

VALENTINO S.P.A.,  
Opposer,

-versus-

VC CONNECTION SDN BHD,  
Respondent- Applicant.

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}  
} **IPC No. 14-2015-00083**  
} Opposition to:  
} Appln. Serial No. 4-2013-501802  
} Date Filed: 10 July 2013  
} **TM: "V VALENTINO CREATIONS"**  
}  
}  
}

**NOTICE OF DECISION**

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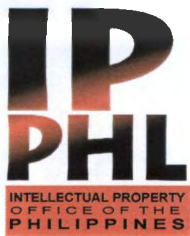
**GREETINGS:**

Please be informed that Decision No. 2016 - 114 dated April 08, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, April 08, 2016.

For the Director:

*Edwin A. Dating*  
**Atty. EDWIN DANILO A. DATING**  
Director III  
Bureau of Legal Affairs



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IPC No. 14-2015-00083

Opposition to:

Application No. 4-2013-501802

Date Filed: 10 July 2013

Trademark: "V VALENTINO CREATIONS"

Decision No. 2016- 114

DECISION

VALENTINO S.P.A.<sup>1</sup> ("Opposer") filed an opposition to Trademark Application Serial No. 4-2013-501802. The application, filed by VC Connection SDN BHD<sup>2</sup> ("Respondent-Applicant"), covers the mark "V VALENTINO CREATIONS" for use on "articles of clothing including jeans, trousers, shirts and t-shirts for men, women and children; as far as included in Class 25 and not in other classes" under Class 25 of the International Classification of Goods and Services.<sup>3</sup>

The Opposer alleges:

x x x

"The grounds for the opposition to the registration of the 'V VALENTINO CREATIONS' trademark are as follows:

"1) Opposer is the first to adopt, use and register worldwide including the Philippines, the 'VALENTINO' trademark and its derivatives (collectively referred to as VALENTINO trademarks) for goods falling under International class 3, 8, 9, 11, 16, 19, 20, 21, 23, 24, 25, 27, 35, 36, and 43 are well-known internationally, 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 (R.A.) No. 8293 the right to exclude others from registering or using identical or confusingly similar marks such as Respondent-Applicant's trademark 'V VALENTINO CREATIONS' for goods falling under international class 25.

"2) There is a likelihood of confusion between Opposer's 'VALENTINO' trademarks and Respondent-Applicant's 'V VALENTINO CREATIONS' mark in terms of appearance, sound, spelling, meaning, and connotation, as to likely, when applied to or used in connection with goods of Respondent-Applicant under class 25, cause confusion, mistake and deception to the purchasing public as being a mark owned by the

<sup>1</sup>A foreign corporation organized under and the laws of Italy, with business address at Via Tureti, 16/18, Milano, Italy.

<sup>2</sup>A foreign corporation organized and existing under the laws of Malaysia with address at No. 9, Jalan PJU 3/48, Sunway Damansara Technology Park, 47810 Petaling Jaya, Selangor, Malaysia.

<sup>3</sup>The 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.

Opposer, hence, the Respondent-Applicant's 'V VALENTINO CREATIONS' cannot be registered in the Philippines pursuant to the express provisions of Section 147 of R.A. 8293.

"3) Respondent-Applicant, by adopting the 'V VALENTINO CREATIONS' mark for its goods under class 25 will indicate a connection between them and those of the Opposer's and is likely to cause confusion, or to cause mistake, or to deceive as to affiliation, connection, or association with the Opposer, or as to origin, sponsorship, supervision, authorization or approval of his products by the Opposer, for which he is liable for false designation of origin, false description or representation under Section 169 of R.A. No, 8293.

"4) The trademark 'VALENTINO' is also the dominant part of Opposer's trade/business name which under Section 164.2 of R.A. 8293 should be protected even prior to or without the obligation of registration.

"5) 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) Opposer is the first to adopt, use and register the 'VALENTINO' marks in the Philippines.

"Opposer is the owner of the 'VALENTINO' trademarks. The 'VALENTINO' marks which herein Opposer originated and adopted in 1959 are well known internationally and have been registered in over ninety (90) countries worldwide. The goods and/or services carried under 'VALENTINO' trademarks have, through the years, earned international acclaim, as well as the district reputation of high quality of goods and services long before the application and registration of Respondent-Applicant's mark.

