

SOCIETE GIVENCHY,  
Opposer,

INTER PARTES CASE NO.3403  
Opposition to:

-versus-

Appln. Serial No.56423  
Filed: May 20, 1985  
Trademark: "4G GEMINI"

GOLD GALLERY JEWELRIES AND  
DESIGNS CO.,  
Respondent-Applicant.

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DECISION NO. 97-35

### DECISION

On 29 September 1989, Societe Givenchy, a corporation duly organized and existing under the laws of France with principal office and place of business at 3 Avenue Georges V, Paris 75008 France, filed its Verified Notice of Opposition docketed as Inter Partes Case No. 3403, to Application Serial No. 56423 for the trademark "4G GEMINI" covering wallets for gold chains and pouch for necklace and bracelet, which application was filed on 20 May 1985 by Gold Gallery Jewelries and Designs Co., a corporation organized under the laws of the Philippines, with business address at Room 1101, 11th Floor, State Center, Juan Luna, Binondo, Manila, which was published on page 23, Volume II, No. 5 of the Official Gazette of the Bureau of Patents, Trademarks and Technology Transfer which was officially released for circulation 31 May 1989.

The grounds for Opposition are as follows:

"i. The registration of the trademark "4G GEMINI" in the name of Respondent- Applicant will mislead the purchasing public and make it convenient for Respondent-Applicant to pass off its goods as those of the Opposer, resulting in damage to both the public and the Opposer,"

"ii. Except for the word "GEMINI", the trademark is exactly identical and so confusingly similar to the trademark "4G" owned and being used by the Opposer, such that the registration of the trademark "4G GEMINI" in the name of Respondent-Applicant will run counter to Section 4(d) of Republic Act No. 166,"

"iii. The registration of the trademark "4G GEMINI" in the name of Respondent-Applicant will violate the proprietary rights and interests of the Opposer over its trademark "4G" and will therefore cause great and irreparable injury to the latter".

Opposer relied on the following facts and circumstances to support its Opposition:

"i. The opposer is and has always been the owner of the trademark "4G" which it has used in its business and its goods particularly clothing including boots, shoes and slippers under International Class 25;

"ii. The Opposer has registered the trademark "4G" in France, its national country and also in various countries all over the world, namely, the Philippines, Argentina, Australia, Brazil, Bahamas, Switzerland, China, Denmark, Finland, United Kingdom (Great Britain), Greece, Hongkong, Indonesia, Ireland, Italy, Japan, Republic of Korea (South Korea), Lebanon, Norway, New Zealand, Sweden, Antilles, Brunei, Chile, Columbia, Costa Rica, Ecuador, Guatemala, Honduras, Kuwait, Macao, Malaysia, Nicaragua, Panama, Peru, Puerto Rico, Paraguay, Saudi Arabia, Singapore, El Salvador, Thailand, Taiwan and Venezuela;

“iii. Aside from the foregoing countries of registration, the opposer has also extensively used the trademark “4G” in the following countries, to wit: Luxembourg, Canada, Mexico, U.S.A., Benelux, Austria, Spain, Portugal, Andorra, Monaco, Liechtenstein, Iraq, United Arab Emirates, Syria, Yugoslavia, Hungary, Morocco, Egypt, Romania, San Marino, Czechoslovakia, Tunisia., Vietnam, Jordan, Kuwait, Oman, Israel, South Africa, Zaire, Sudan, Ethiopia, Kenya, Nigeria, Cameroun, Congo, Gabon, and Tanzania;

“iv. The opposer has obtained International Registration of its trademark “4G” under Registration No. 380.541 which extends to the following countries: Liechtenstein, Sweden, Yugoslavia, Austria, Benelux, Spain, Hungary, Italy, Morocco, Monaco, Portugal, Egypt, Romania, San Marino, Czechoslovakia, Tunisia and Vietnam;

“v. The opposer has caused the promotion, advertising and popularization of its trademark “4G” worldwide;

“vi. The long use of, as well as popularization of the trademark “4G” has generated an immense goodwill for the sage not only in France, but also in various countries all over the world, including the Philippines, such that opposer has acquired general international consumer recognition as belonging to one owner;

