



GADO S.r. I.,
Petitioner,

-versus-

DUFFER OF ST. GEORGE LIMITED,
Respondent-Registrant.

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}
} IPC No. 14-2011-00554
} Cancellation of:
} Reg. No. 4-2010-002998
} Date Issued: 20 March 2011
} TM: "DUFFER SHIELD DEVICE"

NOTICE OF DECISION

**ORTEGA DEL CASTILLO BACORRO
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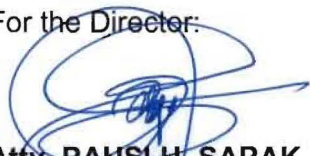
**SYCIP SALAZAR HERNANDEZ AND
GATMAITAN LAW OFFICES**
Counsel for the Respondent-Registrant
SSHG Law Center
105 Paseo de Roxas, Makati City

GREETINGS:

Please be informed that Decision No. 2013 - 158 dated August 01, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, August 01, 2013.

For the Director:


Atty. PAUSI U. SAPAK
Hearing Officer
Bureau of Legal Affairs



GADO S. r. l.,
Petitioner,

IPC No. 14-2011-00554
Case Filed: 09 December 2011

-versus-

Cancellation of:
Reg. No. 4-2010-002998
Date Issued: 20 March 2011

DUFFER OF ST. GEORGE
LIMITED,
Registrant.

Title: "DUFFER SHIELD DEVICE"

x-----x

Decision No. 2013- 158

DECISION

GADO S.r.l. ("Petitioner")¹ filed on 09 December 2011 a Petition to Cancel Trademark Reg. No. 4-2010-002998. The registration, issued on 20 March 2011 to DUFFER of ST. GEORGE LIMITED ("Respondent-Registrant")², covers the mark "DUFFER SHIELD DEVICE" for use on "clothing, footwear, headgear, belt" under Class 25 of the International Classification of Goods³.

The Petitioner alleges among other things that a mark is precluded from registration if it is confusingly similar to a registered trademark belonging to another party under Sec. 123.1 (d) of R.A. No. 8293 otherwise known as the Intellectual Property Code of the Philippines ("IP Code"). According to the Petitioner, the mark DUFFER SHIELD DEVICE nearly resembles the registered trademark D & G of the Petitioner as to be likely to deceive or to cause confusion. The Petitioner points out that the DUFFER SHIELD DEVICE prominently features the upper case letters "D" and "G", similar to the Petitioner's D & G trademarks.

To support its Petition, the Petitioner submitted the following:

1. Exhibit "A" – Affidavit of Cristiana Ruella;
2. Exhibit "A-1" – Copy of Notarial Declaration;
3. Exhibit "A-2" – Print out from the trademark database of IPO of Certificate of Reg. No. 4-2009-003520 for the mark D & G;
4. Exhibits "A-3" – Copy of Assignment of Application for Registration of trademark Dolce & Gabbana;
5. Exhibits "A-4", "A-4-a", "A-4-b", "A-4-c", "A-4-d" and "A-4-f", "A-4-q", "A-4-h", and "A-4-1" – Copy of print outs, downloaded from the trademark database of the IPO

¹ A corporation organized under and by virtue of the laws of Italy, with principal place of business at Via Goldone, 10-20129 Milano, Italy.

² With address at Hollinsbook Way Pilsworth, Bury Lancashire, BL9 8RR, United Kingdom.

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

- of each of the registrations submitted for recording of Assignments for the mark D & G and variations;
6. Exhibit "A-5" – A list of Registrations and pending applications worldwide for the mark D & G, Dolce Gabbana;
 7. Exhibit "A-6" – Certified copy of Italian Trademark Registration No. 620372 for the mark D & G, Dolce & Gabbana;
 8. Exhibits "A-7" – Copy of Certificate of Reg. No. 4-1998-004094 issued by the IPO for the mark D & G Dolce & Gabbana;
 9. Exhibits "A-7-b" – Copy of Certificate of Reg. No. 4-2000-002360 issued by the IPO for the mark D & G Dolce Gabbana;
 10. Exhibit "A-7-c" – Copy of Certificate of Reg. No. 4-2006-003129 issued by the IPO for the mark DOLCE & GABBANA THE ONE;
 11. Exhibit "A-7-d" – Copy of Certificate of Reg. No. 4-2996-107428 issued by the IPO for the mark J & ANS DOLCE & GABBANA;
 12. Exhibits "A-8" to "A-8-a" – Print out from the Dolce & Gabbana web page, www.dolce&gabbana.com;
 13. Exhibit "A-9" – A list of international awards conferred to Dolce & Gabbana;
 14. Exhibits "A-10" to "A-10-a" – Copies of the ranking/related articles placing Dolce & Gabbana as the 5th among the top influential names in the fashion business; and
 15. Exhibits "B", "B-1" – Certified copies of the Exhibits which form part of the record of IPC No. 14-2009-00156 entitled GADO S.A.R.L. vs. Stealthatlook, Inc., consisting in various certificates of trademark registrations for Dolce & Gabbana and variant trademarks.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Registrant on 13 January 2012. However, the Respondent-Applicant did not file an Answer, hence Order No. 2012-933 dated 10 July 2012 was issued declaring Respondent-Registrant in default and the instant cancellation is deemed submitted for Decision based on the petition and evidence submitted by the Petitioner.