"In the Philippines, Opposer has registered its 'VALENTINO' trademarks with the Intellectual Property Office, under the following Certificates of Trademark registrations

x x x

"Certified true copies of the applicable Certificates of Registrations are attached herewith as Exhibits 'A', Series.

"Also, Opposer has other pending applications for registration of its 'VALENTINO' trademarks in the Philippines, namely:

x x x

"On the other hand, Respondent-Applicant filed its application for registration only on July 10, 2013 under Application No. 4-2013-501802 for goods under class 25.

"2) The Opposer's 'VALENTINO' trademarks which originated in 1959 have acquire a strong degree of distinctiveness as marks owned by the Opposer.

"The Opposer's 'VALENTINO' trademarks have been and are continuously being used, promoted and advertised for a considerable duration of time and over wide geographical areas worldwide, including the Philippines. Thus, Opposer's 'VALENTINO' trademarks have become well-known internationally.

"Also, Opposer's 'VALENTINO' trademarks have been registered in over ninety (90) countries worldwide. Copies of registration certificates in several jurisdictions,

namely, Benelux, European Union, Germany, Great Britain, Hong Kong, Italy, Singapore, and U.S.A. are hereto as Exhibit 'B', Series (Original copies were attached and submitted in IPC Case No. 14-2010-00048 entitled 'VALENTINO S.P.A. vs. PING AN UNITED RESOURCES LIMITED'. A list showing all the registered 'VALENTINO' trademarks worldwide is herein attached as Exhibit 'B-1' and the details contained therein are verifiable in the internet.

"The goods carried under the said 'VALENTINO' trademarks had, through the years, earned international acclaim, as well as the distinct reputation of being high quality goods. There is already a high degree of distinction as regards Opposer's 'VALENTINO' trademarks.

"Opposer has invested tremendous amount of resources in the promotion of its 'VALENTINO' trademarks, i.e., advertisements in various international magazines, well known newspapers and other publications around the world. In fact, Opposer has invested in total amount of €10,333,212 in Euro Dollars for year 2008 to 2010 only and €12,553,480 in Euro Dollars for 2009 to 2012 for advertisement investments related to class 25 products. Chart of the worldwide advertisements on Valentino's 'Valentino' trademarks in class 25 for year 2008 to 2010 was submitted in IPC Case No. 14-2011-00402 entitled 'VALENTINO S.P.A. vs. AULIA SINGGIH', and shall be offered separately and chart of the worldwide advertisements on Valentino's 'Valentino' trademarks in class 25 for year 2009 to 2012 is attached to the affidavit of Opposer's witness, Antonella Andriolli.

"Further, the products of 'VALENTINO' and the world of 'VALENTINO' have been featured in over 300 international magazine covers worldwide, including Vogue-Company-Harper's & Queen, G.Q. (Gentlemen Quarterly), Bazaar, Men's Bazaar, Hello!, Elle, Bazzar-Gente-La Settimana Incom and the like. Photographs of some wall covers with such magazine covers were submitted in IPC Case No. 14-2010-00048 entitled 'VALENTINO S.P.A. vs. PING AN UNITED RESOURCES LIMITED', and shall be attached separately.

"One evidence of the international fame and celebration of Opposer's 'VALENTINO' trademarks is the book '30 Years of Magic', which contains among others, pictures of models and works of Valentino through the years. An additional testament to the fame of Mr. Valentino Garavani are pages from the book, 'The Who's Who of Mr. Valentino Garavani are pages from the book, 'The Who's Who of the Italian Fashion', which document the first twenty years of fame of 'VALENTINO' from 1959 to 1979 and a brochure entitled 'VALENTINO STORY'. Copies of the books and brochure were submitted in IPC Case No. 14-2010-00048 entitled 'VALENTINO S.P.A. vs. PING AN UNITED RESOURCES LIMITED', and shall be offered separately.

"Opposer and/or its predecessors-in-interest have adopted and continuously used the 'VALENTINO' trademarks worldwide in connection with goods of various classes, including clothing under class 25. Goods carrying 'VALENTINO' trademarks are being sold through VALENTINO S.P.A. boutiques and sales networks worldwide. VALENTINO S.P.A. has more than 200 boutiques and sales networks worldwide. In addition, goods carrying 'VALENTINO' trademarks are being sold through its online boutique: <http://www.valentino.com/>. VALENTINO S.P.A. has more than 200 boutiques and sales networks worldwide. Print-out from the Web site, <http://www.valentino.com/>, depicting sample products bearing the 'VALENTINO'

trademarks are herein attached as Exhibits 'C' S showing the actual use of the 'VALENTINO' trademarks and is verifiable in the internet.

