

VAN DE VELDE NV,
Opposer,

-versus-

DRIVEN BY PASSION CORPORATION,
Respondent-Applicant.

}
}
}
}
}
}
}
}

IPC No. 14-2012-00153
Opposition to:

Appln. Serial No. 4-2011-004296
Date Filed: 13 April 2011

TM: PRIMADONNA

X-----X

NOTICE OF DECISION

BENZON NEGRE UNTALAN
Counsel for Opposer
Second Floor, SEDCCO Building,
Rada corner Legaspi Streets,
Legaspi Village, Makati City

OLIVA FIRME & ASSOCIATES
Counsel for Respondent- Applicant
Unit 30, 2nd Floor, Facilities Center
No. 548 Shaw Blvd., Mandaluyong City

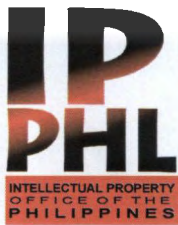
GREETINGS:

Please be informed that Decision No. 2016 - 527 dated 23 December 2016 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, 06 January 2017.

MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs



VAN DE VELDE NV, }
Opposer, }
 -versus- }
 DRIVEN BY PASSION CORPORATION, }
Respondent-Applicant. }
 x-----x

IPC No. 14-2012-00153
 Opposition to:
 Application No. 4-2011-004296
 Date Filed: 13 April 2011
 Trademark: "PRIMADONNA"
 Decision No. 2016- 527

DECISION

VAN DE VELDE NV¹ ("Opposer") filed an opposition to Trademark Application Serial No. 4-2011-004296. The application, filed by Driven By Passion Corporation² ("Respondent-Applicant"), covers the mark "PRIMADONNA" for use on "bags and wallets" under Class 18 and "shoes, belts, t-shirts, pants, shorts" under Class 25 of the International Classification of Goods and Services.³

The Opposer alleges:

x x x
 "ARGUMENTS

"6. The PrimaDonna brand traces its roots in Germany back in the mid 1800's when it was created originally by Salomon Lindauer whose focus was to provide elegant lingerie for women. In 1890, the brand name PrimaDonna was registered as a specialist in corsetry and by 1900, the brand has already conquered the European market. In 1938, the company changed its name into Wilhelm Meyer-Ilschen.

"7. The year 1955 marked the 90th anniversary of the PrimaDonna brand. Along with the evolution of women's lingerie, the PrimaDonna brand has succeeded in maintaining its huge presence in the global market for women's lingerie as well as expanding to women's clothing and accessories.

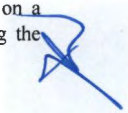
"8. In 1990, the Opposer, Van de Velde of Belgium, acquired PrimaDonna from Wilhelm Meyer-Ilschen and has since then turned PrimaDonna into a global clothing brand. Presently, the Opposer has stores in more than thirty countries worldwide, including the Philippines, which carry the PrimaDonna brand.

"9. The Opposer's mark, PrimaDonna, is well-known internationally, having been registered as a trademark in over twenty (20) countries across Europe, Northern

¹A corporation duly organized under the laws of Belgium, with office address at Lageweg 4, B-9260 Schellebelle, Belgium.

²With address at 515 Unit 3A Katarungan St. Mandaluyong 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.



Africa and the Mediterranean, the Middle East, Asia and Oceania, North America and Latin America. x x x

"10. As early as 1962, the Opposer's predecessor-in-interest has obtained a trademark registration for the mark PrimaDonna in the United Kingdom (Exhibit 'C-35').

"11. The Opposer has also successfully obtained a declaration from the Patent Office of the Republic of Bulgaria that PrimaDonna is a well-known mark for goods under Class 25. x x x

"12. In support of the decision, the following factors were cited in declaring PrimaDonna a well-known mark: i) the extent of popularity or recognition of the mark among the relevant circle of consumers; ii) the duration, extent and geographical area of use of the mark; and iii) the duration, extent and geographical area of availing the mark to the public.

