

UNION HARBOUR LIMITED,
Opposer,

-versus-

RISHI MIRANI,
Respondent-Applicant.

X-----X

} **IPC No. 14-2011-00120**
} Opposition to:
} Appln. Serial No. 4-2010-001848
} Date filed: 18 February 2010
} **TM: "GEORGE GINA**
} **& LUCY"**

NOTICE OF DECISION

HECHANOVA BUGAY & VILCHEZ
Counsel for the Opposer
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Makati City

RISHI MIRANI
Respondent-Applicant
KAMPR Bldg.,
2254 Don Chino Roces Avenue
Makati City

GREETINGS:

Please be informed that Decision No. 2015 - 290 dated December 23, 2015 (copy enclosed) was promulgated in the above entitled case.

Taguig City, December 23, 2015.

For the Director:

Edwin O. Dating
Atty. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affa

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 Application No. 4-2010-001848
 Date Filed: 18 February 2010
 Trademark: "GEORGE GINA
 & LUCY"
 Decision No. 2015- 290

DECISION

UNION HARBOUR LIMITED¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2010-001848. The application, filed by Rishi Mirani² ("Respondent-Applicant"), covers the mark "GEORGE GINA & LUCY" for use on "sunglasses" under Class 09, "jewelry, watches" under Class 14, "purses, wallets, belt, handbags" under Class 18, "lingerie, scarves, hats, accessories for children & accessories for men namely: raincoats, caps, visor, headband, socks, shoes, slippers, sneakers, gloves, nectie, suspender, swimwear, cardigan, sandals and belts not made of leatherr" under Class 25 and "hair accessories" under Class 26 of the International Classification of Goods and Services.³

The Opposer alleges:

x x x

"8. The registration of the mark GEORGE GINA & LUCY in the name of the Respondent-Applicant will violate and contravene the provisions of Sections 123.1 (e), (f) and (g) of the IP Code, as amended, because said mark is confusingly similar to Opposer's own internationally well-known GEORGE GINA & LUCY trademarks as to be likely to cause confusion or mistake, or deceive the purchasers thereof as to the origin of the goods.

"9. The registration of the mark GEORGE GINA & LUCY in the name of Respondent-Applicant will cause grave and irreparable injury and damage to the Opposer for which reason it opposes said application based on the grounds set forth hereunder:

"10. Opposer is the owner of the GEORGE GINA & LUCY trademarks, among others, which has been registered in various countries worldwide. Representations of Opposer's GEORGE GINA & LUCY trademarks are replicated below for this Honorable Office's reference:

¹A foreign corporation organized and existing under the laws of Hong Kong, with principal office address at 26/F- Unit 2602- The Center, 99 Queen's Road Central HK- Hong Kong.

²With address on record at Kampiri Bldg., 2254 Don Chino Roces Ave., Makati City, Metro Manila.

³The Nice Classification is a classification of goods and services for the purpose of registering trademark and service marks, based on a 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 Purposes of the Registration of Marks concluded in 1957.

x x x

"11. Opposer was founded in 2005 and is an innovative specialty designer, brand creator and distributor of fashion and lifestyle products. Its brands uniquely combine upbeat urban lifestyle with clear and recognizable designs. These brands are worldwide registered trademarks, successfully sold in over 30 countries worldwide, with a network of more than 2,200 well-selected and ahead-of-the-competition points of sales.

"12. Herewith attached as Exhibits 'B to '74' is a duly notarized Affidavit-Direct Testimony executed by Atty. Chrissie Ann L. Barredo, wherein she provides printouts from the Opposer's corporate website (<http://www.unionharbour.com>), which contains a description of and background on Opposer, among other information. Said website also indicates that one of the fashion brands owned by the Opposer is GEORGE GINA & LUCY, and contains a link to said brand's official website (<http://george-gina-lucy.com>). Printouts from the Opposer's George Gina & Lucy website are also attached to the Affidavit Direct-Testimony executed by Atty. Barredo.

"13. Opposer has caused the application and registration of the GEORGE GINA & LUCY trademark in more than thirty (30) countries all over the world, namely, in:

x x x

"14. As proof of the foregoing, herewith attached as Exhibit 'C' to 'C-124' is the duly authenticated Affidavit-Direct Testimony executed by Nicolas Neuhaus, the owner of the Opposer company. Attached to his Affidavit-Direct Testimony is a list of active registrations and pending applications of the trademark GEORGE GINA & LUCY in the name of Opposer. Also attached to said Affidavit-Direct Testimony are true copies of the aforementioned registrations.

"15. Opposer has also caused the registration of its well-known GEORGE GINA & LUCY trademark with the OHIM (Office of the Harmonization in the Internal Market) as a Community Trademark. As proof of the foregoing, attached to the Affidavit Direct-Testimony executed by Atty. Barredo are printouts containing the application and/or registration details of said mark(s) with the OHIM, as well as with the Intellectual Property Offices of various countries.

