

GUESS, INC.,  
Opposer,

INTER PARTES CASE NO. 3899  
Opposition to:

- versus-

Appln: Serial No. 77032  
Filed: July 26, 1991  
Trademark: "GEORGE MACHADO"

THE CLOTHES SHOP, INC.  
Respondent-Applicant.  
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DECISION NO. 97-19

### DECISION

This is an opposition to the trademark "GEORGE MACHADO" bearing application Serial No. 77032 filed by herein Respondent-Applicant the Clothes Shop, Inc., on July 6, 1991 for polo shirts and trousers, under class 25 and published in Volume VI, No. 2 of the Official Gazette dated March-April 1993, and which was officially circulated on May 31, 1993.

Opposer, Guess, Inc., is a corporation duly organized and existing under the laws of California, U.S.A., with business address at 1444 South Alameda Street, Los Angeles, California 90021, while Respondent-Applicant, The Clothes Shop Inc., is a domestic corporation with address at Gentex Compound, E. Rodriguez Avenue Ext., Libis, Murphy, Quezon City, Philippines.

Opposer relied on the following grounds:

"1. The Opposer is the registrant of the trademark "GEORGES MARCIANO" covered by Certificate of Registration No. 54394 issued on February 9, 1993 for the goods men's, women's and children's apparel, namely jeans, suits, coats, jackets, shirts, blouses, vests, dresses, skirts, shorts, jumpsuits, overalls, sweaters, trousers, stockings socks and tights, under class 25, and Certificate of Registration No. 45220 issued on June 16, 1989 for goods covering Classes 9, 14, 16, 18, 20, 21, 24, 26 and 28.

"2. The trademark "GEORGE MARCIANO" which Opposer owns have been used in the Philippines by it on the above enumerated goods which covers also the goods shirts and trousers of Respondent-Applicant, long prior to the alleged date of first use by Respondent-Applicant of its mark GEORGE MACHADO on January 1, 1987.

"3. The name "GEORGES MARCIANO" consist of or comprises a name identifying a particular living individual who is the present President of Opposer, and the name "GEORGE MACHADO" is by sound, appearance and print almost appears like and confusingly similar to said famous name "GEORGES MARCIANO" and which likewise was designed to ridicule and make profit from the said registered name of a living individual who did not give his consent thereto.

"4. The mark "GEORGE MACHADO" is confusingly similar to opposer's registered trademark "GEORGES MARCIANO", the first word "GEORGE" is exactly similar and identical to the first word of the above registered trademark and the last name "MACHADO" is with similar sound And appearance with intent to ridicule, as it means when translated in English as "too much" but is definitely confusing to the last word of the registered mark"

Opposer further relied on the following facts to support its opposition:

"1. The Opposer is the registered owner of the trademark GEORGES MARCIANO, covered by Certificate of Registration No. 54394 issued on February 19, 1993 for goods men's, women's and children's apparel etc. under class 25, and Certificate of Registration No. 45220 issued on June 16, 1989 for goods under class 9, 14, 16, 18, 20, 21, 24, 26 and 28.

"2. Because of the high quality of the products and the worldwide advertisements made on Opposer's trademark, it has become very popular and well known not only locally but internationally as well, and in a Memorandum dated November 20, 1980 of the then Minister of Trade which was upheld in the case of La Chemise Lacoste S.A. vs. Ram Sadwani, G.R. SP No. 13359 dated June 17, 1983, affirming the validity of the said Memorandum, the said Minister of Trade in implementing the Treaty of Paris for the Protection of Industrial Property has directed the Director of Patents to reject all pending applications for Philippine registration of signature and other world famous trademarks by applicant other than the original owners or users. The trademark "GEORGES MARCIANO" is used in commerce internationally, supported by proof that goods bearing said trademark is sold on an international scale advertisement, the establishment of factories, sales offices, licensing agreements and distributorship in different countries including volume or other measure of international trade and commerce all over the world.

"3. The application of subject trademark was filed only on July 26, 1991, and Respondent-Applicant claims first use of the same in trade and in commerce only on January 1, 1987.

"4. That Respondent-Applicant's trademark "GEORGE MACHADO" is confusingly similar to the trademark "GEORGES MARCIANO", as both have the same sound and appearance. Moreover, the goods covered by both trademarks are not only related but similar or identical with respect to shirts and trousers.

"5. The registration of Respondent- Applicant's alleged trademark "GEORGE MACHADO" would violate Opposer's right and interest of its trademark "GEORGES MARCIANO" because said trademarks are confusingly similar. Moreover, it is almost similar to the name of a living individual who is actually the President of Opposer, who did not give his consent thereto as required under Sec. 4(c) of the trademark law, and thus, if Respondent-Applicant is allowed to continue using such name, it will ride freely on the popularity, of his name to his prejudice and detriment."

