



GUCCIO GUCCI, S.P.A.,
Opposer,

-versus-

TEAMWARE SDN BHD,
Respondent-Applicant.

}
} IPC No. 14-2013-00214
} Opposition to:
} Appln No. 4-2012-009721
} Date Filed: 09 August 2012
} TM: "ST GUCHI"

X-----X

NOTICE OF DECISION

CARAG JAMORA SOMERA & VILLAREAL LAW OFFICES
Counsel for the Opposer
2nd Floor, The Plaza Royale
120 L.P. Leviste Street, Salcedo Village
Makati City

LAGUNA LAKE TRADEMARKS
Respondent-Applicant's Representative
P.O Box 121 College Post Office UPLB
Los Banos, Laguna 4031

GREETINGS:

Please be informed that Decision No. 2015 - 06 dated January 21, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, January 21, 2015.

For the Director:

edwin a. dating
Atty. **EDWIN DANILO A. DATING**
Director III
Bureau of Legal Affairs



GUCCIO GUCCI, S.P.A.,

Opposer,

-versus-

TEAMWARE SDN BHD,

Respondent-Applicant.

X ----- x

IPC No. 14-2013-00214

Opposition to Trademark

Application No. 4-2012-009721

Date Filed: 09 August 2012

Trademark: **"ST GUCHI"**

Decision No. 2015- 06

DECISION

Guccio Gucci, S.p.A.¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-009721. The contested application, filed by Teamware SDN BHD² ("Respondent-Applicant"), covers the mark "ST GUCHI" for use on *metal door handles; door lever furniture of metal; lock bolt, lock casings of metal, lock nuts of metal, lock parts of metal, locking apparatus (non-electric) of metal, locking pins of metal, mechanisms of metal (non-electric) for locking door, tumblers of metal (parts of locks), striking plates of metal for locks; profiles of metal; locks (other than electric) of metal, padlocks, mechanical combination of locks (non-electric), mechanical locks (non-electric, metal); bots (door-) of metal, door catches of metal, door closers (non-electric), door fittings of metal, door friction stays of metal, door guards of metal, door handles of metal, door hinges of metal, door holders of metal, door knobs of common metal, door knockers, door lever furniture of metal, door openers (non-electric, door springs (non-electric), door stops of metal; locking gate hasps of metal; hasps of metal; metal fittings for hangings; small items of metal hardware" and "card operated electronic locks, central door locking apparatus, electric locks, electronic locks, electronic door locks, lock (electric) with alarms, safety locking device (electric)" under Classes 06 and 09, respectively, of the International Classification of Goods³.*

Opposer anchors its opposition on Section 123.1 subparagraphs (d) and (e) of R.A. No. 293, also known as the Intellectual Property Code ("IP Code"). It maintains that it is the owner of the numerous registrations and/or applications for registration of its trademark "GUCCI". It asserts that the Respondent-Applicant's mark so resembles its own, particularly the "GUCCI" word marks, as to be likely to deceive or cause confusion, especially since the pronunciation of "GUCCI" is exactly the same with "GUCHI". Among others, it claims that by virtue of its prior and continued use

¹ A company organized by virtue of and under the laws of Italy, United States, with registered office address at Via Tornabuoni 73/R 50123, Firenze (Florence), Italy.

² A Malaysian corporation with given address at Lot PT 355, Jalan, TPP 5/1, Taman Perindustrian Puchong, Section 5 47100 Puchong, Selangor, Malaysia.

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 its mark in many countries, "GUCCI" has become popular and internationally well-known, including here in the Philippines. It contends that its mark has established valuable goodwill with the purchasing public, which have identified it as the owner and source of goods and/products bearing the mark "GUCCI".