"16. Opposer has spent considerable amounts in advertising and in the promotion of its GEORGE GINA & LUCY products. Some samples of advertising and promotional materials of Opposer depicting the aforementioned trademark are attached to the Affidavit -Direct Testimony of Nicolas Neuhaus as Annex C and its sub-markings.

"17. Total worldwide sales of Opposer for products bearing the GEORGE GINA & LUCY trademark and its variations for the last five (5) years are as follows:

x x x

"18. Opposer's total worldwide expenses for the advertising of its products bearing the GEORGE GINA & LUCY trademark and its variants for the last five (5) years are as follows:

x x x

"19. Furthermore, Opposer's GEORGE GINA & LUCY products, particularly its handbags, have become so popular that international celebrities have been



photographed carrying them. Attached to the same Affidavit Direct-Testimony of Atty. Barredo are printouts showing just some of those featured celebrities.

"20. Opposer's GEORGE GINA & LUCY products have also been featured and reviewed in various popular fashion magazines and publications, such as Teen Vogue, Glamour, and Elle. Also forming part of Atty. Barredo's Affidavit-Direct Testimony are printouts of just some of these articles obtained online.

"20. As earlier mentioned, in order to reach more consumers around the world, Opposer maintains official websites for its GEORGE GINA & LUCY products, particularly for its handbags and eyewear, located at <http://george-gina-lucy.com> and <http://www.ggl-eyewear.com>. Said websites contain pictures and descriptions of the various models of Opposer's GEORGE GINA & LUCY bags and eyewear, as well as the locations of the stores that sell GEORGE GINA & LUCY products worldwide, among others. The site also provides a function whereby consumers are able to verify the authenticity of their own GEORGE GINA & LUCY products worldwide, among others. The site also provides a function whereby consumers are able to verify the authenticity of their own GEORGE GINA & LUCY bag by entering the unique serial number found on the same. Attached to the Affidavit-Direct Testimony of Atty. Barredo are printouts from the aforementioned official websites.

"21. A visual comparison between the parties' marks leaves no doubt that Respondent-Applicant's GEORGE GINA & LUCY mark is, in every way, not only confusingly similar but, in fact, IDENTICAL to Opposer's internationally well-known GEORGE GINA & LUCY trademark, for which Opposer has already previously obtained registrations in various countries worldwide.

"22. The confusing similarity between Respondent-Applicant's GEORGE GINA & LUCY and Opposer's well-known GEORGE GINA & LUCY mark is highly likely to deceive the purchasers of goods on which the mark is being used as to the origin or source of said goods and as to the nature, character, quality and characteristics of the goods to which it is affixed. Furthermore, the unauthorized use by others of a trademark similar or identical to Opposer's GEORGE GINA & LUCY trademarks will certainly dilute the distinctiveness of the latter, and adversely affect the function of said trademarks as an indicator of origin, and/or the quality of the product.

"23. The registration of Opposer's well-known GEORGE GINA & LUCY marks in various countries worldwide cover goods under Classes 3, 4, 9, 14, 16, 18, 20, 21, 24, and 25, and 26, such as the following, among others:

x x x

"24. Respondent-Applicant's application for the registration of the mark GEORGE GINA & LUCY also covers goods falling under Class 09, 14, 18, and 25. In fact, these goods are also identical to those covered by Opposer's GEORGE GINA & LUCY marks, as can clearly be seen from a comparison of each parties' respective goods below:

x x x

"25. Opposer's GEORGE GINA & LUCY trademarks are internationally well-known, having met the criteria under Rule 102 of the Rules and Regulations on Trademarks, Service Marks, Tradenames, and Marked or Stamped Containers. According to Section 123.1 (e) and (f) of the IP Code, a mark cannot be registered if it is

identical with, or confusingly similar to a well-known mark, whether or not it is registered here, to wit:

x x x

"26. As internationally well-known marks, Opposer's GEORGE GINA & LUCY marks are further protected under Article 6bis of the Paris Convention, which provides:

x x x

"27. The identicalness of Respondent-Applicant's mark with Opposer's own well-known GEORGE GINA & LUCY trademarks can only lead to the conclusion that Respondent-Applicant intends to ride on the popularity of Opposer, thereby causing Opposer to incur monetary losses, and suffer the dilution of its trademarks.

