

KEY MULTI-INDUSTRIES, INC.,
Opposer,

INTER PARTES CASE NO. 3104

OPPOSITION TO:

- versus -

Application Serial No. 53758
Filed : May 16, 1984
Applicant : Ram N. Mahtani
Trademark : COLLEZIONE &
KEY DESIGN
Used on : Wallets

RAM N. MAHTANI,
Respondent-Applicant.
x-----x

DECISION NO. 89-98 (TM)
December 14, 1989

DECISION

This is an opposition to Ram N. Mahtani's application for the registration of the mark "COLLEZIONE & KEY DESIGN" for wallets under Serial No. 53758 filed on May 16, 1984 and published for opposition in the May 23, 1988 issue of the BPTTT Official Gazette.

Opposer, Key Multi-Industries, Inc., is a domestic corporation duly organized and existing under Philippine laws, with business address at 630 Lee Street, Mandaluyong, Metro Manila, while Respondent-Applicant, Ram N. Mahtani, is a citizen of the Philippines, with business address at 994 D Paris corner Leon Guinto Streets, Malate, Metro Manila

The core issue to be resolved in this case is whether or not Respondent-Applicant's mark "COLLEZIONE & KEY DESIGN" for wallets is confusingly similar with Opposer's mark "COLLEZIONE" for ladies' wear, blouses, children's wear, men's wear, polo shirts and other ready-made dresses. Opposer's mark is registered under Registration No. 26242 issued on September 13, 1978, which registration remains in force today.

We resolve in the affirmative.

The goods, though non-competitive, are very much related to each other. Both goods are sold and distributed in the same channels of trade, reaching the same class of purchasers and having the same price range. A buyer is likely to see them both sold in the same department store. What is more, the goods of the parties are complementary in the sense that they are usually used together. Wallets are accessories forming part of a person's overall daily wear. Thus, if Respondent-Applicant's mark would be registered, a likelihood of confusion is bound to occur—a confusion of source, affiliation or connection. In the case of Ang vs. Teodoro, 74 Phil. 50, the Supreme Court aptly stated that:

" x x x (a)lthough two non-competing articles may be classified under two different classes by the Patent Office because they are deemed not to possess the same descriptive properties, they would nevertheless be held by the courts to belong to the same class if the simultaneous use on them of identical or closely similar trademarks would be likely to cause confusion as to origin, or personal source, of the second user's goods." (Underscoring supplied)

There is no question that the two competing marks are closely similar to each other, if not identical. The style of lettering of both marks and the existence of the logo, i.e., key design on

each are the same. What could have been Respondent's purpose in selecting "COLLEZIONE" if not of its fame? The more than ten years of actual use and registration of the Opposer's mark is more than enough to establish goodwill of the business line and acceptability of the product bearing the mark. Thus, as held in the same case of Ang vs. Teodoro, supra:

"(i) it is certainly not farfetched that the selection by petitioner of the same trademark for pants and shirts was motivated by a desire to get a free ride on the reputation and selling power it has acquired at the hands of the respondent. As observed in another case, the field from which a person may select a trade-mark is practically unlimited, and hence there is no excuse for impinging upon or even closely approaching the mark of a business rival. In the unlimited field of choice, what could have been petitioner's purpose in selection of 'Ang Tibay' if not for its fame?"

In the recent case of Converse Rubber Corp. vs. Universal Rubber, G.R. No. L-27906, Jan. 8, 1987, the Supreme Court, in a more critical fashion, states:

"But even assuming, arguendo, that the trademark sought to be registered by respondent is distinctively dissimilar from those of the petitioner, the likelihood of confusion would still subsist, not on the purchaser's perception of the goods but on the origin thereof. By appropriating the word 'CONVERSE', respondent's products are likely to be mistaken as having been produced by the petitioner. 'The risk of damage is not limited to a possible confusion of goods but also includes confusion of reputation of the public could reasonably assume that the goods of the parties originated from the same source.'" (Underscoring supplied)

In this cited case, the word "CONVERSE" forms part of the Petitioner's tradename and used by Respondent as part of its trademark. Yet, the Supreme Court decided in the Petitioner's favor. A fortiori, the appropriation of herein Respondent-Applicant of the mark "COLLEZIONE" in an identical manner for goods complementary to each other and found in the same store would the principle of confusion of reputation or the confusion as to source of origin apply.

IN VIEW OF THE FOREGOING, this opposition is hereby SUSTAINED. Consequently, Application Serial No. 53758 in Respondent-Applicant's name is DENIED registration.

Let a copy of this Decision be forwarded to the Trademark Examining Division for proper action

SO ORDERED.

IGNACIO S. SAPALO
Director