In support to its Opposition, the Opposer submitted the following as evidence:

1. certified true copy of Certificate of Registration No. 54871;
2. certified true copy of Certificate of Renewal of Registration No. 36138;
3. certified true copy of Certificate of Renewal of Registration No. 030750;
4. certified true copy of Certificate of Registration No. 4-1999-000053;
5. certified true copy of Certificate of Registration No. 4-2006-011830;
6. certified true copy of Certificate of Registration No. 4-2011-014293;
7. certified true copy of Certificate of Registration No. 4-2011-014799;
8. affidavit of Vanni Volpi;
9. certificates of authentication;
10. certificates of registration of "GUCCI" issued by different countries;
11. legalized copies of representative advertising/promotional materials; and
12. certified copies of a Decision in English and Chinese rendered by the High People's Court of Beijing Municipality, The People's Republic of China.⁴

For its part, the Respondent-Applicant, through R. Garcia Boldyrev, manifested that it does not wish to defend against the instant opposition. On 18 December 2013, the Hearing Officer issued Order No. 2013-1681 declaring the Respondent-Applicant in default and the case deemed submitted for decision.

The issue to be resolved is whether or not the Respondent-Applicant's mark "ST. GUCHI" should be allowed registration.

As culled from the records and evidence, the Opposer has valid and existing registrations for its mark "GUCCI" and its variations, including Certificate of Registration 36138 issued as early as 14 November 1986 and timely renewed on 14 November 2006. On the other hand, Respondent-Applicant filed its application only on 09 August 2012.

But are the competing marks, as shown below, confusingly similar?

⁴ Marked as Exhibits "A" to "U".

GUCCI

Opposer's mark



Respondent-Applicant's mark

A practical approach to the problem of similarity or dissimilarity is to go into the *whole* of the two trademarks pictured in their manner of display. Inspection should be undertaken from the viewpoint of a prospective buyer. The trademark complained of should be compared and contrasted with the purchaser's memory (not in juxtaposition) of the trademark said to be infringed. Some such factors as "sound; appearance; form, style, shape, size or format; color; ideas connoted by marks; the meaning, spelling, and pronunciation, of words used; and the setting in which the words appear" may be considered.⁵ Thus, confusion is likely between marks only if their over-all presentation, as to sound, appearance, or meaning, would make it possible for the consumers to believe that the goods or products, to which the marks are attached, emanate from the same source or are connected or associated with each other.

The eyes can easily see that the marks are different. The similarity between the marks manifests in that "GUCHI" when pronounced sounds like "GUCCI". Such resemblance, however, is not sufficient to conclude that confusion is likely to occur. The consumers can easily distinguish the two marks.

Confusion or mistake, much less deception, is unlikely in this instance because the goods covered by Opposer's trademark registration are far different from that of the Respondent-Applicant's. The Opposer's brand covers fashion, footwear, optical, fragrance, accessories, home and lifestyle products while the Respondent-Applicant's goods consist mainly of doors, locks and similar apparatuses. The parties' respective goods neither flow in the same channels of trade nor target the same market as to result to any confusion. A consumer could easily discern that there is no connection between the two. Therefore, it is doubtful that a purchaser of that would encounter a door or lock bearing "ST GUCHI" would be reminded of Opposer's luxury "GUCCI" products.

Corollarily, the enunciation of the Supreme Court in the case of **Mighty Corporation vs. E. & J. Gallo Winery**⁶ aptly states that:

⁵ Etepha A.G. vs. Director of Patents, G.R. No. L-20635, 31 March 1966.

⁶ G.R. No.154342, 14 July 2004.

"A very important circumstance though is whether there exists likelihood that an appreciable number of ordinarily prudent purchasers will be misled, or simply confused, as to the source of the goods in question. The 'purchaser' is not the 'completely unwary consumer' but is the 'ordinarily intelligent buyer' considering the type of product involved. He is 'accustomed to buy, and therefore to some extent familiar with, the goods in question. The test of fraudulent simulation is to be found in the likelihood of the deception of some persons in some measure acquainted with an established design and desirous of purchasing the commodity with which that design has been associated. The test is not found in the deception, or the possibility of deception, of the person who knows nothing about the design which has been counterfeited, and who must be indifferent between that and the other. The simulation, in order to be objectionable, must be such as appears likely to mislead the ordinary intelligent buyer who has a need to supply and is familiar with the article that he seeks to purchase."

Finally, it is emphasized that 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.⁷ This Bureau finds that the Respondent-Applicant's mark meets this function.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2012-009721 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 21 January 2015.


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

⁷ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.