

VALENTINO GLOBE B.V.,	}	IPC NO. 4286
Opposer,	}	Opposition to:
	}	Serial No. 77002
-versus-	}	Filed: July 25, 1991
	}	Applicant: Florence Fashion
	}	(Jersey) Ltd.
FLORENCE FASHIONS	}	Trademark: "GIANNI VALENTINO"
(JERSEY) LTD.,	}	
Respondent-Applicant	}	
x-----x		Decision No. 2003-30

D E C I S I O N

This case is an Opposition to the registration of the trademark "GIANNI VALENTINO" filed by Opposer, Valentino Globe B.V. against Respondent-Applicant, Florence Fashions (Jersey) Ltd.

This Office received Opposer's verified Notice of Opposition on March 13, 1997 after its earlier filing of an Unverified Notice of Opposition on January 10, 1997. After a request for extension favorably granted to Respondent-Applicant, an Answer was filed on June 11, 1997.

Respondent-Applicant, a corporation organized and existing under the law of Jersey, Channel Islands, filed an application for the registration of the trademark "Gianni Valentino" for goods under class 25. It claims that "Gianni" is a common abbreviation of the name "Giovanni" and "Giovanni Valentino" is the name of its company president who is the son of and internationally renowned designer name Mario Valentino.

Opposer which based its opposition on Section 4(d) of Republic Act 166, asserts its prior registration of the mark "Valentino Garavani & V Logo" and the "Valentino" and "V (Logo)" and maintains its prior adoption and use.

Opposer's evidence which this office have considered in arriving in its decision consists of lists of foreign magazines featuring Valentino products, covers of foreign magazines featuring articles and pictures of Valentino products, excerpts from the book "Valentino, thirty years of magic" by Mari-Paule Pelle and Patrick Mauries (January 1990), excerpts from the "The Who's Who of the Italian Fashion" by Adriana Mulassano and Alfa Castaldi (February 1979), brochure on fashion, Valentino story, list of "Valentino" editorial and/or advertising, magazine "Vogue Italia" brochure on "Valentino Couture", legalized copies of registration in other countries, namely, Australia, Benelux, Brazil, Chile, United Kingdom, Greece, Hongkong, Japan, New Zealand, South Africa, Sweden, Switzerland, Venezuela, Syria, Italy and China. It offered the deposition of foreign witness George Frederik Nicolai and local witness Eva de los Reyes.

Respondent-Applicant chose not to adduce any evidence in its behalf proceeding from its declaration in open court as well as its written manifestation filed on September 25, 2001 that it will no longer defend the opposition.

The issue is whether or not the trademark "GIANNI VALENTINO" of the respondent-applicant is identical with or confusing similar to the trademark of herein Opposer, hence proscribed under section 4(d) of Republic Act 166.

The provision of law in point is Section 4(d) of Republic Act 166, which provides:

Sec. 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 the trademark, tradename or servicemark 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:

x x x

d) consists of or comprises a mark or trade-name which so resembles a mark of trade-name registered in the Philippines or a mark or trade-name 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 mistakes or to deceive purchasers; or

x x x

Upon examination and comparison of Respondent-Applicant's mark "GIANNI VALENTINO" with the registered mark of the Opposer, under Certificate of Registration No. 52082 for the trademark "VALENTINO GARAVANI and V-logo" it is observed that the name "Valentino" is the most prominent and distinctive feature of both marks. "Valentino" appears to be the first name of one and the surname of the other. The sound of the name Valentino when pronounced is catchy and prominent.

The fact that Opposer's registration of the "Valentino Garavani and V-logo" is under international class 18 for leather goods does not detract from nor lessen the possibility that confusion is likely to result. The Sponsorship theory discussed in the case Chua Che vs. Philippine Patent Office 13 SCRA 67, January 31, 1965, which we find applicable to the instant case, theorized that registration of a trademark should be refused in cases where there is a likelihood of confusion, mistake or deception even though the goods fall under different categories. The likelihood that purchasers will associate the product to a common origin is not farfetched. Both trademarks represent such kind of products that are marketed or sold in the same type of stores that cater to same breed of customers. Respondent-Applicant in its pre-trial brief mentions that it uses its mark on high fashion products, which are specialist and premium goods sold through exclusive department stores and boutiques. Hence, the likelihood of confusion is real.

