

GUCCIO GUCCI S.p.A.,
Opposer,

-versus-

RONG BAO HONG,
Respondent -Applicant.

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} **IPC No. 14-2013-00418**
}
} Opposition to:
} Appln. Serial No. 4-2012-014659
} Date Filed: 04 December 2012
} **TM: "CUCI"**
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}

NOTICE OF DECISION

CARAG JAMORA SOMERA & VILLAREAL LAW OFFICE

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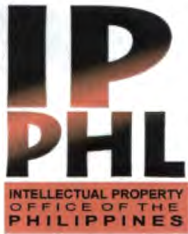
GREETINGS:

Please be informed that Decision No. 2016 - 183 dated June 22, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 22, 2016.

For the Director:


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



GUCCIO GUCCI S.p.A,

Opposer,

IPC NO. 14 - 2013 - 00418

- versus -

Opposition to:
Trademark Application Serial No.
42012014659

RONG BAO HONG,

Respondent-Applicant.

TM: "CUCI"

X-----X

DECISION NO. 2016 - 183

DECISION

GUCCIO CUCCI (Opposer)¹ filed an opposition to Trademark Application Serial No. 4-2012-014659. The trademark application filed by RONG BAO HONG (Respondent-Applicant)², covers the mark CUCI for "*Bags and wallet*" and *T-Shirt, jeans, shorts, polos, polo shirts blouses, men's underwear & ladies' underwear, sandals, socks, skirts, shoes and children's wear namely, jumper*" under Class 18 and 25 of the International Classification of Goods and Services³, respectively.

The Opposer alleges:

"3. The Opposer is a well-known company and is one of the world's most successful and prolific producers / designers of high class / luxury items of, among others, fashion, apparel footwear, optical, fragrance, home and lifestyle products. The Opposer's celebrated designs/products are marketed/sold/offered for sale/distributed, under Opposer's internationally famous trademarks x x x

4. The GUCCI Marks which have their origins from the world famous designer, Mr. Guccio Gucci, have been prominently and extensively used for more than (90) years in connection with a wide variety of products. These Marks also designate a prominent series of retail stores, located through out the European Union countries; the fashion capitals of the world, such as Milan, Italy; Paris, France; New York City, United States of America, as well as in Asia – in Hong Kong; Tokyo, Japan; Singapore and other parts of the world, including here in the Philippines, where GUCCI-brnaded clothing, footwear, accessories, and other

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

² An individual with a given Philippine address at Stall No. 2F-38 168 Shopping Mall, Binondo, Manila with trademark agent Jeffrey Gomez with address at 23B Northern Polytech St., University Hills Subd., Portrero, Malabon City.

³ The Nice Classification of Goods and Services is for registering trademarks and service marks based on multilateral treaty administered by the WIPO, called the Nice Agreement Concerning the International Classification of Goods and Services for Registration of Marks concluded in 1957.

**Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE**

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5. Respondent is the applicant for registration before this Office's Bureau of Trademarks, of the trademark "Cuci" for goods falling under International Class 25 that was filed on December 4, 2012 and bearing Application No. 4-2012-014659 (hereinafter also alternatively referred to as "Respondent's mark" and/or "Respondent's application"). x x x

GROUND S RELIED UPON FOR THIS OPPOSITION

6. Opposer is the owner of the numerous trademark registrations/applications for registration, for its GUCCI Marks, and is the Registrant in the Philippines of, among others, the following marks for and/or featuring the GUCCI Word Mark, with their respective registration details, as follows:

Mark	Registration No.	Registration Date	Class	Validity of Registration
1. GUCCI	054871	April 6 1993	6 and 34	Petition for renewal of registration was filed on April 12, 2013; awaiting BOT-IPOPHL's grant of registration renewal/release of owner's copy of Certificate of Renewal of Registration
2. GUCCI	036138	November 14, 1996	9	Up to November 14, 2016
3. GUCCI	030750	May 31, 1982	3, 14, 18 and 25	Petition for renewal of registration was filed on April 17, 2013; awaiting BOT-IPOPHL's grant of registration renewal/release of owner's copy of Certificate of Renewal of Registration
4. GUCCI RUSH	4-1999-000053	September 28, 2003	3	Up to September 28, 2013
5. GUCCI (Word Mark & Shield Device)	4-2006-011830	November 11, 2007	18 and 25	November 11, 2017
6. GUCCI GUILTY	4-2011-014293	March 15, 2012	3	Up to March 15, 2022
7. GUCCI	4-2011-014799	April 5, 2012	35	Up to April 5, 2022

x x x

7. The Respondent's application for registration of the "Cuci" mark chiefly contravenes Section 123.1 sub-paragraph (d) of Republic Act No. 8293 x x x