Such use and advertising have resulted in the distinctiveness and goodwill in all parts of the world of the goods bearing the 'VALENTINO' trademarks.

"In the Philippines, goods carrying 'VALENTINO' trademarks are commercially sold nationwide through one brand corporations such as Adora Retail Philippines Inc. and H&F Retail Concepts Inc.

"3) There is a likelihood of confusion between Respondent-Applicant's 'V VALENTINO CREATIONS' mark and Opposer's 'VALENTINO' trademarks.

"3.1. Respondent-Applicant's 'V VALENTINO CREATIONS' mark in class 25 is confusingly similar with the Opposer's 'VALENTINO' trademarks that should be protected under Section 155.2 of R.A. No. 8203, which Section proscribes the copying or colorably imitating a registered mark or a dominant feature thereof likely to cause confusion, or to cause mistake, or to deceive.

"3.2. Shown below are the parties' respective marks for purposes of comparison:

x x x

"Hence, the high similarity between the two marks would likely influence the public to believe that Respondent-Applicant's products are those of the Opposer's.

"The addition of the word 'CREATIONS' to 'V' and 'VALENTINO' in respondent-applicant's mark does not make the said mark distinct as the dominant element is obviously 'VALENTINO'. Evidently, respondent-applicant's 'V VALENTINO CREATIONS' mark closely resembles and is confusingly similar to the Opposer's well-known and registered 'VALENTINO' marks.

"3.4. Considering the similarity of the parties' marks, as well as the undeniable identity and relation of the goods of the Respondent-Applicant to the goods of the Opposer, confusion between parties' marks and products will definitely occur in the event that Respondent-Applicant's application for registration and use of trademark will be allowed.

"4) The use of Respondent-Applicant's 'V VALENTINO CREATIONS' mark for its products would indicate a connection to the products covered in Opposer's 'TECHNO VALENTINO' trademarks, hence, the interests of the Opposer are likely to be damaged.

"4.1. Respondent-Applicant applied for the registration of the 'V VALENTINO' mark for goods under class 25 (articles of clothing including jeans, trousers, shirts and t-shirts for men, women and children; as far as included in class 25 and not in other classes), which are related to the goods covered by existing trademark registration of Opposer's 'VALENTINO' trademarks. A copy of the respondent-applicant's mark as published in the IPOPHL Official Gazette is herein attached as Annex 'D'.

"4.2. The use by Respondent-Applicant of the 'V VALENTINO CREATIONS' mark for its products identical or similar to the goods carrying Opposer's 'VALENTINO'

trademarks on goods falling under class 25, will definitely cause confusion and mislead the public into believing that his products originate from, or are licensed or sponsored by Opposer or that Respondent-Applicant is associated with or an affiliate of the Opposer.

"4.3. The flagrant and veritable imitation of herein Opposer's 'V VALENTINO CREATIONS' trademark is likely to cause confusion, mistake and deception to the public as to the source and origin of Respondent-Applicant's products. The fact that the products of Respondent-Applicant and Opposer travel the same channels of trade and have similar target markets will cause confusion as to the source and origin of the goods as well.

"4.4. It is the resultant goodwill and popularity of Opposer's 'VALENTINO' trademarks that Respondent-Applicant wishes to exploit and capitalize. Accordingly, the use and approval for registration of Respondent-Applicant's 'V VALENTINO CREATIONS' mark constitutes an infringement or invasion of Opposer's property rights to its 'VALENTINO' trademarks which are protected by law. Such will most assuredly cause the dilution and loss of distinctiveness of Opposer's 'VALENTINO' trademarks as well as cause irreparable damage and injury to Opposer.

"4.5. Indubitably, the use, sale, and distribution by the Respondent-Applicant of 'V VALENTINO CREATIONS' products will inflict considerable damage to the interests of the Opposer. To allow Respondent-Applicant to register the 'V VALENTINO CREATIONS' mark for his products will constitute a mockery of our laws protecting intellectual property rights. It will legitimize its unfair and unlawful business practice.