Should Trademark Reg. No. 4-2010-002998 be cancelled?

Sec. 151.1, par. (b) of the IP Code provides:

A petition to cancel a registration of a mark under this Act may be filed with the Bureau of Legal Affairs by any person who believes that he is or will be damaged by the registration of a mark under this Act as follows:

xxx(b) Any time, if the registered mark xxx or its registration was obtained **fraudulently or contrary to the provisions of this Act**, or if the registered mark is being used by, or with the permission of, the registrant so as to, **misrepresent the source** of the goods or services on or in connection with which the mark is used.

Petitioner established that it is the successor-in-interest of Messrs. Domenico Dolce and Stefano Gabbana, the originators, first users and adopters of the trademarks D & G and D & G Dolce & Gabbana. In the Philippines, the Petitioner holds registration for the trademark D & G for various goods in Classes 3, 9, 14, 18 and 25 (Reg. No. 4-2009-003520, issued on 25 August 2010). The Petitioner is also the registrant and/or the assignee of the following trademark registrations:

1. D & G Dolce & Gabbana Reg. No. 4-1996-105083 issued on 25 December 2005 under Class 25;
2. D & G Dolce & Gabbana Reg. No. 4-1996-107429 issued on 21 June 2000 under Class 18; and
3. D & G Dolce & Gabbana Reg. No. 4-1998-004094 issued on 18 January 2004 under Classes 3 & 9.

Clearly, the Petitioner's trademark registrations preceded the Respondent-Registrant's.

But, are the competing marks, as shown below, resemble each other such that confusion, or even deception, is likely to occur?



Petitioner's Mark



Respondent-Registrant's Mark

The prominent features of the mark registered by the Respondent-Registrant are the letters D & G. The letters "D" and "G" are exactly the same features that comprise the Petitioner's mark. The shield device only compliments or serves as accessory to the letters D & G. The combination of the letters D and G defines the subject trademarks. The letters alone give the marks distinctive property. On the other hand, the shield without the letters D and G are innocuous and only serves ornamental purpose.

In this regard, the conclusion created by use of the same word as the primary element in a trademark is not counteracted by the addition of another term⁴, and by analogy, by a device.

The Petitioner's marks are used on ladies, gents and children's clothing in general under Class 25. Considering therefore that the Respondent-Registrant's mark is also used on clothing, footwear, headgear, belts under Class 25. Succinctly, because the Petitioner's mark and the mark registered by the Respondent-Registrant are identical and used on similar and closely related goods, it is likely that the consumers will have the impression that these goods or products originate from a single source or origin. The confusion or mistake would subsist not only on the purchaser's perception of the goods but on the origin thereof as held by the Supreme Court, to wit:⁵

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Here, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

⁴ Continental Corp., v. Continental Specialties Corp. 207 USPQ 60.

⁵ Converse Rubber Corporation v. Universal Products Inc., et.al. G.R. No. L-27906, 08 January 1987.

The public interest, therefore, requires that the two marks should not be allowed to co-exist. Confusion, mistake, deception and fraud, should be prevented. It is emphasized that 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 product⁶.

Sec. 123.1 (d) of the IP Code provides:

- (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.

The registration of the mark DUFFER SHIELD DEVICE in the name of Respondent-Registrant's violate the aforequoted provision.

WHEREFORE, premises considered, the instant Petition for Cancellation is hereby **GRANTED**. Let the filewrapper of Trademark Registration No. 4-2010-002998 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 01 August 2013.


ATTY. NATHANIEL S. AREVALO
Director IV
Bureau of Legal Affairs

/joanne

⁶ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 November 1999.