"28. Opposer will be damaged by the registration of the mark GEORGE GINA & LUCY, considering that Opposer's well-known trademarks have already obtained goodwill and consumer recognition throughout the world. For what other purpose would the Respondent-Applicant choose the exact name 'GEORGE GINA & LUCY', of all possible names and terms, to identify his goods which are undeniably identical or closely related to Opposer's own products? As held by the Supreme Court in American Wire & Cable Co. vs. Director of Patents:

x x x

"29. Thus, Respondent-Applicant's application to register the mark GEORGE GINA & LUCY must be denied, in accordance with Sections 123.1 (e), (f) and (g) of the IP Code, which provide:

x x x

"30. The registration of the mark GEORGE GINA & LUCY in the name of the Respondent-Applicant will violate the exclusive proprietary rights of the Opposer over its own marks and irreparably injure or damage the interest, business reputation and goodwill of said marks.

"31. Clearly, the registration of Respondent-Applicant's mark, which is identical to Opposer's own GEORGE GINA & LUCY trademarks will not only prejudice the Opposer but will also allow the Respondent-Applicant to unfairly benefit from and get a free ride on the goodwill of Opposer's well-known marks.

The Opposer's evidence consists of the Special Power of Attorney issued by the Opposer appointing the law offices of HECHANOVA, BUGAY & VILCHEZ as its Attorneys-in-Fact to file and prosecute to its completion an opposition to trademark application no. 4-2010-001848; the Affidavit-Direct Testimony executed by Atty. Chrissie Ann L. Barredo, Associate of the law firm of HECHANOVA, BUGAY & VILCHEZ; and the Affidavit-Direct Testimony executed by Nicolas Neuhaus, the owner of Opposer company.⁴

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

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant on 05 May 2011. Said Respondent-Applicant, however, did not file an Answer.

Should the Respondent-Applicant be allowed to register the trademark GEORGE GINA & LUCY?

The Opposer anchors its opposition on Sections 123.1, paragraphs (e), (f) and (g) of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"), to wit:

Sec. 123. Registrability. - 123.1. A mark cannot be registered if it:

x x x

- (e) Is identical with, or confusingly similar to, or constitutes a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: *Provided*, That in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;
- (f) Is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or service which are not similar to those with respect to which registration is applied for: *Provided*, That use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark: *Provided* further, That the interests of the owner of the registered mark are likely to be damaged by such use;
- (g) Is likely to mislead the public, particularly as to the nature, quality, characteristics or geographical origin of the goods or services; x x x

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

 **GEORGE
GINA &
LUCY**

Opposer's trademark

GEORGE GINA & LUCY

Respondent-Applicant's mark



The marks are obviously identical and used on similar and/or closely related goods, particularly, accessories, bags and apparel. Thus, it is likely that the consumers will have the impression that these goods originate from a single source or origin. The confusion or mistake would subsist not only on the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinary 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.⁵

Public interest therefore requires, that 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 product.⁶

The Respondent-Applicant's filing of their trademark application in the Philippines may be earlier than the Opposer's, but the latter raises the issues of trademark ownership, fraud and bad faith on the part of the Respondent-Applicant.

In this regard, this Bureau emphasizes that it is not the application or the registration that confers ownership of a mark, but it is ownership of the mark that confers the right of registration. The Philippines implemented the World Trade Organization Agreement "TRIPS Agreement" when the IP Code took into force and effect on 01 January 1998. Art 16(1) of the TRIPS Agreement states:

1. The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of

⁵ Converse Rubber Corp. 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 November 1999, citing *Eihepa v. Director of Patents*, *supra*, *Gabriel v. Perez*, 55 SCRA 406 (1974). See also Article 15, par. (1), Art. 16, par. (1), of the Trade Related Aspects of Intellectual Property (TRIPS Agreement).

which the trademark is registered where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed. The rights described above shall not prejudice any existing prior rights, nor shall they affect the possibility of Members making rights available on the basis of use.

Clearly, it is not the application or the registration that confers ownership of a mark, but it is 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 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 the R.A. 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, 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. 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.

In this instance, the Opposer proved that it is the originator and owner of the contested mark. In contrast, the Respondent-Applicant despite the opportunity given, did not file an Answer to defend their trademark application and to explain how they arrived at using the mark GEORGE GINA & LUCY which is exactly the same as the

⁷ See Sec. 236 of the IP Code.

⁸ G.R. No. 183404, 13 Oct. 2010.

Opposer's. It is incredible for the Respondent-Applicant to have come up with exactly the same mark for use on similar goods by pure coincidence.


Succinctly, the field from which a person may select a trademark is practically unlimited. As in all other cases of colorable imitations, the unanswered riddle is why of the millions of terms and combinations of letters and designs available, the Respondent-Applicant had to 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 mark.⁹

The intellectual property system was established to recognize creativity and give incentives to innovations. Similarly, the trademark registration system seeks to reward entrepreneurs and individuals who through their own innovations were able to distinguish their goods or services by a visible sign that distinctly points out the origin and ownership of such goods or services.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2010-001848 is hereby SUSTAINED. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 23 December 2015.



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

⁹ *American Wire & Cable Company v. Director of Patents*, G.R. No. L-26557, 18 Feb. 1970.