

WRANGLER CLOTHING CORP., Opposer,  -versus-  WILLIAM Y. CASTRO. Respondent-Applicant. x-----x	} } } } } } } } } }	Inter Partes Case No. 14-2000-00030 Opposition to:  App. Serial No. : 113691 Filed on : 09-26-1996 Trademark : "GIVANO"  Decision No. 2001-21
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DECISION

This is an opposition proceeding instituted by the Opposer, Wrangler Clothing Corporation, a Delaware Corporation, against an application to register the trademark "GIVANO" filed by the applicant, William Y. Castro.

The grounds for the opposition are as follows:

"1. The trademark "GIVANO" being applied for by the Respondent-Applicant is confusingly similar and identical to opposer's trademark "GITANO", as to be likely, when applied to or used in connection with the goods (clothing) of Respondent-Applicant will cause confusion, mistake and deception on the part of the purchasing public.

"2. The registration of the trademark "GIVANO" for class 25 (clothing and shoes) in the name of the Respondent-Applicant will violate Sec. 123 (d) Intellectual Property Code which states that a mark cannot be registered if: "it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing of priority date, in respect of: (I) The same goods or services; and (III) if it nearly resembles such a mark as to be likely to deceive or cause confusion (Sec. 123(d) (I) and (III), Intellectual Property Code).

"3. The registration and use of the Respondent-Applicant of the trademark "GIVANO" will diminish the distinctiveness and dilute the Opposer's trademark "GITANO".

"4. The registration of the trademark "GIVANO" in the name of the Respondent-Applicant for the same goods as those of the Opposer is likely to mislead the public, particularly as to the nature, quality, characteristics or origin of the goods (Sec. 123 (g) supra).

"5. The registration of the trademark "GIVANO" in the same name of the Respondent-Applicant is contrary to other provision of the Intellectual Property Code.

In support of this Opposition, Opposer relied upon the following facts, among others:

"1. Opposer's is the registrant-assignee of the mark "GITANO" Registration No. 53850 issued on November 5, 1992 Class 25, which mark had been registered in the United

States Patent and Trademark Office for Class 25 per Registration No. 1,453,287 issued on August 18, 1987.

"2. The Opposer has acquired the mark "GITANO" for extensive commercial use in the Philippines as shown in an assignment executed on July 12, 2001, by GITANO FASHIONS LIMITED, former owner, in favor of the herein Opposer, which was submitted for recordal with this Honorable office in July 19, 2000, copy thereof is herewith attached as Annex "A" and made part hereof.

"3. By virtue of the Opposer's acquisition of the former owner's trademark GITANO in the Philippines and its prior registration not only in the Philippines but also in almost every country in the world, that the name and mark GITANO has become famous as shown by a certified true copy of the Intellectual Property Assignment hereto attached as Annex "B" and made integral part hereof.

"4. The registration and use of the confusingly similar mark GIVANO by the Respondent-Applicant for similar goods under Class 25 will deceive and/or confuse purchasers into believing that Respondent-Applicant's goods and/or products bearing the trademark GIVANO emanate from or are confused with those of Opposer.

"5. The registration and use of the confusingly similar trademark GIVANO by Respondent-applicant will diminish the distinctiveness and dilute the goodwill of Opposer's famous mark GITANO.

"6. It is evident that the adoption of the trademark GIVANO by Respondent-Applicant which is confusingly similar and almost identical in sound and spelling to Opposer's trademark GITANO was not made in good faith. Rather, there is apparently an intent to ride on the goodwill established and to "pass off" Respondent-Applicant's goods as those of Opposer because of its worldwide popularity. Respondent-applicant obviously intends to trade and is trading on Opposer's goodwill."

Opposer, Wrangler Clothing Corporation, a Delaware (USA) Corporation, is the owner of the trademark GITANO registered under Registration No. 53850 issued on November 5, 1992 for Class 25 with the Bureau of Trademarks and Technology Transfer, now the Intellectual Property Office (Exhs. "A-1" to A-3"). The original registrant of subject mark in the Philippines was Gitano Licensing Ltd., which later assigned the same to Gitano Fashions Ltd. The latter in turn assigned the mark to the Opposer, Wrangler Clothing Corporation (Exhs. "B" to "B-5"). This assignment (from Gitano Fashions Ltd., to Wrangler Clothing Corporation) is duly recorded with the Intellectual Property Office. (Exhs. "C", "C1" and "D").

