

WALTON INTERNATIONAL LTD.	}	IPC Case No. 14-2000-00039
Opposer,	}	14-2000-00044
	}	Trademark: "GIORDANO"
-versus-	}	Serial Nos. 108599 and 108600
	}	
FERDINANDO GIORDANO S.P.A.	}	
Respondent.	}	Decision No. 2005 – 17
x-----x		

DECISION

The instant case are consolidated Opposition cases filed by Walton International Ltd. (Opposer), a company incorporated under the laws of the Cayman Islands with registered offices situated at the offices of Royal Trust (Cayman) Limited, P.O. Box 1586, Grand Cayman against Application Serial No. 108599 for the registration of the trademark "GIORDANO" on goods under Class 29 and Application Serial No. 108600 for the goods under class 33, in the name of Ferdinando Giordano S.P.A. (Respondent-Applicant).

Opposer filed a verified Notice of Opposition on 13 December 2000, claiming that:

- "1. Opposer is the lawful owner of the trademark "GIORDANO" registered in this jurisdiction under Certificate of Registration Nos. 51681 issued on 7 October 1991; Certificate of Registration No. 4-1994-95688 issued on 23 June 2000; and Certificate of Registration No. 4-1990-75997 issued on 28 August 2000.
- "2. Opposer is the owner of more than a hundred trademark registrations for exactly the same mark in various countries throughout the world covering diverse classes of goods and services.
- "3. Opposer was the first to adopt and use the above-named trademark in actual trade and commerce for various international classes throughout the world and was in fact first used by the opposer in Hong Kong in March 1981.
- "4. Registration by the respondent of the mark "GIORDANO" will be violative of the Section 123.1 (d) & (f) of Republic Act 8293;
- "5 Being internationally well-know, Opposer's mark is likewise protected under Article 6bis of the Paris Convention.

In its Answer filed on 11 April 2001 in Inter-Partes Case No. 14-2000-00039, respondent-applicant argued that Opposer's claim that it is "internationally well-known" is not supported by proof and has not met the criteria enumerated under Rule 102 of the Rules and Regulations on Trademarks, Service Marks, Trade Names, and Marked or Stamped Containers. Respondent also argues that the goods covered by respondent-applicant's application belong to a different class of goods when compared with the class of goods specified in the certificates of registration of the opposer. In the meantime, an Alias Notice to Answer to respondent was issued by Hearing Officer Josephine Alon in Inter Partes Case No. 14-2000-00044. No answer was received in Inter Partes Case 14-2000-00039 that it had already filed an answer in Inter Partes Case No. 14-2000-00039.

The issues having been joined in Inter Partes Case No. 14-2000-00039, the case was set for pre-trial conference. For failure of the respondent-applicant to attend the pre-trial conference set on 19 July 2001, the respondent-applicant was declared in default on motion of the opposer and the case proceeded for the *ex-parte* presentation of evidence of opposer.

In the meantime, opposer moved for the consolidation of the proceedings of IPC 14-2000-00044 into IPC No. 14-2000-00039 which was favorably granted in Order No. 2001-707 dated 15 November 2001.

Admitted as evidence for the Opposer are Exhibits "A" to "E" inclusive of submarkings, to wit: Exhibit "A" – Certificate of Registration No. 51681 issued on 7 October 1991; Exhibit "B" Certificate of Registration No. 4-1994-95688 issued on 23 June 2000; Exhibit "C" – Certificate of Registration No. 4-1990-75997 issued on 28 August 2000; Exhibit "D" – Listing / Inventory detailing opposer's trademark registrations for the mark "GIORDANO" worldwide, appended to the Affidavit of Anthony Clinton Dudley Evans; Exhibit "E" – selected trademark registrations of the same mark in different countries throughout the world appended to opposer's trademark counsel.

The issues to be resolved in the instant case are: 1) Whether or not there is confusing similarity between the marks. 2) Whether confusion as to origin would ensue

The challenged application having been filed under the provisions of the old Trademark law or Republic Act 166, the instant case shall be decided based on the provisions thereof so as not to prejudice vested rights of the parties. The applicable provisions of Republic Act 166 provides that:

"Sec. 4. Registration of trademarks, tradenames and service marks in the principal register. – xxx The owner of a trademark, tradename or service mark, 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: xxx

d) Consists of or comprises a mark of trade name which so resembles a mark or 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 mistake or deceive purchasers."

Evidence glaringly show the dissimilarity of the goods of the opposer and respondent-applicant for which the mark "GIORDANO" is used. Opposer's Certificates of Registration Nos. 51681 issued on 7 October 1991, 4-1994-95688 issued on 23 June 2000, 4-1990-75997 issued on 28 August 2000, (Exhibits "A", "B" and "C" for the mark "GIORDANO" in the Philippines are for class 25; class 42; and class 14 and 18 respectively. The goods under these classifications are as follows:

Class 14. Precious metals and their alloys and goods in precious metals or coated therewith (except cutlery, forks and spoons); jewelry, precious stones, horological and other chronometric instruments.

Class 18. Leather and imitations of leather, articles made form these materials and not included in other classes, skins, hides, trunks and traveling bags, umbrellas, parasols and walking sticks, hides, trunks and traveling bags, umbrellas, parasols and walking sticks; whips, harness and saddlery.