"5) 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' trademarks is well protected under Section 165 of R.A. 8293, which provides:

x x x

"5.1. Undoubtedly, the use of the 'V VALENTINO CREATIONS' mark and the sale and distribution of goods under class 25 by the respondent-applicant are inflicting considerable damage to the interests of the Opposer. To allow respondent-applicant to register 'V VALENTINO CREATIONS' mark, will constitute mockery of our laws protecting intellectual property rights as it will legitimize respondent-applicant's unfair and unlawful business practice.

"6. The affidavit of Opposer's witness, Antonella Andrioli, with the attached evidence, is herein attached as Exhibit 'E' and shall constitute an integral part of this Opposition.

"7. Enclosed herein as Exhibit 'F' is the affidavit of Avril Elaine Gamboa, attaching copies of evidence which already form part of the records of other cases filed in the Bureau of Legal Affairs, specifically, IPC Case No. 14-2011-00402 entitled 'VALENTINO S.P.A. vs. AULIA SINGGIH and IPC Case No. 14-2010-00048 entitled 'VALENTINO S.P.A. vs. PING AN UNITED RESOURCES LIMITED' and shall constitute as integral part of this Opposition.

"8. Opposer reserves the right to present such other documents as may be necessary to prove the foregoing allegations in the course of the proceedings.

The Opposer's evidence consists of copies of the following Certificates of Registration for VALENTINO trademarks and its variants : Registration Nos. 4-1989-70274, 4-2008-009616, 4-2012-502637, 4-2000-010495, 4-1997-124857, 4-1990-074377, 4-2000-010490 and 053234 issued by IP PHL; copies of registration certificates in Benelux, European Union, Germany, Great Britain, Hong Kong, Italy, Singapore and U.S.A.; list showing all the registered VALENTINO trademarks worldwide; print-out from the website <http://www.valentino.com/>, depicting sample products bearing the VALENTINO trademarks; a copy of the Respondent-Applicant's mark as published in the IPOPHL Official Gazette; the affidavit of Opposer's witness, Antonella Andrioli, Legal Representative of VALENTINO S.P.A.; and the affidavit of Avril Elaine Gamboa, Associate Lawyer of Sapalo, Velez, Bundang and Bulilan Law Offices.<sup>4</sup>

This Bureau issued a Notice to Answer and sent a copy thereof upon Respondent-Applicant on 30 April 2015. Said Respondent-Applicant, however, did not file an Answer.

Should the Respondent-Applicant be allowed to register the trademark V VALENTINO CREATIONS?

Records show that at the time the Respondent-Applicant filed its trademark application on 10 July 2013 for the mark "V VALENTINO CREATIONS", the Opposer already owns trademark registrations for VALENTINO trademarks and its variants. This Bureau noticed that the goods covered by Respondent-Applicant's trademark application are similar to Opposer's.

A comparison of the competing marks reproduced below:



Opposer's trademark



Respondent-Applicant's mark

shows that the marks are obviously identical including the use of the letter "V" enclosed by a semi-circle and both marks are used on similar goods, particularly, articles of clothing or apparel under Class 25. Thus, it is likely that the consumers will have the impression that these goods originate from a single source or origin. The

<sup>4</sup> Marked as Exhibits "A" to "F", inclusive.

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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.<sup>5</sup>

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.<sup>6</sup>

Also, Opposer has been using VALENTINO not only as a trademark but also as trade name or business name. As a trade name, VALENTINO is protected under Section 165 of the IP Code, to wit:

Sec. 165. *Trade Names or Business Names.* - 165.1. A name or designation may not be used as a trade name if by its nature or the use to which such name or designation may be put, it is contrary to public order or morals and if, in particular, it is liable to deceive trade circles or the public as to the nature of the enterprise identified by that name.

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 trade name or mark, likely to mislead the public, shall be deemed unlawful.

165.3. The remedies provided for in Sections 153 to 156 and Sections 166 and 167 shall apply *mutatis mutandis*.

165.4. Any change in the ownership of a trade name shall be made with the transfer of the enterprise or part thereof identified by that name. The provisions of Subsections 149.2 to 149.4 shall apply *mutatis mutandis*.

<sup>5</sup> *Converse Rubber Corp. v. Universal Rubber Products, Inc. et. al.*, G.R. No. L-27906, 08 Jan. 1987.

<sup>6</sup> *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).




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.<sup>7</sup>

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. 4-2013-501802 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, 08 April 2016.

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

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<sup>7</sup> *American Wire & Cable Company v. Director of Patents*, G.R. No. L-26557, 18 Feb. 1970.