On September 26, 1995, Respondent-Applicant filed an application for registration of the trademark "GIVANO" under application Serial No. 113691 covering the product under Class 25. On June 29, 2000, the said application was published for purposes of opposition on the November-December, 1999 issue of the Official Gazette, p. 75, Vol. II No.6.

Then on August 21, 2000, after requesting extension to file opposition, the Opposer filed a verified notice of opposition.

Subsequently, on August 30, 2000, Notice to Answer together with a copy of the Notice of Opposition were sent to the Respondent-Applicant, who on September 13, 2000, filed a motion for extension to file answer. Despite the grant of the extensions, Respondent-Applicant still failed to file his Answer. On December 7, 2000, Opposer filed a motion to declare Respondent-Applicant in default which this Office granted in an Order dated December 15, 2000 at the same time set the case for the reception of evidence ex-parte on January 24, 2001.

As ordered, the Opposer presented its evidence, consisting mainly of documentary exhibits, on January 24, 2001.

The only issue to be resolved in the instant proceedings is whether Respondent-Applicant's trademark GIVANO is confusingly similar to Opposer's GITANO and whether Respondent-Applicant is entitled to the registration of the mark "GIVANO".

#### As To Similarities And Dissimilarities Of The Marks.

The marks GIVANO and GITANO, when viewed in their entireties, have a number of similarities in spelling. Both marks are composed of six letters of three syllables each and each syllable has the same vowel. The first word of each mark consists of a letter beginning with the letter "G" and ending with the letter "O". The first two letters and the last three- letters of both marks are identical. The only difference lies in the letter "V" in GIVANO and "T" in GITANO.

The two marks also have similarities in sound. Both marks consist of three syllables, with the same cadence when spoken. Likewise, the two marks have the same initial and concluding sounds.

While "GIVANO" and "GITANO" may differ in meaning, GITANO has a dictionary meaning of "a Spanish male gypsy". (*Websters Third New International Dictionary Unabridged, 1986 ed.*) Whereas, GIVANO is a whimsical and capricious coined mark with no known meaning or connotation, nevertheless, they have almost the same sound when pronounced.

Having considered all evidence on record we find that the similarities in general form, spelling and sound between GIVANO and GITANO outweigh the dissimilarity in meaning, such that the overall commercial impression conveyed by the two marks is so similar that it will result to the likelihood of confusion.

#### The Similarity Or Dissimilarity And Nature Of The Goods.

In the case at bar, there is no difficulty in arriving at a conclusion that the goods of the two parties connected with their respective trademarks are related to each other. The goods covered by the competing trademarks are similar. The Respondent-Applicant goods sought to be covered by the mark "GIVANO" as enumerated in its trademark application are: shoes, shirts, shorts, pants, socks, jackets, caps and dresses, while Opposer's goods covered by its registered mark "GITANO" as enumerated in its trademark registration no. 53850 are: boy's and men's pants, jackets, woven shirts, sweaters, rain wears, shirts; and girls and ladies woven blouses, skirts, pants, shorts, shirts, cardigans, blazers, jackets, sweaters, rain wears, jumpers, underwears and lingerie.

From the goods alone of the competing parties covered by the competing marks, it is clearly shown that they fall under the same classification, CLASS 25. They serve the same purpose and flow through the same channel of trade, hence, they are competing and are considered to be RELATED GOODS.

The Supreme Court in the case of ESSO Standard Eastern, Inc. vs. The Honorable Court of Appeals and United Cigarette Corporation (116 SCRA 336, 342 [1982]) ruled that:

“Goods are related when they belong to the same class or have the same descriptive properties; when they possess the same physical attributes or essential characters with reference to their form, composition, texture or quality. They may also be related because they serve the same purpose or sold in grocery store. (2 Callman Unfair Competition & Trademarks, p. 1257). Thus, biscuits were held related to milk because they are both food products (Arce vs. Selecta Supra). Soap and perfume, lipstick and nail polish are similar related because they are common household items nowadays. (Chua Che vs. Phil. Patent Office Supra)”  
(underscoring supplied)

Pursuant to the aforesaid Supreme Court ruling, the goods of the parties are obviously similar to each other. They are so related to each other as to make it likely that the purchasers would think that Opposer is the manufacturer of Respondent-Applicant’s goods as they belong to same classes of goods or vice versa.

It is therefore clear that the goods on which the trademark “GIVANO” is used by Respondent-Applicant is competing, sold on the same channels of trade and entirely related to the products of Opposer so that there is likelihood of confusion or deception on the part of the purchasing public as to the origin or source of the goods.

#### The Fame of the Prior Mark

Opposer, WRANGLER CLOTHING CORPORATION, likewise claims entitlement for protection of its registered trademark as well known mark under the Convention of Paris for the Protection of Industrial Property, the relevant article thereof provides:

Article 6 bis  
[Marks: Well-Known marks]

"The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interest party, to refuse or to

cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or used to be well known in that country as being already the mark of a person entitled to the benefits of this convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any well-known mark or an imitation liable to create confusion therewith." (Underscoring provided)

To support its claim that the trademark "GITANO" had attained the status of well-known mark, Opposer stated that the trademark "GITANO" which was originally owned by Gitano Licensing Ltd. was later assigned the same to Gitano Fashion Ltd., which in turn assigned the mark to herein Opposer, Wrangler Clothing Corporation has registered and used the same in the United States and worldwide (Exhibit "B" to "B-5"). The assignment (from Gitano Fashions Ltd. To Wrangler Clothing Corporation) is duly recorded with the Intellectual Property Office-Philippines. (Exhs. "C", "C-1" and "D")

Likewise its witness, Atty. Emeterio V. Soliven testified that the trademark "GITANO" is registered in One Hundred Ninety Eight (198) countries including the Philippines. (TSN pp. 13-23, January 24, 2001 and Opposer's Memorandum, p.6)

"GITANO" as a well-known mark deserves a broader scope of protection (see e.g. Kenner Parker Toys, Inc. vs. RoseArt Industries 22 USPQ 2d 1453 [Fed. Cir. 1992] and cases cited therein) such broader scope of protection may be invoked only when the latter is used for identical or similar goods by another and is liable to create confusion pursuant to Article 6 bis of the convention.

In a Memorandum cited by the Opposer, issued by the then Minister of Trade and Industry, Roberto V. Ongpin, dated 25 October 1983 to the Director of Patents, he laid down as a set of guidelines in the implementation of Article 6 bis 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 use for use in the same or similar kinds of goods; and
- "d. the person claiming must be the owner of the mark. (The Parties Convention Commentary on the Paris Convention. Article by Dr. Bogach, Director General of the World Intellectual Property Organization, Geneva, Switzerland, 1985) (underscoring ours)

From the goods indicated in the certificates of registration submitted, its registration in one hundred ninety eight (198) countries, and as present assignee the Opposer compiled with the said memorandum. The Opposer is using the mark "GITANO" for the goods under class 25 same with Respondent-Applicant who is also using the mark "GIVANO" for goods under class 25 and as previously determined the Opposer's goods is related to the goods covered by the trademark of Respondent-Applicant, the products involved are so related that the public will be misled in the use of identical marks. Hence, Opposer is entitled to the protection under Article 6 bis.

#### Prior adopter and user

The mark "GITANO" was registered in the Philippines under Registration No. 53850 on November 5, 1992 which was filed as early as March 24, 1988 with a date of first use in the Philippines of December 31, 1983 and a date of first use on goods of December 31, 1971. (Exhibit A-2), whereas the application for registration of the mark "GIVANO" an application was only filed on September 26, 1996 with a date of first use in the Philippines of February 9, 1994.

From the dates alone, one can already determine who is the prior adopter and user of the competing mark. There is therefore, no difficulty to conclude that the Opposer has the better right to appropriate the mark "GITANO" as the prior adopter and user. Accordingly, the adoption and use by Respondent of the mark GIVANO which is confusingly similar to Opposer's mark GITANO cannot be allowed.

Furthermore, where there is any doubt on the question of likelihood of confusion, it must be resolved against the newcomer as the newcomer has the opportunity of avoiding confusion, and is obligated to do so. (TBC Corp. vs. Holsa Inc., 44 USPQ2d 1315)

WHEREFORE, premises considered, the Notice of Opposition is hereby SUSTAINED. Consequently, Application bearing Serial No. 113691 for the registration of the trademark "GIVANO" used on shoes, shirts, shorts, pants, socks, jackets, caps & dresses under Class 25, filed by William Y. Castro, is hereby REJECTED.

Let the filewrapper of this case be forwarded to the Administrative, Financial and Human Resource Development Services Bureau for appropriate action in accordance with this Decision,

with a copy thereof to be furnished the Bureau of Trademarks for information and to update its records.

SO ORDERED.

Makati City, 06 December 2001.

ESTRELLITA BELTRAN-ABELARDO  
Director, Bureau of Legal Affairs  
Intellectual Property Office