8. Respondent-Applicant's mark so resembles the Opposer's GUCCI Word Marks, as to be likely when applied to or used in connection with the Respondent-Applicant's goods, to deceive or cause to confusion with those of Opposer's goods / lines of business bearing the Opposer's GUCCI Word Marks. This is especially true since the phonetically similar to the Respondent's Cuci mark.

9. The use by Respondent-Applicant of the mark "Cuci" on goods that are similar, identical or closely related to the Opposer's goods that are produced by, originate from, offered by, or are under the sponsorship of herein Opposer bearing the latter's GUCCI Word Marks, will greatly mislead the purchasing/consuming public into believing that Respondent-Applicant's goods are produced by, originate from, or are under the sponsorship of the Opposer.

10. Opposer continues to use and has not abandoned the use in other countries around the world, including here in the Philippines, of its GUCCI Marks.

11. By virtue of the prior and continued use of the Opposer's GUCCI Marks in many countries around the globe made by herein Opposer, the GUCCI Marks have become popular and internationally well-known ones, including here in the Philippines. The GUCCI Marks have established valuable goodwill for the Opposer with the purchasing/consumer public, which have identified Opposer as the owner and the source of goods and/or products bearing said Opposer's GUCCI Marks.

12. In view of the foregoing, the Respondent's "Cuci" mark may also be considered in contravention of Section 123.1 (e) of our IP Code x x x"

To support its opposition, the Opposer submitted the following as evidence:

Exhibit "A" – Duplicate original of documents on payment of the issuance fees for the Certificate of Renewal of Registration No. 054871 for the mark GUCCI in the Opposer's name for Classes 6 and 34 goods;

Exhibit "B" – Original of certified true copy of Philippine Trademark Certificate of Registration No. 036138 for the mark GUCCI;

Exhibit "C" – Duplicate original of documents on payment of the issuance fees for the Certificate of Renewal of Registration No. 030750 for the mark GUCCI in the Opposer's name for Classes 3, 14, 18 and 25 goods;;

Exhibit "D" – Original of Certified True Copy of Philippine Trademark Certificate of Registration No. 4-1999-000053 for GUCCI RUSH;

Exhibit "E" – Original of Certified True Copy of Philippine Trademark Certificate of Registration No. 4-2006-011830 for GUCCI (Word Mark & Shield Device);

Exhibit "F" – Original of Certified True Copy of Philippine Trademark Certificate of Registration No. 4-2011- 014293 for GUCCI GUILTY;

Exhibit "F" – Original of Certified True Copy of Philippine Trademark Certificate of Registration No. 4-2011- 014293 for GUCCI GUILTY;

Exhibit "G" – Original of a Certified True Copy of Philippine Trademark Certificate of Registration No. 4-2011-014799 for the mark GUCCI;

Exhibit "I" – A certified copy of a notarized and legalized list of all of the trademark registrations for the GUCCI Word Marks;

Exhibit "J" – Certified Copy of Certificate of Authentication issued for Collective Annex "B" of the witness;

Exhibit "K" to "K-1" – Certified true copy of Italian Trademark Registration No. TO 2006 C 003062 for the mark GUCCI;

Exhibit "L" to "L-1" – Certified True Copy of Italian Trademark Reg. No TO 2004 C 00302 for the mark GUCCI;

Exhibit "M" to "M-1" – Certified True Copy of Italian Trademark Reg. No TO 2004 C 00315 for the mark GUCCI;

Exhibit "N" – Certified true copy of US Trademark Registration No. 876,292 for the mark GUCCI;

Exhibit "O" – Certified true copy of US Trademark Registration No. 1,168,477 for the mark GUCCI;

Exhibit "P" – Certified true copy of US Trademark Reg. No. 1, 202,802 for the mark GUCCI;

Exhibit "Q" – Certified True Copy of US Trademark Reg. No. 1,321,864 for the mark GUCCI;

Exhibit "R" – Certified True Copy of US Trademark Reg. No. 1,168,922 for the mark GUCCI;

Exhibit "S" – Certified True Copy of US Trademark Reg. No. 1,169,019 for the mark GUCCI; and

Exhibit "T" – Certified Copies of legalized copies of representative advertising/promotional materials all featuring the Opposer's GUCCI Marks.

