

CARLA BEROTTI COMPANY LIMITED,	}	IPC No. 14-2005-00120
Assignee of WEENA KOOMVONG,	}	Opposition to:
Opposer,	}	Appln. Serial No. 4-2002-002238
	}	Date Filed: March 14, 2002
-versus-	}	TM: "SCRIPTED CARLA BEROTTI"
	}	
	}	
CYNTHIA C. DINO,	}	
Respondent-Applicant,	}	Decision No. 2006 – 66
x-----x		

DECISION

This pertains to the Verified Notice of Opposition to the application for registration of the mark "SCRIPTED CARLA BEROTTI" for shoes under Application Serial No. 4-2002-002238 lodged by Cynthia C. Dino and published for opposition in the Trademark Electronic Gazette of the IP Philippines which was released for circulation on July 28, 2005.

Opposer Carla Berotti Company Limited, assignee of Weena Koomvong, is a foreign corporation organized and existing under the laws of Thailand with office address at 37 / 2 Somprasong 4 Petburi Tanong, Payatai Subdistrict, Rajatevi District, Bangkok, Thailand.

On October 25, 2005, opposer filed a Verified Notice of Opposition. The grounds for opposition are as follows:

1. Respondent-applicant's mark "SCRIPTED CARLA BEROTTI" is identical to opposer's registered mark "CARLA BEROTTI (Scripted)" for use on shoes;
2. The approval of the application is contrary to Sections 123.1 and 155.1 of Republic Act No. 8293;
3. The approval of the application will violate opposer's right to the exclusive use of its mark "CARLA BEROTTI (Scripted)" on shoes;
4. The approval of the application has caused and will continue to cause great and irreparable damage and injury to opposer; and
5. Respondent-applicant filed the application in bad faith and is not entitled to register the mark "SCRIPTED CARLA BEROTTI" in her favor.

Opposer relied on the following facts to support its opposition:

1. Opposer, through its predecessor-in-interest, Weena Koomvong, adopted and started using the mark "CARLA BEROTTI (Scripted)" on shoes as early as 1995;
2. On January 24, 1995, the mark "CARLA BEROTTI (Scripted)" for use on shoes was registered with the Trademark Office of the Intellectual Property Department of Thailand in favor of Weena Koomvong under Registration No. Kor 34969;
3. On December 2004, Weena Koomvong transferred the mark "CARLA BEROTTI (Scripted)" and its registration in favor of opposer Carla Berotti Company Limited;
4. Shoes bearing the mark "CARLA BEROTTI (Scripted)" have been exported to the Philippines, particularly to respondent-applicant;

5. Respondent-applicant had been selling in the Philippines “CARLA BEROTTI (Scripted)” shoes that came from opposer up to April 2005;
6. The mark “SCRIPTEDCARLA BEROTTI” being applied for registration by respondent-applicant is identical to opposer’s registered mark “CARLA BEROTTI (Scripted)” and used on the same goods, namely, shoes;
7. The approval of the application for registration is contrary to Section 123.1 of Republic Act No. 8293;
8. Respondent-applicant knew that the mark “CARLA BEROTTI (Scripted)” belongs to opposer as respondent-applicant has been importing from opposer shoes bearing said mark;
9. Respondent-applicant has before her a boundless choice of words and phrases sufficient to distinguish her products from those of opposer; and
10. Respondent-applicant is not entitled to register in her favor the mark “SCRIPTED CARLA BEROTTI”

A Notice to Answer dated November 7, 2005 was sent to respondent-applicant through registered mail on November 14, 2005. No Answer was filed within the reglementary period for which reason respondent-applicant was declared to have waived her right to file the Answer and the supporting documents thereof per Order No. 2006-375. Respondent-applicant is, thus, in default. Per Order No. 2006-375, the case was submitted for decision based on the Verified Notice of Opposition and the supporting documents thereof.

The issues to be resolved herein are as follows:

1. Whether the mark “SCRIPTED CARLA BEROTTI” applied for registration by respondent-applicant is identical with or confusingly similar to opposer’s mark “CARLA BEROTTI (Scripted)”;
2. Whether opposer has acquired a goodwill to the mark “CARLA BEROTTI (Scripted)” on which respondent-applicant hinges her application for registration; and
3. Whether respondent-applicant is entitled to register the mark “SCRIPTED CARLA BEROTTI” for shoes under Class 25.

As to the first issue, this Office rules in the positive.