“vii. The trademark “4G GEMINI” is a flagrant and veritable imitation of opposer's trademark “4G” so that its use on the goods of respondent-applicant would indicate that respondent-applicant's goods are connected with the goods manufactured and/or sold by herein opposer as to falsely suggest a connection with the existing business of opposer and therefore constitutes an intent to defraud opposer:

“viii. The use of the “4G GEMINI” which is a mere reproduction of opposer's trademarks “4G” on respondent-applicant's goods dilutes the distinctiveness or strength of said trademark which the public has already identified or associated with opposer's goods to its prejudice and in violation of opposer's rights to said trademark:

“ix. Respondent-applicant's adoption of the “4G” device which is a mere reproduction of opposer's trademark “4G DEVICE” was clearly intended by respondent-applicant to ride on the goodwill of opposer's said trademark:

On May 20 1985, Respondent-Applicant filed an application for registration of the trademark “4G GEMINI AND 4G DEVICE” covering wallets for gold chains and pouch for necklace and bracelet which application was assigned Serial No. 56423. Said application was subsequently published on page 23, Volume 11, No. 5 of the Official Gazette of the Bureau of Patents, Trademarks and Technology Transfer, circulated on 31 May 1989;

On 27 July 1989 Opposer filed an Unverified Notice of Opposition. Shortly thereafter, or on 3 August 1989, this Office issued a Notice to Answer requiring Respondent-Applicant to file its Answer within fifteen (15) days from receipt thereof which notice was returned unclaimed. On 29 September 1989, within the period prescribed by the rules for filing same, Opposer filed a Verified Notice of Opposition.

Upon motion by Opposer, this Office issued an Order dated 28 March 1990 appointing special process server to effect service of Notice to Answer upon Respondent-Applicant. However, the special process server failed to serve the Notice to Answer because Respondent-Applicant could not be found in the address stated in the application, which it had allegedly vacated four (4) years earlier;

Opposer, upon order of the Office, caused the publication of the Notice to Answer in a newspaper of general circulation. Thereafter, motion of Opposer, Respondent-Applicant was declared in Default and Opposer was granted the right to present its evidence ex-parte.

On December 5, 1991, Opposer formally offered its evidence, Exhibits "A" to "Y" which this Office admitted in its Order dated 3 January 1992.

The main issue to be resolved in this case is whether or not the application for registration of the trademark "4G GEMINI and DEVICE" used on wallets for gold chains and pouch for necklace and bracelet by Respondent-Applicant is confusingly similar to the registered mark "4G" of the Opposer under Certificate of Registration No. 28848 used on goods particularly clothing including boots, shoes and slippers under International Class 25, issued December 29, 1980,

Section 4(d) of Republic Act No. 166 (Trademark Law) provides as follows:

*Section 4. Registration of trademarks, tradenames and service marks on the principal register.* - There is hereby established a 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 the same on the principal register, unless it.

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

Perusal of the evidence for the Opposer clearly shows that the mark "4G" is the dominant feature in both parties' trademarks. The only difference lies in the insertion of the mark "GEMINI" after "G" in the Respondent's mark. Nonetheless, this does not deter unwary purchasers from noticing that the products of either party originate from one source, thereby causing confusion, mistake and deception as to the source or origin of the product.

Noteworthy also is the prior registration of the subject mark "4G" by the Opposer under Certificate of Registration No. 28848 issued on December 29, 1980 (see Exhibit "B") whereas Respondent-Applicant filed its application for registration of the mark "4G GEMINI" only on May 20, 1985 (Exhibit "AA"). Thus, the reasonable conclusion is that Opposer is the prior registrant and lawful owner of the mark "4G".

Moreover, the non-filing of Respondent of its responsive pleading despite personal service and publication of the Notice to Answer is a clear manifestation of Respondent's lack of interest in pursuing its application for registration in this Bureau and is taken as a tacit recognition of Opposer's lawful ownership and right to use of the mark "4G" for its products.

WHEREFORE, premises considered, the herein Notice of Opposition is, as it is hereby SUSTAINED. Accordingly, Serial No. 56423 for the mark "4G GEMINI" in favor of the herein Respondent-Applicant is hereby REJECTED.

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

SO ORDERED.

Makati City, October 27, 1997

EMMA C. FRANCISCO  
Director