"13. The extent of PrimaDonna's global success and popularity as a brand are as vast as its registrations. In the year 2011 alone, the Opposer earned aggregate sales worldwide in the amount of € 70,513,537.40. x x x

"14. The PrimaDonna brand likewise accounts for almost half of the Opposer's total revenues. For the years 2004 and 2005, the PrimaDonna brand earned approximately € 48 million and € 41 million, respectively, which represents 43% and 40% of total revenues. x x x

"15. Over the decades of PrimaDonna's existence as a label, the Opposer has invested huge amounts in promotional and advertising efforts. As such, the trademark PrimaDonna has prominently figured in the pages of international magazines such as Elle, Marie Claire, Bodystyle, Introversion, Compliment and Red. x x x

"16. By virtue of the prior and long-standing use by the Opposer of the PrimaDonna mark in various parts of the world, as well as its huge advertising efforts, the PrimaDonna mark has become popular and well-known internationally, thus, establishing goodwill for the Opposer which has been identified by the public as the source of goods bearing the trademark PrimaDonna. Undoubtedly, the Respondent-applicant wishes to exploit and capitalize the popularity of the PrimaDonna mark by seeking the registration of the mark in its name.

"17. Section 3 of the IP Code provides, to wit:

x x x

"18. In relation thereto, the Paris Convention for the Protection of Industrial Property (the 'Paris Convention') provides as follows:

x x x

"19. Section 123.1 (e) of the IP Code prohibits the registration of the mark which is identical with or confusingly similar to a mark which is considered 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. Based on the aforequoted provisions of the Paris Convention and the IP Code, the registration of a mark must be refused where it is likely

to confuse a well-known mark, whether registered or not, when used for identical or similar goods.

"20. The registration of the Respondent-applicant's mark is proscribed under the aforementioned provisions in view of the exact similarity of the mark and the goods for which it is sought to be registered and the trade channels as well as the conditions under which sales of these goods are made.

"21. There is no question that the mark sought to be registered is exactly identical to the Opposer's trademark, PrimaDonna. Thus, the registration and use of the primadonna mark by the Respondent-applicant to identify identical and similar goods under Class 18 and Class 25 will likely cause confusion or deceive the relevant public. A comparison of the goods for which the PrimaDonna is registered worldwide and those for which the Respondent-applicant's mark is sought to be registered is seen below:

x x x

"22. Based on the above sampling, the Opposer's mark is registered for goods under Class 25 consisting of clothing items like jerseys, body dresses, underclothings for women, knitted clothings, body linen, dress bodies, underclothings for men or women, knitted clothings, underclothes made of artificial silk and body linen, tops, shirts, housecoats, dressing-gowns, jackets, pajamas, blouses, knitted articles, body linen made of rayon, which are all identical to the goods consisting of t-shirts, pants, shorts for which the Respondent-applicant's mark is sought to be registered. Both sets of goods are also classified under Class 25.

"23. The goods under Class 18 consisting of bags and wallets, we well as shoes and belts under Class 25, are also similar to the Opposer's list of goods consisting of suspenders for wear, tights, stockings and hosiery.

"24. Among the factors to determine whether there is likelihood of confusion are: (1) strength of the senior user's mark; (2) degree of similarity between the marks; (3) proximity of the products; (4) likelihood that the senior user of the mark will bridge the gap; (5) evidence of actual confusion; (6) defendant's bad faith; (7) quality of defendant's products; and (8) sophistication of the relevant consumer group.

"25. Not only is the Opposer's mark exactly the same as that of and the goods it covers identical and similar to those of Respondent-applicant's, but it also is a strong, distinctive mark that raises the likelihood of confusion to a much higher degree. Other than Respondent-applicant's application for registration, no other entity has registered with the Bureau of Trademarks the PrimaDonna trademark under any class of goods or services.