A close perusal of opposer’s “CARLA BEROTTI (Scripted)” and respondent-applicant’s “SCRIPTED CARLA BEROTTI” show that they are identical to each other: Notwithstanding the letter C-like figure that arcs under or underscores the words “CARLA BEROTTI” in one of opposer’s sample packaging box (Exhibit ‘H’), the font and scripted style of the words “CARLA BEROTTI” of both opposer’s and respondent-applicant’s respective marks are the same. For comparison below are the graphic representations of both marks, showing that they are identical to each other:

Exhibit “H”  
(Sample packaging box of Opposer)

(Opposer’s mark)



(Respondent-Applicant's mark)

There is, thus, a likelihood of confusion between the two marks such that the purchasing would be led to believe that shoes sold by respondent-applicant bearing the mark applied for are the products of opposer.

As to the second and third issues, this office likewise rules in the positive.

The evidence on record shows the following:

The mark "CARLA BEROTTI (Scripted)" was registered with the Trademark Office of the Intellectual Property Department of Thailand on January 24, 1995 under Registration No. Kor 34969 for use on shoes in favor of Weena Koomvong who assigned it to opposer on December 20, 2004 (Exhibits "A", "B" and submarkings). Respondent-applicant on her own had been importing, and selling shoes from opposer bearing said mark at least from 2000, specifically in Tutuban, until April 2005 (exhibits "C" and "D" and submarkings thereof; "E" and "G"). The evidence on record shows, too, that to date, opposer continues to import and sell in the Philippines shoes under the mark "CARLA BEROTTI (Scripted)" through its authorized representative and distributor Cecilia Valdez-Saculo (Exhibit "G").

As opposer has first adopted and used in commerce in the Philippines the mark "CARLA BEROTTI (Scripted)" initially through respondent-applicant and eventually through Cecilia Valdez-Saculo up to the present, opposer acquired ownership of said mark on the shoes on which it is affixed or used, and even on articles related thereto. Opposer is entitled to use its mark to the exclusion of others, to register, and to perpetually enjoin others from using it (*Chung Te v. Ng Kian Giab*, 18 SCRA 747 [1966]; *Ed A. Keller & Co. Ltd. v. Kinkwa Meriyasu Co. (P. I.)*, Inc. 57 Phil. 262 [1932]). The right to register trademark is based on ownership (*Marvex Commercial Co., Inc. vs. Petra Hawpia & Company*, 18 SCRA 1178 (1966); *Unno Commercial Enterprises, Inc. v. General Milling Corp. et al.*, 205 Phil 707 [1983] and *Gabriel v. Perez et al.*, 55 SCRA 406 [1974], citing *Operators, Inc. vs. Director of Patents*, 15 SCRA 147 [19]). When the applicant is not the owner of the trademark being applied for, he has no right to apply for the registration of the same (*Operators, Inc. vs. Director of Patents*, supra).

An importer or distributor of goods on which a mark or trade name owned by another is used does not acquire ownership over said mark unless the owner has ceded or transferred it to him: Use by the importer or distributor of the mark is deemed use by the owner of the mark. The importer or distributor is an agent of the trademark owner. As such, the agent is estopped from acquiring or asserting a title adverse to that of the principal (*Marvex Commercial Co., Inc. vs. Petra Hawpia & Company*, supra; *Unno Commercial Enterprise, Inc. v. General Milling Corp. et al.*, supra; *Gabriel v. Perez et al.*, supra; *Thomas v. Pineda*, 89 Phil. 312 [1951]).

In importing and distributing opposer's shoes with the mark "CARLA BEROTTI (Scripted)", respondent-applicant was actually opposer's agent. Respondent-applicant cannot, thus, assert ownership over the mark "SCRIPTED CARLA BEROTTI" by registration without impairing opposer's ownership over its mark "CARLA BEROTTI (Scripted)".

Moreover, Respondent-applicant has a boundless choice of words, phrases and symbols to adopt as a mark sufficient unto itself to distinguish her products from those of opposer's and other's marks. Respondent-applicant, though, chose one identical to opposer's mark. There is no reasonable explanation for respondent-applicant's choice of the mark "SCRIPTED CARLA BEROTTI" for use on shoes from a field so broad except that she intends to cash in on the

goodwill of opposer's mark already acquired through opposer's distribution and sale in the Philippines of shoes bearing the mark "CARLA BEROTTI (Scripted)" initially through respondent-applicant herself and eventually through Cecilia Valdez-Saculo up to the present.

WHEREFORE, the Opposition is hereby SUSTAINED. Consequently, Application Serial No. 4-2002-002238 for the registration of the trademark "SCRIPTED CARLA BEROTTI" for shoes filed on March 14, 2002 is hereby REJECTED.

Let the filewrapper of SCRIPTED CARLA BEROTTI subject matter of this case be forwarded to the Bureau of Trademarks for appropriate action in accordance with this Decision.

SO ORDERED.

Makati City, July 17, 2006.

ESTRELLITA BELTRAN-ABELARDO  
Director, Bureau of Legal Affairs  
Intellectual Property Office