



GARAGE INTERNATIONAL
LUX SARL,
Opposer,

-versus-

MIRANI RISHI,
Respondent-Applicant.

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}
} IPC No. 14-2011-00489
} Opposition to:
} Appln. Serial No. 4-2011-005828
} Filing Date: May 20, 2011
} Trademark: "GARAGE"
}
}
}
}

NOTICE OF DECISION

VERALAW
(DEL ROSARIO BAGAMASBAD AND RABOCA)
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Rosadel Building
1011 Metropolitan Avenue
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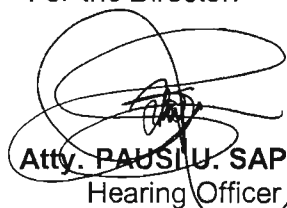
RISHI MIRANI
Respondent-Applicant
Kampri Bldg., 2254 Don Chino Roces Avenue
Makati City

GREETINGS:

Please be informed that Decision No. 2012 – 158 dated August 28, 2012 (copy enclosed) was promulgated in the above entitled case.

Taguig City, August 28, 2012.

For the Director:


Atty. PAUSIU. SAPAK
Hearing Officer
Bureau of Legal Affairs

CERTIFIED TRUE COPY



GARAGE INTERNATIONAL
LUX SARL, *Opposer,*

IPC No. 14-2011-00489
Opposition to:

- versus -

TM Appln. Serial No. 4-2011-005828
(Filing Date: 20 May 2011)
TM: "GARAGE"

RISHI MIRANI,
Respondent-Applicant.

x-----x

Decision No. 2012- 158

DECISION

GARAGE INTERNATIONAL LUX SARL ("Opposer")¹ filed on 27 December 2011 an opposition to Trademark Application Serial No. 14-2011-005828. The application, filed by RISHI MIRANI ("Respondent-Applicant")² covers the mark "GARAGE" for use on *"soaps for body and face, hair lotions, cosmetics products, namely: cosmetics preparation for the bath, bath salts, bath gels, cotton sticks for cosmetics purposes, skin whitening creams and powders, foundation preparations, hair colorants, hairdressing products, cosmetics preparation for eyelashes, adhesives for false eyelashes, decorative transfers for cosmetics purposes, cosmetics pencils, cosmetic creams, paper guides for eye make-up, blush, essential oils for personal use, milk for cosmetic purposes, nail varnishes, lotions for cosmetic purposes, make-up preparations, beauty masks, cosmetic kits, nail care preparation, false nails, cotton wool for cosmetic purposes, perfumery, namely: perfumes, toilet oil, scented water, eau de cologne, pomades for cosmetic purposes, make-up powder, lipsticks, cosmetic preparations for skin care, eyebrow cosmetics, eyebrow pencils, cosmetic dyes, toilet water oils for toilet purposes, toiletries, varnish-removing preparations, make-up brushes and make-up kit"* under Class 03; *"sun-glasses, frames"* under Class 09; *"jewelry, watches"* under Class 14; *"purses, wallets, handbags"* under Class 18; and *"clothing, namely: shirts, T-shirts, dresses, skirts, trousers, coats, sweater, jackets, vests, dressing gowns, shorts, swimsuits, overcoats, rainwear underwear, pants, underpants, caps, pajamas, stockings, windproof clothing, briefs, jogging suits, belts, neckties, gloves, shoes, boots, sandals, women shoes, sneakers, overshoes, clogs, tongs, belts"* under Class 25, of the International Classification of goods.³

The Opposer alleges, among other things, that the registration of the mark GARAGE in the name of the Respondent-Applicant is proscribed under Rep. Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). According to the Opposer, the registration of the said mark is likely to mislead the public

¹ A corporation duly organized and existing under and by virtue of the laws of Luxembourg, with its principal office at 1 Allee Scheffer, Suite 2.05.01, in Luxembourg, L-2520 Luxembourg, and a subsidiary of GROUP Dynamite Inc. and related to GARAGE INTERNATIONAL SARL.

² With address at Kampri Building, 2254 Don Chino Roces Avenue, Makati City.

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.

that the Respondent-Applicant's business is affiliated with or is under the sponsorship of the Opposer. The Opposer also claims that the term GARAGE is a trade name of the Opposer which must be protected.

In support of its opposition, the Opposer submitted the Special Power of Attorney it issued to its counsel of record, the Verification and certification of non-forum shopping, the Affidavit-Direct Testimony of Anna Martini, FCA and the annexes thereto:

1. schedule of worldwide applications and registrations for the mark GARAGE;
2. trademark registrations in Canada (TMA No. 678,226, TMA No. 733,573, TMA No. 678,227, TMA No. 737,318), Lebanon (Reg. No. 116738), and the United States of America (Reg. Nos. 3,573,958; 3,538,639; 3,909,384; and 3,819,823);
3. certified true copies of the filing notices for the GARAGE mark in China and European Union;
4. copies of Certificate of Registrations, filing, notices or publication in Azerbaijan, Bahrain, Bangladesh, Chile, Costa Rica, Dominican Republic, Egypt, Georgia, India, Indonesia, Jordan, Kazakhstan, Kuwait, Malaysia, Morocco, Panama, Qatar, Russia, Saudi Arabia, Singapore, Turkey, United Arab Emirates, Venezuela, and Yemen;

and a print-out from the Philippine Trademarks database on the details of the application for the GARAGE mark in the Philippines filed by the Opposer.⁴

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant 18 January 2012. The Respondent-Applicant, however, did not file an Answer.

Should the Respondent-Applicant's trademark application be allowed?

The mark applied for registration by the Respondent-Applicant is identical to the Opposer's, as shown below:

GARAGE

Opposer's mark

GARAGE

Respondent-Applicant's mark

The Opposer also has a pending application for the registration of the mark covering "*perfumery, essential oils, cosmetics*" under Class 03, "*handbags, knapsacks*" under Class 18, "*clothing, footwear, headgear*" under Class 25, and "*retail store services*" under Class

⁴ Marked as Exh. "A" to "C", inclusive.

35. These goods are dealt in by the Opposer and indicated in its trademark applications and registrations in many countries.

Hence, because the goods indicated in the Respondent-Applicants' trademark application are similar and/or closely related to the goods dealt in by the Opposer bearing the mark GARAGE, 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 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.

The public interest, therefore, requires that the two marks, identical to or closely resembling each other and used on the same and closely related goods, but utilized by different proprietors should not be allowed to co-exist. Confusion, mistake, deception, and even 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.

The Respondent-Applicant's filing of his trademark application on 20 May 2011 preceded the Opposer's (13 October 2011). However, the essence of the opposition to the Respondent-Applicant's trademark application is the issue of ownership of the contested mark. In this regard, it is not the application or the registration that confers ownership of a mark, but it is the ownership of the mark that confers the right to registration. While the country's legal regime on trademarks shifted to a registration system, it is not the intention of the legislators not to recognize the preservation of existing rights of trademark owners at the time the IP Code took into effect.⁷ The registration system is not to be used in committing or perpetrating an unjust and unfair claim. A trademark is an industrial property and the owner thereof has property rights over it. The privilege of being issued a registration for its exclusive use, therefore, should be based on the concept of ownership. The IP Code implements the TRIPS Agreement and therefore, the idea of "registered owner" does not mean that ownership is established by mere registration but that registration establishes merely a presumptive right of ownership. That presumption of ownership yields to superior evidence of actual and real ownership of the trademark

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

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

7 See Sec. 236 of the IP Code.

and to the TRIPS Agreement requirement that no existing prior rights shall be prejudiced. In *Berris v. Norvy Abyadang*⁸, the Supreme Court held:

The ownership of a trademark is acquired by its registration and its actual use by the manufacturer or distributor of the goods made available to the purchasing public. Section 122 of R.A. No. 8293 provides that the rights in a mark shall be acquired by means of its valid registration with the IPO. A certificate of registration of a mark, once issued, constitutes *prima facie* evidence of the validity of the registration, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate. R.A. No. 8293, however, requires the applicant for registration or the registrant to file a declaration of actual use (DAU) of the mark, with evidence to that effect, within three (3) years from the filing of the application for registration; otherwise, the application shall be refused or the mark shall be removed from the register. In other words, the *prima facie* presumption brought about by the registration of a mark may be challenged and overcome, in an appropriate action, by proof of the nullity of the registration or of non-use of the mark, except when excused. Moreover, the presumption may likewise be defeated by evidence of prior use by another person, *i.e.*, it will controvert a claim of legal appropriation or of ownership based on registration by a subsequent user. This is because a trademark is a creation of use and belongs to one who first used it in trade or commerce.

Records show that long before the Respondent-Applicant filed his trademark application, the Opposer coined, appropriated, used, dealt in, and registered and/or applied for registration, the mark GARAGE in many countries. The Opposer thus has shown that it is the originator and owner of the mark for goods falling under Classes 03, 18, 25 and 35.

GARAGE is a unique and highly distinctive mark, for goods under Classes 03, 09, 14, 18, 25 and 35. It is an arbitrary mark. It is inconceivable therefore for the Respondent-Applicant to have come up with exactly the same mark without having been inspired or motivated by an intention to imitate the Opposer's mark. It is highly improbable for another person to come up with an identical or nearly identical mark, for use on the same or closely related goods purely by coincidence. The field from which a person may select a trademark is practically unlimited. As in all cases of colorable imitation, the unanswered riddle in why, of the millions of terms and combination of letters that are available, the Respondent-Applicant had come up with a mark identical or so closely similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark⁹.

Furthermore, the word "GARAGE" is the pre-eminent part of the Opposer's trade name. Sec. 165.2, pars. (a) and (b) of the IP Code therefore apply, to wit:

165.2. (a) Notwithstanding any laws or regulations providing for any obligation to register trade names, such names shall be protected, even prior to or without registration, against any unlawful act committed by third parties.

(b) In particular, any subsequent use of the trade name by a third party, whether as a trade name or a mark or collective mark, or any such use of a similar tradename or mark, likely to

⁸ G.R. No. 183404, 13 Oct. 2010.

⁹ See *American Wire and Cable Co. v. Director of Patents et.al.*, SCRA 544 G.R. No. L-26557, 18 Feb. 1970.

mislead the public shall be deemed unlawful.

WHEREFORE, premises considered, the instant opposition is hereby SUSTAINED. Let the filewrapper of Trademark Application Serial No. 4-2011-005828 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 24 August 2012.



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