"26. The distinctiveness or 'strength' of a mark measures its capacity to indicate the source of the goods or services with which it is used. The greater the distinctiveness of the mark, the greater the likelihood of confusion that prospective purchasers will associate the same or a similar designation found on other goods, services or businesses with the prior user. 'Strong' marks that have a higher degree of distinctiveness are thus protected against the use of similar marks against a wider range of goods or services than are 'weak' designations that have less distinctiveness or market recognition.



"27. Thus, by virtue of the similarity and strength of the marks, the Respondent-applicant's use of the primadonna mark will cause confusion in the minds of potential consumers not only as to the identity of the products but also with regard to their source, affiliation or sponsorship.

"28. While the Respondent-applicant's goods under Class 18 consisting of bags and wallets may arguably be non-competing with goods under Class 25 represented by the PrimaDonna trademark, likelihood of confusion with respect to source or affiliation nevertheless exists. Direct competition between the parties' products is not required in order to find a likelihood of confusion. The danger of affiliation or sponsorship confusion increases when the junior user's market is one into which the senior user would naturally expand. The actual intent of the senior user to expand is not particularly probative for this purpose. Instead, consumer perception is the controlling factor. If consumers believe, even though falsely, that the natural tendency of producers of the type of goods marketed by the prior user is to expand into the market for the type of goods marketed by the subsequent user, confusion may be likely.

"29. The production or sale of goods consisting of bags and wallets is traditionally within the natural or normal expansion of a clothing business like the Opposer's. More often than not, these goods are even sold and distributed by the same proprietor under the same roof, in which case, there is an overlap of consumers, suppliers and trade channels. The likelihood of confusion is higher in cases where the business of one corporation is the same or substantially the same as that of another corporation.

"30. If the mark primadonna is allowed to be registered in the name of the Respondent-applicant, its registration and use will greatly diminish the distinctiveness of the Opposer's trademark and dilute its goodwill and reputation which it has painstakingly built over the decades.

"31. In sum, the registration of the mark primadonna in favor of the Respondent-applicant should be denied because it is identical with the Opposer's trademark considered to be well-known abroad and in the Philippines.

The Opposer's evidence consists of the Power of Attorney executed by the Opposer in favor of BNU dated 21 May 2012; a copy of Application Serial No. 42011004296; copies of Opposer's certificates of trademark registration and their renewal in several jurisdictions; a copy of the decision of the Patent Office of Bulgaria; a copy of the 2011 sales report; a copy of the Ernst & Young Report of Factual Findings; copies of magazines such as Elle, Marie Claire, Bodystyle, Introversion, Compliment and Red.⁴

This Bureau issued a Notice to Answer and sent a copy thereof upon Respondent-Applicant on 15 June 2012. The Respondent-Applicant filed its Answer on 16 August 2012 and avers the following:

x x x

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

"AFFIRMATIVE DEFENSES

"5. In support of the specific denials and affirmative allegations, respondent-applicant respectfully submits that:

"5.1 Bengzon Negre Untalan Intellectual Property Attorneys has not been validly constituted as the Attorney-In-Fact of the opposer considering that:

"5.2 Under the Inter Partes Proceedings, as amended by Office Order No. 99, series of 2011, particularly Section 8 thereof, in case the opposer has constituted as attorney-in-fact, the Special Power of Attorney must show: (1) proof of authority to issue or execute the same; and (2) that said Special Power of Attorney must have proof of authentication by the appropriate Philippine diplomatic or consular office.

"5.3 Moreso, Section 134 of the Intellectual Property Code expressly states that the 'opposition shall be in writing and verified by the oppositor or by any person on his behalf who knows the facts, and shall specify the grounds on which it is based and include a statement of the facts relied upon.'

"5.4 In this case, it is crystal clear that while Atty. Anthony D. Bengzon was constituted as the attorney-in-fact of the opposer, the same however is legally defective. First, the attached Special Power of Attorney (Annex 'A') was not authenticated by the appropriate Philippine diplomatic or consular office. Second, the said SPA does not show the authority of Herman Van de Velde to execute the said SPA on behalf of the opposer. And lastly, Atty. Anthony D. Bengzon could not have known the facts in the Verified Notice of Opposition as he is a mere lawyer of the opposer who has not been engaged in the management of the opposer.