This Bureau issued and served a Notice to Answer to the Respondent-Applicant on 15 April 2014. However, the Respondent-Applicant did not file an Answer to the Opposition.

The issue to resolve is whether the Respondent - Applicant should be allowed to register the trademark "Cuci."

Records show that at the time the Respondent-Applicant filed its trademark application on 4 December 2012, the Opposer has already an existing trademark registration for "GUCCI" and related marks covering Classes 3, 6, 9, 14, 18, 25, and 34.⁴

The competing marks are reproduced below for comparison:

GUCCI

Cuci

Opposer's Trademark

Respondent's – Applicant's Trademark

Upon examination of the competing trademarks and the evidence submitted by the Opposer, this Bureau finds the Opposition meritorious.

The letter composition of the two marks is almost identical. In fact, all the four letters of the Respondent-Applicant can be found in the Opposer's mark. Also, the competing wordmarks are both composed of two syllables, namely, "GU-CI" and "CU-CI". The second syllable "CI" of the two wordmarks is similar. Also, the difference in the first syllable "GU" for the Opposer and "CU" in the Respondent-Applicant's mark is virtually non-existent taking in consideration their phonetic effect to the buying public. The minimal difference is not enough to distinguish the two word marks from each other.

Jurisprudence is consistent that trademarks with *idem sonans* or similarities of sounds are sufficient ground to constitute confusing similarity in trademarks.⁵

Moreover, this Bureau also finds that the goods subject of the competing trademarks, are similar and/or closely related. The products of the respondent-applicant are bags, wallet, shoes and clothing apparels⁶ which are identical to the goods of the Opposer.⁷

There is likelihood that the product of the Respondent-Applicant may be confused with the Opposer's. The public may even be deceived that Respondent-Applicant's products originated from the Opposer, or that there is a connection between the parties and/or their respective goods.

Verily, the field from which a person may select a trademark is practically unlimited. As in all other cases of colorable imitation, the unanswered riddle is why, of the millions of terms and combination of design available, the Respondent-Applicant had to come up with a

⁴ Exhibits A to G

⁵ Marvex Commercial Co., Inc. vs. Petra Hawpia and Co, G.R. No. L-19297, 22 December 1966

⁶ Respondent-applicant's Trademark Application

⁷ Exhibits "A" to "G"

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.⁸


It has been held consistently in our jurisdiction that the law does not require that the competing trademarks must be so identical as to produce actual error or mistake. It would be sufficient, for purposes of the law that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.⁹ Corollarily, the law does not require actual confusion, it being sufficient that confusion is likely to occur.¹⁰ Because the respondent-applicant will use his mark on goods that are similar and/or closely related to the opposer's, the consumer is likely to assume that the respondent-applicant's goods originate from or sponsored by the opposer or believe that there is a connection between them, as in a trademark licensing agreement. The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court.¹¹

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.

WHEREFORE, premises considered, the instant Opposition to Trademark Application Serial No. 42012014659 is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 42012014659 be returned together with a copy of this Decision to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Taguig City, 22 JUN 2016


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

⁸ American Wire & Cable Company vs. Dir. Of Patent, G.R. No. L-26557, February 18, 1970.

⁹ American Wire & Cable Co. vs. Director of Patents, et. al., G.R. No. L-26557, February 18, 1970

¹⁰ Philips Export B.V. et. al. vs. Court of Appeals, et. al., G.R. No. 96161, February 21, 1992

¹¹ Converse Rubber Corporation vs. Universal Rubber-Products, Inc. et. al. G.R. No. L27906, January 8, 1987