of another could hardly be entitled to bring an action for an imitation of his own. If, as claimed by the plaintiff, the mark "Dos Campanas" used by the defendant, is an imitation and a variation of his own trade-mark "Tres Campanas," it is illegitimate and illegal, and the conduct of the person using the said imitation is deceitful and fraudulent and subject to an action for unlawful competition; it follows that the mark "Tres Campanas," of the plaintiff, being an imitation and a variation of the mark "La Campana" of Van Den Bergh & Co., is also illegitimate and illegal, and the conduct of the plaintiff is in turn deceitful and fraudulent and gives rise to an

action for unlawful competition. And being deceitful and fraudulent, that is to say, inasmuch as the petitioner, who claims to be the injured party, made use of the mark "Tres Campanas" for the purpose of deceiving the public with respect to the character of the merchandise sold by him, pretending, under the title of ownership produced in evidence, to cause it to pass as imported from Antwerp when it was manufactured in Manila, as he has testified in this case, he can not, under the provisions of said section 9, exercise any right of action or sue for what he claims in his complaint.

Neither through the lack of registration of the trade-mark of Van Den Bergh & Co. nor by reason of the expiration of the copyright for its use, could the plaintiff consider himself at liberty to freely and with impunity use the same. Section 4 of the said Act reads as follows:

"In order to justify recovery for violation of trade-mark rights in the preceding sections defined, it shall not be necessary to show that the trade-marks have been registered under the royal decree of 1888, providing for registration of trade-marks in the Philippine Islands, in force during the Spanish sovereignty in these Islands, nor shall it be necessary to show that the trade-mark has been registered under this Act. It shall be sufficient to invoke protection of his property in a trade-mark if the party complaining shall prove that he had used the trade-mark claimed by him upon his goods a sufficient length of time so that the use of the trade-mark by another would be an injury to him and calculated to deceive the public into the belief that the goods of that other were the goods manufactured or dealt in by the complaining party."

The fact that both have fraudulently imitated the trade-mark of a third person, one which antedated both of theirs, and which with variations was copied in order to sell as "La Campana" gin from Antwerp, those gins which the one and the other have offered the public under the trade-marks of "Dos Campanas" and "Tres Companas," can not be considered *res inter alios acta* for the foundation of an action between the plaintiff and the defendant. The usurpation of a trade-mark by means of an imitation is punished by law; and this is what the plaintiff puts forward as his right of action against the defendant. The latter in turn, in answer to the plaintiff and for the purpose of denying his right of action, sets up the same charge of imitation, and supports his exception by offering in evidence the trade-mark that was imitated, substituted, and originally usurped; the right of a third person is not contested except as a defense against the plaintiff, and whatever is legitimate as a cause of action is equally legitimate as a defense. If the action is a legitimate one, although the usurped trade-mark was not entered or registered, legitimate must also be the defense, although the mark, usurped in turn by the complaining and injured party, may not have been recorded or registered. Therefore, there is no injury to him who in turn damages another by the same kind of injury, or no action for usurpation can be maintained by one who in turn appears as guilty of identical usurpation; evidence to this effect with respect to an act relating to a third person is not *res inter alios acta*, but a necessary proof of the defense of the defendant. And, inasmuch as the provision of the law must be complied with, it is needless in order to decide this case to consider the other exceptions or defenses of the defendant; the lack of right of action stands foremost owing to its conclusive effect.

By virtue of the foregoing and on account of the circumstances as set forth, the judgment appealed from is hereby affirmed with the costs of this instance against the appellant.

Torres, Mapa, Carson, and Willard, JJ., concur.

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