For failure to file Answer within the time prescribed by the Rules, the herein Respondent-Applicant was declared in Default (Order No. 93-797, dated November 12,1993).

The issues raised were as follows:

1. Whether or not the trademark "GEORGE MACHADO" of Respondent-Applicant is confusingly Opposer's trademark "GEORGES MARCIANO".
2. Whether or not Opposer would likely be damaged by the registration of the mark "GEORGE MACHADO"
3. Whether or not the registration of the mark "GEORGE MACHADO" would dilute and/or damage the internationally famous name GEORGES MARCIANO used on the same class of goods as Opposer's.

The trademark "GEORGES MARCIANO" of Opposer was registered in the United States Patent and Trademark Office under Registration No. 1,454,366 registered August 25, 1987 and the goods covered are for men's, women's and children's apparel namely jeans, suits, coats,

jackets, shirts, blouses, vests, dresses, shirts, shorts, jumpsuits, overalls, sweatshirts, t-shirts, sweaters, trousers, stocking, socks and tights in class 25.

In the instant case, a comparison of the two trademarks (Exhs. "A", "B", "C", "D" for Opposer) would clearly indicate that the dominant feature of the subject marks is the word "GEORGE". The appearance of the word "GEORGE" would likely cause confusion or deception among purchasers as the variation in the second word "MACHADO" of Respondent and "MARCIANO" of Opposer may be ignored believing that they are variations of the same trademark to distinguish one kind or quality from another.

Section 4 of Republic Act No. 166, as amended, provides as follows:

"SEC. 4. Registration of trademark, tradenames and service marks on the principal register. There is hereby established register of trademarks, tradenames and service marks which shall be known as the Principal Register. The owner of a trademark, tradename 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 unless it:

xxx

(d) Consists of or comprises a mark or tradename which so resembles a mark or tradename registered in the Philippines by another and not abandoned, as to be likely, when applied to or used in connection with the goods, business or service of the applicant, to cause confusion or mistake or to deceive purchasers."

Respondent's trademark needs no further scrutiny. It is clearly similar in spelling, sound and appearance with petitioner's trademark. Both trademarks contain the name "GEORGE". The only distinction is the presence of the word "MACHADO" in Respondent's trademark the pronunciation of which also sound similar to MARCIANO of herein Opposer. Since Opposer has the exclusive right to use the trademark "GEORGES" by virtue of its registrations with this Office, Respondent has absolutely no right to register the same as part of its mark GEORGE MACHADO."

Also, under Philippine jurisprudence, colorable imitation implies similarity. However, this does not mean such a similitude as amounts to identity. One test given is that if the form of the marks, contents, words or other special arrangement or general appearance of the words of the alleged infringer's mark is such as would likely to mislead persons in the ordinary course of purchasing the genuine articles, then the similarity is such as entitles the injured party to equitable protection.

It is, therefore not necessary that the matter sought to be protected be literally copied. Difference or variations or similarity in the details of one or article of those of another are not legally accepted tests, whether an action based on confusing similarity exists. It is sufficient that the substantial and distinctive part of the main or essential or dominant features for one mark is copied or imitated in another (Co Tiong Sa vs. Director of Patents, 95 Phil. 1).

Adding to Respondent-Applicant's woes is that its goods closely related to the goods of Opposer, both belong to class 25. Undoubtedly, unwary purchasers may tend to overlook the two trademarks as originating from the same source of origin. Consequently, damages to the reputation and goodwill of the herein Opposer are likely to result if we are to allow Respondent's trademark to surface in the local market.

Moreover, as shown by evidence, the Opposer was able to prove that it is not only registered in the Philippines. (Exhs. "A", "B", and "C") but also in the United States as well, (Exhibit "D"). This brings us to the general impression that Respondent-Applicant would like to ride on the popularity and goodwill established by the marks "GEORGES MARCIANO", a scheme which cannot be tolerated by the Bureau.

Finally, as revealed by records of this case, the non-filing by the Respondent-Applicant of any responsive pleading to the verified opposition is indicative of its lack of interest in contesting the allegations of the herein Opposer, and implies a virtual abandonment of its application for the registration of the mark "GEORGE MACHADO".

WHEREFORE, the Opposition is hereby SUSTAINED. Consequently, Application for Serial No. 77032 for the trademark GEORGE MACHADO filed by The Clothes Shop, Inc. is hereby, REJECTED for being contrary to the provisions of Sec. 4 of the Trademark Law.

Let the filewrapper of this case be forwarded to the Application, Issuance and Publication Division in accordance with this Decision with a copy thereof to be furnished the Trademark Examining Division for information and to update its record.

SO ORDERED.

Makati City, November 13, 1997.

EMMA C. FRANCISCO  
Director