"5.5 Unfortunately for the opposer, the period as stated in Section 8 of the Office Order No. 99, series of 2011 within which to correct or cure the defects has already lapsed. Hence, on this score alone, this Notice of Verified Opposition should have been denied at the very outset.

"5.6 The importance of the validity of the Special Power of Attorney cannot just be simply ignored. In one case, the Supreme Court eloquently held:

x x x

"5.7 Needless to stress, if the Special Power of Attorney is defective, just like in this case, it only means the supposed attorney-in-fact has no valid representation for the alleged principal as the said SPA cannot be admitted in evidence. Hence, it necessary follows that there is no opposition to speak of. Or assuming there is, the same is not duly verified as required under the pertinent rules.

"5.8 Another cogent reason why this opposition should be denied is because some of the supposed Certificates of Registration in other countries were not translated in English language and that the other documents attached to the Verified Notice of Opposition are not authenticated by the appropriate Philippine consuls.

"5.9 Section 134 of Republic Act 8293 expressly provides:

x x x

"5.10 Similarly, Section 7 of Office Order No. 99 Series of 2011 which provides:

x x x

"5.11 In this case, it is beyond cavil that some of the documents presented by the opposer use languages which are not known under this jurisdiction. Considering that the pertinent laws were worded in a mandatory manner, failure to comply with them would be fatal to opposer's claim. The reason for the need of an English translation need not be elaborated. This jurisdiction cannot obviously know the contents of the documents unless they are translated in English. Thus, how can this Honorable Office support the allegation of the opposer if it does not even understand the evidence being presented to it? Thus, this Honorable Office has no option but to deny opposer's claim.

"5.12 In the same vein, some of the documents adduced by the opposer were not authenticated by the proper Philippine consul. Section 8 of Office Order No. 99 Series of 2011 provides that:

x x x

"5.13. Again, there is no doubt that some of the documents presented by the opposer were not authenticated by the proper Philippine consul. Considering that the pertinent laws were worded in a mandatory manner, failure to comply with them would be fatal to opposer's claim. The reason for the need of authentication by the proper Philippine consul is so obvious. x x x

"5.14 Going to the more substantial argument, opposer evidently failed to prove that the granting of the herein application for registration of the trademark primadonna would violate any provision of Republic Act 8293 or any treaty for that matter.

"5.15 At this juncture, it must be stressed that opposer's supposed presence in the Philippine market as well as its mark is NOT locally well-known. In fact, respondent-applicant has much stronger corporate identity and brand recall that anyone in the public would know that primadonna refers to that of the respondent-applicant.

"5.16 The pertinent provision of the Intellectual Property Code reads:

x x x

"5.17 As can be deduced from the foregoing, whether the goods or services are similar or not, the vital test in determining as to whether a mark is a well-known mark is 'the knowledge of the relevant sector of the public, x x x

"5.18 The above provision of the Intellectual Property Code is similar to the provision laid down under the Protection of Well-Known marks under the Paris Convention for the Protection of the Industrial Property, albeit it covers only identical or similar goods, to wit:

x x x

"5.19 Thus, in this jurisdiction, the competent authority to determine whether a mark is question is a well-known mark is no less than this Honorable Office or in case the matter reached the courts, then the proper courts for that matter. x x x

"5.20 Records show that respondent-applicant has previously registered pd primadonna as its trademark. And this Honorable Office could not agree more. x x x

"5.21 For the purpose of determining whether the instant application should be granted and this opposition should be denied, there is a need to know which of the two marks (xxx) is well-known here in the Philippines. x x x

"5.22 In this case, it is clear that respondent-applicant has met most of the criteria cited above. On the other end, opposer has miserably failed to establish that it has any business existence here in the Philippines. x x x

"5.23 In addition, by express provision in Section 123.1 (e and f), the well-known mark must be well-known internationally and in the Philippines. x x x

"5.24 In that case of Kabushi Kaisha Isetan, which case is squarely applicable to this case, the Highest Tribunal even concluded:

x x x

"5.25 It was further held that '[t]he Paris Convention for the Protection of Industrial Property does not automatically exclude all countries of the world which have signed it from using a tradename which happens to be used in one country. x x x

"5.26 A priori, it is now clear that opposer's supposed trademark is not locally-known in the Philippines and as far as the Filipinos are concerned, it cannot be considered as internationally known. Thus, opposer's claim must therefore fail.

"5.27 Based on the documents presented by the opposer, it would appear that its good is different from that of the respondent-applicant. Hence, the approval of the application of the respondent-applicant would not in anyway affect the opposer.

"5.28 The likelihood of the confusion, which is the very essence of protecting trademarks, is very remote and if not impossible considering that the products and goods offered by the respondent-applicant and the opposer are completely unrelated. Needless to stress, the ordinary intelligent client of either the respondent-applicant or the oppose would not be confused of the goods of either company.

"5.29 This Honorable Office should not be misled of the fact that opposer has undergarments as its products while that of the respondent-applicant does not sell any undergarments. Rather it sells shoes, other leather products, as well as clothing for women.

"5.30 At this juncture, the Supreme Court, in the case of Mighty Corporation, et al. vs. E. & J. Winery, et al., has to say:

x x x


"5.31 In this case, it is very clear that respondent-applicant's trademark would not likely create any confusion with opposer's supposed trademark. Interestingly and without being so repetitive, opposer does not sell any shoes, other leather products, as well as clothing for women. Opposer's product is limited to undergarments which is, on the other hand, not the product of respondent-applicant.

"5.32 Verily, there is no cogen reason for this Honorable Office to deny the application for the trademark primadonna by the respondent-applicant. As seen, opposer miserably failed to prove that the granting of the herein application for registration would violate any provision of Republic Act 8293 or any treaty for that matter.

The Respondent-Applicant's evidence consists of copies of the Lease Contract as well as the Certificates of Registration issued by the Bureau of Internal Revenue (BIR) and other permits evidencing primadonna's existence and operations in several malls in the Philippines; photographs of primadonna boutiques; copy of registration no. 42008004043 for the trademark pd primadonna; copies of recent articles and/or published photos which featured primadonna; copy of the internet layout of the domain primadonna.com.ph; photographs of the internet layouts of primadonna's twitter and facebook accounts; printout copy of brochures and a copy of the flyer for respondent-applicant's primadonna brand; copies of posters of concerts of celebrity Ms. Anne Curtis which respondent-applicant sponsored; and photographs of billboard of respondent-applicants primadonna brand.⁵

Before this Bureau dwell on the main issue/s, the technical issues raised by the Respondent-Applicant must first be resolved. As to Mr. Herman Van de Velde's authority as managing director to sign the Verification and Certificate of Non-Forum Shopping, the issue has been settled by the Supreme Court in *Swedish Match Philippines, Inc. vs. The Treasurer of the City of Manila*⁶ where it declared that:

"In sum, we have held that the following officials or employees of the company can sign the verification and certification without need of a board resolution: (1) the Chairperson of the Board of Directors, (2) the President of a corporation, (3) the General Manager or Acting General Manger, (4) Personnel Officer, and (5) an Employment Specialist in a labor case."

Likewise, this Bureau finds the "Special Power of Attorney" executed also by Mr. Herman Van de Velde, as having sufficiently complied with the Rules, it having been notarized and authenticated before the Philippine consular office in Belgium, likewise, it is able to show that the law firm of Bengzon Negre Untalan has been given by the Opposer the authority to represent the latter in the instant case, including the authority of Atty. Anthony D. Bengzon to sign the verification and certification of non-forum shopping. 

⁵ Marked as Annexes "1" to "88", inclusive.

⁶ G.R. No. 181277, 03 July 2013.

The technical issues/matters settled, this Bureau now scrutinize the main issue, hence the question, should the Respondent-Applicant be allowed to register the trademark PRIMADONNA?

A comparison of the competing marks reproduced below:

PrimaDonna

primadonna

Opposer's trademark

Respondent-Applicant's mark

shows that the marks are obviously identical and used on similar and/or closely related goods, particularly, article of clothing or wearing 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.⁷

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

⁷ Converse Rubber Corp. v. Universal Rubber Products, Inc. et. al., G.R. No. L-27906, 08 Jan. 1987.

manufacturer against substitution and sale of an inferior and different article as his product.⁸

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 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.

Significantly, Sec. 121.1 of the IP Code adopted the definition of the mark under the old Law on Trademarks (Rep. Act No. 166), to wit:

121.1. "Mark" means any visible sign capable of distinguishing the goods (trademark) or services (service mark) of an enterprise and shall include a stamped or marked container of goods; (Sec. 38, R.A. No. 166a)

Sec. 122 of the IP Code also states:

Sec. 122. How Marks are Acquired.- The rights in a mark shall be acquired through registration made validly in accordance with the provisions of this law. (Sec. 2-A, R.A. No. 166a)

There is nothing in Sec. 122 which says that registration confers ownership of the mark. What the provision speaks of is that the rights in a mark shall be acquired through registration, which must be made validly in accordance with the provisions of the law.

Corollarily, Sec. 138 of the IP Code provides:

⁸ *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).

Sec. 138. Certificates of Registration. – A certificate of registration of a mark shall be *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. (Emphasis supplied)

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.⁹ 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 *E.Y. Industrial Sales, Inc., et al. v. Shen Dar Electricity and Machinery Co. Ltd.*¹⁰, the Supreme Court held:

x x x Under this provision, the registration of a mark is prevented with the filing of an earlier application for registration. This must not, however, be interpreted to mean that ownership should be based upon an earlier filing date. While RA 8293 removed the previous requirement of proof of actual use prior to the filing of an application for registration of a mark, proof of prior and continuous use is necessary to establish ownership of a mark. Such ownership constitutes sufficient evidence to oppose the registration of a mark.

x x x

Notably, the Court has ruled that the prior and continuous use of a mark may even overcome the presumptive ownership of the registrant and be held as the owner of the mark. x x x

In this instance, the Opposer proved that it is the originator and owner of the contested trademark. As stated, "The PrimaDonna brand traces its roots in Germany back in the 1800's when it was created originally by Salomon Lindauer whose focus was to provide elegant lingerie for women. In 1890, the brand name PrimaDonna was registered as a specialist in corsetry and by 1900, the brand has already conquered the European market..." It is incredible for the Respondent-Applicant to have come up with exactly the same and/or confusingly similar trademark for use on similar or closely-related goods, specifically article of clothing, bags and wallets, by pure coincidence.

⁹ See Sec. 236 of the IP Cod

¹⁰ G.R. No. 184850, 20 October 2010.

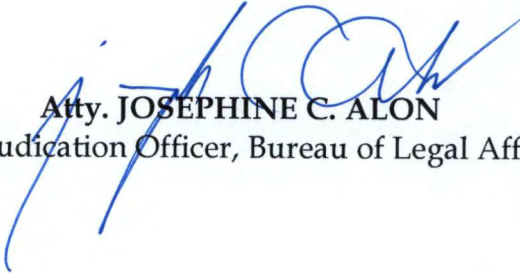
Succinctly, the field from which a person may select a trademark is practically unlimited. As in all other cases of colorable imitations, the unanswered riddle is why of the millions of terms and combinations of letters and designs available, the Respondent-Applicant had to come up with a mark identical or so closely similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark.¹¹

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. 4-2011-004296 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 DEC 2016.


Atty. JOSEPHINE C. ALON
Adjudication Officer, Bureau of Legal Affairs

¹¹ *American Wire & Cable Company v. Director of Patents*, G.R. No. L-26557, 18 Feb. 1970.