Class 25. Clothing including boots, shoes and slippers

Class 42. Retailing and wholesaling of waters, clocks, clothing, footwear, headgear, bags, leather products and fashion accessories

On the other hand, respondent-applicant is applying for the mark "GIORDANO" on the following goods under class 29 and 33:

Class 29. Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams; eggs; milk and other dairy products; edible oils and fats, preserves, pickles.

Class 33. Wines, spirits and liqueurs

In the case of *Esso Standard Eastern, Inc. vs. Court of Appeals and United Cigarette Corporation* (G.R. No. L-29971. August 31, 1982), the Supreme Court ruled that there was no infringement of the trademark "ESSO" owned and used by petitioner on the sale of its petroleum products by respondent use of the "ESSO" mark on its cigarette goods. The Supreme Court held:

"the law defines infringement as the use without the consent of the trademark owner of any "reproduction, counterfeit, copy or colorable imitation of any registered mark or tradename in connection with the sale, offering for sale, or advertising of any goods, business or services on or in connection with which the use is likely to cause confusion, mistake or to deceive purchasers or others as to the source or origin of such good." Implicit in this definition is the concept that the goods must be so related that there is likelihood either of confusion of goods or business." (Emphasis supplied)

Earlier, the Supreme Court elaborated on the restricted right over a trademark. In *Philippines Refining Co., Inc. vs. Ng Sam and the Director of Patents* (No. L-26676 July 30, 1982):

"A rudimentary precept in trademark protection is that "the right to a trademark is limited one, in the sense that others may use the same mark on unrelated goods. Thus, as pronounced by the United States Supreme Court in the case of *American Foundries vs. Robertson*, "the mere fact that one person has adopted and used a trademark on his goods does not prevent the adoption and use of the same trademark by others of on articles of a different description.

Such restricted right over a trademark is likewise reflected in our Trademark Law. Under Section 4(d) of the law, registration of a trademark which so resembles another already registered or in use should be denied, where to allow such registration could likely result in confusion, mistake, deception to the consumers. Conversely, where no confusion is likely to arise, as in this case, registration of a similar or even identical mark may be allowed. (Emphasis supplied)

Based on the foregoing discussion the registration of the mark "GIORDANO" may be allowed because confusion is remote and unlikely when the mark is applied to goods that are totally different from the goods of opposer.

Opposer also argues that it is a well-known mark and cites its registrations abroad. It quotes Article 6bis of the Paris Convention for the Protection of Industrial Property. The applicability of Article 6bis has been discussed in the *Canon Kabushiki Kaisha vs. Court of Appeals and NSR Rubber Corporation* (G.R. No. 120900, 20 July 2000), to wit,

"However, the then Minister of Trade and Industry, the Hon. Roberto V. Ongpin, issued a Memorandum dated 25 October 1983 to the Director of Patents, a set of guidelines in the implementation of Article 6bis of the Treaty of Paris. These conditions are:

- a) the mark must be internationally known;
- b) the subject of the right must be a trademark, not a patent or copyright or anything else,

- c) the mark must be for use in the same or similar kinds of goods; and
- d) the person claiming must be the owner of the mark. (The Paris Convention Commentary on the Paris Convention. Article by Dr. Bogsch, Director General of the World Intellectual Property Organization, Geneva, Switzerland, 1985)

from the set of facts found in the records, it is ruled that the Petitioner failed to comply with the third requirement of the said memorandum, that is the mark must be for use in the same or similar kinds of goods. The Petitioner is using the mark "CANON" for products belonging to class 2 (paints, chemical products) while the Respondent is using the same mark for sandals (class 25). Hence, Petitioner's contention that the mark is well known at the time the Respondent filed its application for the mark should fail." (underscoring supplied)

Following the ruling in the Canon case, opposer cannot be entitled to the relief it seeks. A thorough review of the records reveals that opposer's registrations abroad based on the inventory list provided by its legal counsel pertain to goods under classes 18, 25, 9, 14, 42. We note some registrations under classes 6, 9, 10, 17, 21 and 26, yet, not one of the registrations of mark "GIORDANO" is for goods under Classes "29" or "33". The goods are totally different and there is no indication that the opposer would branch into selling goods under international 33 or 29. Therefore, confusion as to origin of the goods is likewise a remote possibility.

As succinctly stated in the aforementioned case "When a trademark is used by a party for a product in which the other does not deal, the use of the same trademark on the latter's product cannot be validly objected to."

WHEREFORE, premises considered the instant Opposition is hereby DISMISSED and application Serial Nos. 108599 and 108600 for the registration of the trademark "GIORDANO" for "Meat, fish, poultry and game; meat extracts, preserved; dried and cooked fruits and vegetables; jellies, jams; eggs; milk and milk products, edible oil and fats under International Class 29 and alcoholic beverages except beer under international Class 33" in the name of Ferdinando Giordano S.P.A., is hereby GIVEN DUE COURSE.

Let the filewrapper of GIORDANO, subject matter in these cases be forwarded to the Administrative, Financial and Human Resources Development Services Bureau for appropriate action in accordance with this Decision and a copy thereof furnished the Bureau of Trademarks for information and to update their records.

SO ORDERED.

Makati City, 28 September 2005.

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs