



VALENTINO S.P.A.,	}	IPC No. 14-2007-00256
Opposer,	}	Opposition to:
	}	
	}	Appln. Ser. No. 4-2006-006219
- versus -	}	Date Filed: 13 June 2006
	}	
	}	Trademark: VALENTINO &
DON JUAN PUBLISHING, INC.,	}	DEVICE
Respondent-Applicant.	}	
x-----x	}	Decision No. 2012 - <u>57</u>

DECISION

VALENTINO S.P.A.¹ ("Opposer") filed on 03 September 2007 a Verified Notice of Opposition to Trademark Application No. 4-2006-006219. The application, filed by DON JUAN PUBLISHING, INC.² ("Respondent-Applicant"), covers the mark VALENTINO & DEVICE for use on "magazine" under Class 16 of the International Classification Goods³.

The Opposer alleges the following:

"1. Opposer is the first to adopt, use and register worldwide including the Philippines, the VALENTINO trademark and its derivatives and is well-known internationally and in the Philippines, taking into account the knowledge of the relevant sector of the public, rather than the public at large, as being a distinctive trademark owned by the Opposer. It thus enjoys under Section 147 of Republic Act No. 8293 the right to exclude others from registering or using identical or confusingly similar marks such as Respondent-Applicant's trademark VALENTINO for goods falling under international class 16.

"2. Respondent's use of the VALENTINO for immoral and scandalous materials will definitely disparage, bring into contempt or disrepute Opposer's mark or falsely suggest a connection with the Opposer or its founder and artistic leader, Valentino Garavani hence, its registration is proscribed under Section 123 (a) of R. A. 8293.

"3. Respondent-Applicant's appropriation and use of the trademark VALENTINO infringes upon the Opposer's exclusive right to use as registered owner of its VALENTINO trademark, which is protected under R. A. 8293 particularly Section 147 thereof.

"4. The trademark VALENTINO is the dominant part of Opposer's trade/business name which under Section 165.2 of R. A. 8293 should be

1 A foreign corporation organized under the laws of Italy with business address at via Turati 16/08, 20121, Milan, Italy.

2 With address on record at 3F New Rosario Arcade, 42 Ortigas Avenue Extension, Rosario, Pasig City.

3 The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks, based on a multilateral administered by the World Intellectual Property Organization. This treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks concluded in 1957.

protected even prior to or without the obligation of registration.

“Opposer relies on the following facts to support its opposition, reserving the right to present other evidence to prove these facts and others as may appear necessary or expedient in the course of the proceedings:

“1. The VALENTINO trademark and its derivative marks are well-known internationally and in the Philippines.

Opposer is the owner of the trademark VALENTINO and its derivatives. The VALENTINO mark which petitioner herein originated and adopted in 1959 is well-known internationally and have been registered in over ninety (90) countries worldwide. The goods and/or services carried under said trademarks had, through the years, earned international acclaim, as well as the distinct reputation of high quality goods and services long before the application and registration of respondent-registrant's questioned mark.

In the Philippines, Opposer has registrations for the trademark VALENTINO & V LOGO with Registration No. 4-1997-124857 issued on July 1, 2004 for goods falling under international class 9, VALENTINO & V LOGO with Registration No. 4-1997-124856 issued on January 17, 2005 for goods falling under international class 3 and V (LOGO) with Registration No. 53234 issued on August 7, 1992.

x x x

There are also twelve (12) pending applications, covering said VALENTINO marks in the Philippines, to wit:

Trademark: VALENTINO & V (LOGO) in Class 25
Serial No.: 124860
Date Filed: 09-18-97

Trademark: VALENTINO GARAVANI & V LOGO in Classes 9 and 25
Serial No.: 74377
Date Filed: 12-13-90

Trademark: VALENTINO & V in Ellipse in Class 35
Serial No.: 4-2000-0010495
Date Filed: 12-22-00

Trademark: V in Ellipse in Class 3
Application No.: 4-2000-10493
Date Filed: 12-22-2000

Trademark: VALENTINO GARAVANI & V IN ELLIPSE in Class 18
Application No.: 4-2003-0004832
Date Filed: 06-02-2003

Trademark: V in Ellipse in Class 14
Application No.: 4-2000-10494

Date Filed: 12-22-00

Trademark: V in Ellipse in Class 18
Application No.: 4-2000-10491
Date Filed: 12-22-00

Trademark: V in Ellipse in Class 9
Application No.: 4-2000-10490
Date Filed: 12-22-00

Trademark: V in Ellipse in Class 35
Application No.: 4-2000-10492
Date Filed: 12-22-00

Trademark: VALENTINO & V (LOGO) in Class 13
Application No.: 00124858
Date Filed: 9-18-97

Trademark: VALENTINO GLOBE B.V. In Classes 25 and 14
Serial No.: 70273
Date Filed: December 13, 1989

Trademark: V in Ellipse
Serial No.: 4-2000-0010487
Date Filed: December 22, 2000

"2. The VALENTINO trademark which originated in 1959 has acquired a strong degree of distinctiveness as a mark owned by the Opposer.

The Opposer's VALENTINO marks have been and are continuously being used, promoted and advertised for a considerable duration of time and over wide geographical areas. Opposer's mark is a well-known registered mark and is the subject of pending applications with earlier filing and registration dates, and being on commercial sale both locally and abroad.

Opposer has invested tremendous amount of resources in the promotion of its VALENTINO marks, i.e., advertisements in well-known newspapers, magazines and other publications around the world. There is already a high degree of distinction as regards petitioner's VALENTINO marks. The goods carried under the said VALENTINO marks had, through the years, earned international acclaim, as well as the distinct reputation of being high quality goods.

x x x

"3. Use by respondent of its VALENTINO trademark for its pornographic magazine after Opposer's mark has become well-known will defame not only Opposer's mark VALENTINO but also the reputation of Opposer and its founder, Valentino Garavani.

The use of Respondent of the mark VALENTINO for pornographic materials some forty years after Opposer's mark has become well-known

would disparage or bring into contempt or disrepute the goodwill that the name VALENTINO has created.

It is the resultant goodwill and popularity of petitioner's VALENTINO marks that Respondent wishes to exploit and capitalize. Copies of Respondent's magazine are attached herewith as exhibits. As these exhibits will prove, any use, sale and distribution by Respondent of its goods bearing the VALENTINO trademark will tarnish, disparage and dilute the distinctiveness of Opposer's trademark VALENTINO.


"4. The word VALENTINO is the dominant part of Opposer's tradename, VALENTINO S.P.A., which is protected even without registration.

The right of Opposer to the VALENTINO marks is well protected under Section 165 of R.A. 8293 which provides:

x x x"

The Opposer's evidence consists of the following:

1. Exhibit "A" - Certified copy of Certificate of Registration No. 4-1997-124857 for the trademark VALENTINO & V (LOGO) registered on 1 July 2004;
2. Exhibit "B" - Certified copy of Certificate of Registration No. 4-1997-124857 for the trademark VALENTINO & V (LOGO) registered on 1 July 2004;
3. Exhibit "C" - Certified copy of Certificate of Registration No. 53234 for the trademark V (LOGO) registered on 7 August 1992;
4. Exhibits "D" and "D-1" - Brochures showing the mark VALENTINO;
5. Exhibits "E" and "E-1" - Sample labels for the mark VALENTINO;
6. Exhibits "G" and "G-1" - Magazines of Respondent-Applicant bearing VALENTINO mark;
7. Exhibit "F" - Affidavit of Antonella Andrioli, Proxy Holder and authorized representative of Valentino S,P.A.

A Notice to Answer was issued and served upon the Respondent-Applicant on 15 October 2007 which, however, was returned to this Bureau for reason that Respondent-Applicant has already moved out of the given address. Thus, an Alias Notice to Answer was subsequently issued through private courier on 09 September 2008. The Respondent-Applicant however, did not file 

an Answer. Thus, pursuant to Rule 2, Section 11⁴ of the Regulations on Inter Partes Proceedings, as amended, this case is now deemed submitted for decision on the basis of the opposition, affidavit of witness and documentary evidence submitted by the Opposer.

Should the Respondent-Applicant be allowed to register the trademark VALENTINO & DEVICE?

The essence of trademark registration is to give protection to the owners of trademarks. The function of a trademark is to point out distinctly the origin or ownership of the goods to which it is affixed; to secure to him who has been instrumental in bringing into the market a superior article of merchandise, the fruit of his industry and skill; to assure the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product.⁵ Thus, Sec. 123.1 (d) of the Intellectual Property Code ("IP Code") provides that a mark cannot be registered if it:

(d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:

- (i) the same goods or services, or
- (ii) closely related goods or services, or
- (iii) if it nearly resembles such a mark as to be likely to deceive or cause confusion;

Records and evidence show that at the time the Respondent-Applicant filed its trademark application, the Opposer already has an existing trademark registrations for VALENTINO & V (LOGO) issued as early as 01 July 2004 and 17 January 2005 for goods falling under classes 9 and 3, respectively. The questions now are: Are the marks identical and used on the same or closely related goods or services? Or, do they resemble each other that deception or confusion is likely to occur?

In determining whether two (2) or more marks are confusingly similar, the law does not require actual confusion, it being sufficient that confusion is likely to occur.⁶

The competing marks are reproduced below for comparison:

⁴ Sec. 11 *Effect of failure to file Answer* – In case the respondent fails to file an answer, or if the answer is filed out of time, the case shall be decided on the basis of the petition or opposition, the affidavits of the witnesses and the documentary evidence submitted by the petitioner or opposer.

⁵ *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 November 1999.

⁶ *Philips Export B. V., et. al. v. Court of Appeals, et. al.*, G. R. No. 96161, 21 February 1992.



Opposer's mark



Respondent-Applicant's mark

Obviously, the contending marks are identical. The fact that the Respondent-Applicant's mark is presented, stylized and printed differently is inconsequential considering that it copied the dominant word VALENTINO and the V logo or design of the Opposer. Thus, in appearance and pronunciation, the likelihood of confusion is very likely.

This Bureau noted that the goods covered by the Opposer's registrations include "optical apparatus and instruments, namely, eyewear, spectacles, sunglasses, spectacle, frames, spectacle lenses" under class 9 and "perfumes" under class 3. The Respondent-Applicant's, on the other hand, covers "magazine" under class 16. While the Opposer's goods are not identical with the Respondent-Applicant's magazine, these goods, nonetheless, are related in the sense that Opposer utilizes fashion advertising including printed materials such as magazines and brochures to promote its optical instruments and perfumes. Hence, confusion is likely when Opposer's goods are promoted using these advertising magazines and materials. It is very likely that the Opposer's goods and Respondent-Applicant's magazines, being fashion-related, have common purchasers and marketed similarly.

Moreover, the Opposer is entitled to protection when the use of identical or similar mark by the Respondent-Applicant will forestall the normal potential expansion of business. Evidently, the Opposer has a variety of products included in its brochures carrying the mark VALENTINO & V (LOGO), such that the possibility for the Opposer to produce its own fashion magazine carrying its marks is very likely.

In the case of *Sta. Ana v. Maliwat, et. al.*⁷, the Supreme Court ruled that:

"Modern law recognizes that the protection to which the owner of a trademark is entitled is not limited to guarding his goods or business from actual market competition with identical or similar products of the parties, but extends to all cases in which the use by a junior appropriator of a trademark or tradename is likely to lead to a confusion of source, as where prospective purchasers would be misled into thinking that the complaining party has extended his business into the field or is in any way connected with the activities of the infringer or when it forestalls the normal potential expansion of his business."

⁷ G. R. No. L-23023, 31 August 1968.

Aptly, this Bureau noted that there is evident bad faith on the part of the Respondent-Applicant in seeking the registration of the mark VALENTINO & DEVICE. The assumption that Respondent-Applicant coined the mark by mere coincidence is dubious since it was given the opportunity to explain how it adopted the mark that is similar with the Opposer but it chose otherwise.

The Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) of the IP Code, and therefore, should not be allowed.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application No. 4-2006-006219, together with a copy of this Decision, be returned to the Bureau of Trademarks for appropriate action.

SO ORDERED.

Taguig City, 27 March 2012.


NATHANIEL S. AREVALO
Director IV
Bureau of Legal Affairs 