The evidence further shows that Opposer's marks have been registered in several foreign countries (Exhibit "M" and its submarkings) and the products bearing the "valentino" trademark have acquired a certain stature in the fashion industry. (Exhibits "B"-5, "C"-1, "D"-6). It cannot be ignored that fashion icons choose to wear Opposer's clothes. It likewise appears from documentary evidence presented that famous Jacqueline Kennedy wore a Valentino dress on her wedding to Aristotle Onassis. Further, the evidence unmistakably shows top models like Naomi Campbell, Claudia Schiffer and Linda Evangelista modeling Valentino clothes in the pages of respectable fashion magazines. All these suggest that Opposer has built an overwhelming impression upon the fashion industry. Thus, we are convinced that even a discerning patron of fashion may be misled into thinking that the products bearing Respondent-Applicant's mark is but a variation or new product line from the designer Valentino, specially so because the trademark in question is to be applied for products under class 25 which includes CLOTHES. The relevant public who have familiarized themselves with leading names in the fashion industry and are aware of "Valentino" products features in magazines, meticulous and discriminating as they may be, can still be deceived if respondent's mark will be allowed on products that directly compete with opposer's items. Confusion may result even if consumers have the luxury of time to examine labels of these competing products.

The object of trademark is to point out distinctly the origin or ownership of the article to which it is affixed, to secure to him who has been instrumental in bringing into the market a superior article or merchandising the fruit of his industry or skill, and to prevent fraud or imposition. (Etepha A.G. vs. Director of Patents & Westmont Pharmaceuticals, Inc. GRL-20635, March 31, 1996)

Furthermore, the record is replete with proof showing that it used extensive promotion and advertising (Exhibits "B"- "F" and its submarkings) in order to build a name and reputation in fashionable ladies clothes. It was also able to prove that it has used its trademark in commercial sale (Exhibits "P", "Z", "AA"- "CC"), thus ably impressing upon the relevant public the distinctiveness of its trademark and is sufficient proof that its use has not been abandoned.

On the other hand, Respondent-Applicant barring only its bare allegation of use and adoption of its trademark opted not to defend the opposition, hence no evidence was proffered in its behalf.

Finding that Respondent-Applicant's mark "GIANNI VALENTINO" is confusingly similar to Opposer's mark, its registration is proscribed under Section 4(d) of Republic Act 166, this Office and resolves to grant the opposition. Accordingly, the instant Opposition is, as it is hereby SUSTAINED.

Considering however that Inter Partes Case No. 4285 which was heard jointly with Inter Partes Case No. 4322 between the parties VALENTINO SHOES INC., Opposer and FLORENCE FASHIONS (JERSEY) LTD. Respondent – applicant, respectively, involving the trademarks GIANNI VALENTINO and GIOVANNI VALENTINO, which cases were decided on the basis of a Compromise Agreement entered into between the parties without considering the outcome of this present case, pertinent dispositions under Order No. 2001-17(D) is deemed superseded in consonance with the following dispositions. Consequently, Application Serial No. 77002 filed on 25 July 1991 for the registration of the trademark "GIANNI VALENTINO" for use in clothing, headgear, footwear and other products under class 25 filed by respondent-applicant, Florence Fashions (Jersey) Ltd. Which matured into Certificate of Registration No, 4-1991-78660 issued on May 4, 2001 is, as it is hereby CANCELLED.

Let the filewrapper of "GIANNI VALENTINO" subject matter of this case be forwarded to the Administrative, Financial, Human Resources Development Service Bureau for appropriate action in accordance with this DECISION with a copy to be furnished to the Bureau of Trademarks for information and update its records.

SO ORDERED.

Makati City, 09 July 2003.

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs