

PARFUMS NINA RICCI,)	INTER PARTES CASE NO. 3105
Opposer,)	
)	OPPOSITION TO:
)	
)	Application Serial No. 43101
)	Filed : November 7, 1980
)	Applicant : Vashi K. Sabnani
- versus -)	Trademark : NARUCCI
)	Used on : Perfumes
)	
)	<u>DECISION NO. 92-5 (TM)</u>
VASHI K. SABNANI,)	
Respondent-Applicant.)	April 6, 1992
x-----x)	

DECISION

On 22 June 1988, Parfums Nina Ricci filed an Unverified Notice of Opposition to Application Serial No. 43101 for registration of the trademark NARUCCI in the name of Vashi K. Sabnani and allegedly used on perfumes. The Verified Notice of Opposition was filed on 19 August 1988.

Opposer, Parfums Nina Ricci is a company duly organized and existing under the laws of France and doing business at 17, rue Francois 1er Paris, France. Respondents, Vashi K. Sabnani, on the other hand is a citizen of India, with business address at Wheatly Heights, New York 11798, U.S.A.

On 2 December 1988, Opposer moved for the declaration of Respondent in default for failure to file an Answer notwithstanding the lapse of more than ninety days since the notice to Answer was served to the Respondent. On 3 January 1989, Order No. 89-012 was issued declaring Respondent in default and Supplemental Motion to Admit Answer on the ground that the case-folder of counsel was misplaced. In Order No. 89-462, Respondent's Motion to Lift Order of Default was denied for lack of merit, stating that "the length of period (177 days) that transpired before it filed its Answer is too long for Respondent's counsel to discover the alleged loss of its case-folder on the case." Thus, Opposer was allowed to present its evidence ex-parte.

Opposer believes that it would be damaged by the registration of the trademark NARUCCI, on the following grounds:

"1. Opposer is the owner of the trademark "CAPRICCI", Class 8 and is registered in the Philippines under Certificate of Registration No. 19693 dated 31 July 1973.

"2. Opposer is likewise the owner of the trademark "NINA RICCI" (words) and is registered in the Philippines under Certificate of Registration No. 29049 dated 13th April 1981.

"3. Opposer has used the trademark "CAPRICCI" and "NINA RICCI" in trade and commerce long prior to Respondent-Applicant's application of November 7, 1980.

"4. Opposer's trademark "CAPRICCI" and "NINA RICCI" are well known throughout the world because of the high and superior quality of its products and because of massive worldwide advertisements. Consequently, the registration of applicant's alleged mark would violate Opposer's rights and interests in its trademark "CAPRICCI" and "NINA RICCI" because the mark objected to is identical, so that confusion between Opposer's and Respondent-

Applicant's respective businesses and products would result to confusion since both trademarks are confusingly similar.

"5. That because both trademarks are confusingly similar and covers the same classes of goods, i.e. perfumes, confusion between the Opposer's and Respondent-Applicant's respective businesses and products as well as the dilution and loss of distinctiveness of Opposer's trademark is inevitable."

To support the grounds relied upon by the Opposer, it offered in evidence the following:

"1. Exhibit "A" – Certificate of Registration No. 29049 for the trademark Nina Ricci issued by the Philippine Patent Office on April 13/81 based on French Registration No. 947,282 TM Nina Ricci issued May 11, 1976.

"2. Exhibit "B" – Certificate of Registration No. 19693 issued on July 31, 1973 for the trademark Capricci by the Philippine Patent Office based on the French Certificate of Registration No. 489,000 for TM Capricci issued on June 24, 1960.

"3. Exhibit "C" – Cert. of Reg. No. 947,699 of Opposer issued on Nov. 21, 1972 for trademark Nina Ricci by the United States Patent Office.

"4. Exhibit "D" – Cert. of Reg. No. 793,771 of Opposer registered August 3, 1965 for trademark Capricci by the United States Patent Office.

"5. Exhibit "E" – Cert. of Reg. No. 0661423 with English translation for tm Capricci issued in Japan on Dec. 12, 1964.

"6. Exhibit "F" – Cert. of Reg. No. 34656 of opposer for TM Nina Ricci issued on March 7, 1984 by Seoul, Korea.

"7. Exhibit "G" – Cert. of Reg. No. 74526 of opposer issued March 1, 1985 for TM Capricci.

"8. Exhibit "H" – List of registrations of the trademark Capricci which list contains the names of the countries and registration numbers consisting of four (4) pages.

"9. Exhibit "I" – A list also of Certificate of registrations in different countries for the trademark Nina Ricci consisting of thirty-eight (38) pages."

There is no doubt that Opposer is the owner of the mark NINA RICCI and CAPRICCI. The pivotal issue thus left in this case is whether the Opposer's trademarks NINA RICCI and CAPRICCI are confusingly similar to Respondent's trademark NARUCCI, all being used on the same goods, i.e. perfumes.

Opposer claims that Respondent's trademark 'NARUCCI' intimately resembles Opposer's trademark thereby resulting to confusing similarity between them. (p.5, Memorandum for the Opposer) Nothing more, how the resemblance exists or how intimate the resemblance is as to mislead purchaser, it did not state. The eleven-page memorandum merely made a recital of jurisprudence on confusing similarity and its effects.

The registrability of the subject mark, and necessarily the non-existence of confusing similarity of these marks, had already been passed upon by the Trademark Examining Division and allowed by the Director (see papers no.3 and 4 of the application). In particular, we take note of the Respondent's letter dated 14 July 1983, stating that "the trademark NARUCCI is not similar to the trademark NINA RICCI in terms of sound, spelling and presentation. Likewise, the

goods represented by the mark are not ordinary, over-the-counter goods but expensive goods sold through exclusive boutiques to exclusive but discriminating clientele.” We agree. In terms of sound, Opposer’s trademark NINA RICCI consists of four syllables and starts with “NI” while Respondent’s trademark consists only of three syllables which starts with “NA”. In Trademark Law, the part that comes first is the most pronounced (Etepha vs. Director of Patents, 16 SCRA 495). In terms of appearance, Opposer’s trademark NINA RICCI is a two-word and the designs in the labels of each mark are very much different. More importantly, it is of public knowledge that perfumes of this kind are not ordinary, over-the-counter goods but expensive goods sold through exclusive boutiques to exclusive but discriminating clientele. Thus, even with the assumption that the opposing marks are similar, confusion on the part of the buying public is remote. Considering all of the foregoing, we are not ready, and with more reasons, to pronounce that Opposer’s other mark CAPRICCI is confusingly similar to Respondent’s mark NARUCCI.

We likewise take note of the fact that Opposer’s mark NINA RICCI is used on jewelry, precious stones, time pieces and leathers goods simultaneously with the equally famous mark GUCCI of GUCCIO GUCCI S.r.l. on exactly the same goods (Regn. No. 30750), if only to dispel the similarity of these marks, including the subject mark, on the part that comes last i.e. “cci”.

Lastly, it is worth mentioning that Opposer’s marks NINA RICCI and CAPRICCI coexist with Respondent’s mark NARUCCI in the United States Patent Office in the Principal Registration under Certificate No. 947,699 (Exhibit “C”) No. 793, 771 (Exhibit “D”) and No. 1,252,625 respectively.

WHEREFORE, the Notice of Opposition to Application Serial No. 43101 for the trademark NARUCCI is hereby DISMISSED for lack of merit.

Application Serial no. 43101 is hereby given due course.

Upon finality of this decision, let a copy be furnished to the Trademark Examining Division and the filewrapper of this case be forwarded to the Application, Issuance and Publication Division for appropriate action with this Decision.

SO ORDERED.

IGNACIO S. SAPALO
Director