

GUCCIO GUCCI S.p.A.,
Opposer,

-versus-

KRISTINE TAN,
Respondent-Applicant.

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IPC No. 14-2013-00452
Opposition to:
Appln. Serial No. 4-2013-006798
Date Filed: 11 June 2013

TM: LADY-G

NOTICE OF DECISION

CARAG JAMORA SOMERA & VILLAREAL LAW OFFICES

Counsel for Opposer
2nd Floor, The Plaza Royale
120 L.P. Leviste Street, Salcedo Village,
Makati City

THE LAW FIRM OF COLUSO CHICA & ASSOCIATES

Counsel for Respondent- Applicant
Unit 210 A & T Building,
244 Escolta Street, Binondo
Manila

GREETINGS:

Please be informed that Decision No. 2017 - 205 dated 07 June 2017 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHEL 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.

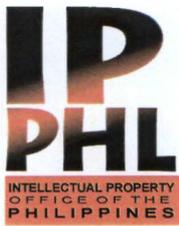
Taguig City, 07 June 2017.

MARILYN F. RETUAL
IPRS IV

Bureau of Legal Affairs

Republic of the Philippines
INTELLECTUAL PROPERTY OFFICE

Intellectual Property Center # 28 Upper McKinley Road, McKinley Hill Town Center, Fort Bonifacio,
Taguig City 1634 Philippines • www.ipophil.gov.ph
T: +632-2386300 • F: +632-5539480 • mail@ipophil.gov.ph



GUCCIO GUCCI S.p.A,
Opposer,

IPC NO. 14 – 2013 - 00452

- versus -

Opposition to:
Trademark Application Serial No.
42013006798

KRISTINE TAN,
Respondent Applicant.

TM: "LADY G"

DECISION NO. 2017 - 205

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DECISION

GUCCIO GUCCI (Opposer)¹ filed an Opposition to Trademark Application Serial No. 4-2013-006798. The trademark application filed by Ms. Kristine Tan (Respondent Applicant)², covers the mark "LADY G" for *"jewelry, bracelets (jewelry), brooches (jewelry), chains (jewelry), wristwatch, earrings, necklaces (jewelry), pearls (jewelry), precious stones, rings (jewelry), leather bags for women, backpacks, bags, shoulder bags, tote bags, wallets, purse, bags (envelopes, pouches) of leather, sport bag, bags (garment) for travel, bags (net) for shopping, beach bags, belts, briefcases, sling for infants (carrying bags), suit cases, travelling bags, umbrellas, belts (clothing), beach clothes, shoes, slippers, sandals, boots, clothing (leather silk, cotton), gowns (dressing), jackets (clothing), leggings, hats, headbands (clothing), pants, ready made clothing, shawls, shirts, tee-shirts, swimsuits and underwear"* under Class 14, 18 and 25 of the International Classification of Goods and Services.³

The Opposer based its Opposition on the following grounds:

"6. The Opposer is the owner of numerous trademark registrations/applications for registration, for its GUCCI Marks, and is the Registrant in the Philippines of, among others, the following marks for its well-known Double G Logo x x x

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

² An individual with a postal address at 932 Ongpin St. Sta Cruz, Manila.

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.



7. The Respondent's application for registration of the 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 Marks, particularly the DOUBLE G DEVICE Marks, as to be likely when applied to or used in connection with the Respondent-Applicant's goods, to deceive or cause confusion with those of Opposer's goods / lines of business bearing the Opposer's Double G Device Marks.



9. The use by the Respondent-Applicant of the mark 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 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 DOUBLE G DEVICE Marks.

11. By virtue of the prior and continued use of the Opposer's DOUBLE G DEVICE Marks in many countries around the globe made by herein Opposer, the said DOUBLE G DEVICE Marks have become popular and internationally well-known ones, including here in the Philippines. The DOUBLE G 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 DOUBLE G DEVICE marks.

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

The Opposer submitted the following evidence to supports its Opposition:

Exhibit "A" – Copy of Opposer's Certificate of Renewal of Registration No. 30659 for the mark Double G Device for classes 3, 14,18 and 25 goods;

Exhibit "B" – Copy of Opposer's Certificate of Registration No. 4-1996-107565 for the mark GG Logo for Class 9 goods;

Exhibit "C" – Copy of Opposer's Certificate of Registration No. 4-2011-014798 for Class 18 goods; and

Exhibit "D" – Copy of Opposer's Certificate of Registration No. 4-2011-015041 for Class 9 goods;

This Bureau issued a Notice to Answer to the Respondent-Applicant on 4 February 2014.

On 19 May 2014, the Respondent-Applicant filed its Answer, alleging as follows:

“9. Paragraph 6 is specifically denied for lack of knowledge and information sufficient to form a belief as to the truth thereof.

10. Paragraph 7 of the Opposition is specifically denied for being false, baseless and malicious. The truth of the matter is that the mark of the Respondent-Applicant is unique and does not resemble any mark belonging to any other proprietor. Hence, it is unlikely to cause confusion or deception to the public.

11. Paragraph 8 of the Opposition is specifically denied for being baseless and mere conclusions. The truth of the matter is that Respondent-Applicant’s mark does not by any stretch of imagination resemble the mark of the Opposer. Thus, even if it is used in similar goods or line of business, it will not confuse or deceive the buying public, especially considering the fact that Respondent-Applicant’s mark contains the word ‘Lady G.’

x x x

14. In line with the foregoing, a comparison of the marks of Opposer and Respondent would show that there is no such similarity or resemblance between the two. Hence an ordinary purchaser giving such attention as a purchaser usually gives will not be deceived to buy a product supposing to be the other. This would not likely happen.

15. Thus, it cannot be said that Respondent-Applicant’s ‘Lady G’ mark is identical with or similar to Opposer’s marks as to cause confusion to the purchasing public.

16. Paragraph 9 of the Opposition is specifically denied for being false, malicious and a mere conclusion of herein Opposer. A simple look or even a detailed examination of Respondent-Applicant’s mark would show that it does not in anyway resemble the ‘Double G Device’ mark of the Opposer.

17. In opposing Respondent-Applicant’s application Opposer only centers on the double G appearing on the former’s mark without recognizing the presence of such distinct and unique marks as a big circle enclosing the letter G with mirror image and with a crown on top. More importantly, there is a LADY G word appearing above the logo itself. x x x

18. Thus applying the two (2) prevailing tests to determine confusion: the dominance test which focuses on the similarity of the essential features of the marks, it is clear that while both marks consist of double G, Respondent-Applicant’s double G with mirror image is evidently different from that of the Opposer/s interlocking double G; letter G interlocking with an inverted letter G and letter G facing an inverted letter G, x x x

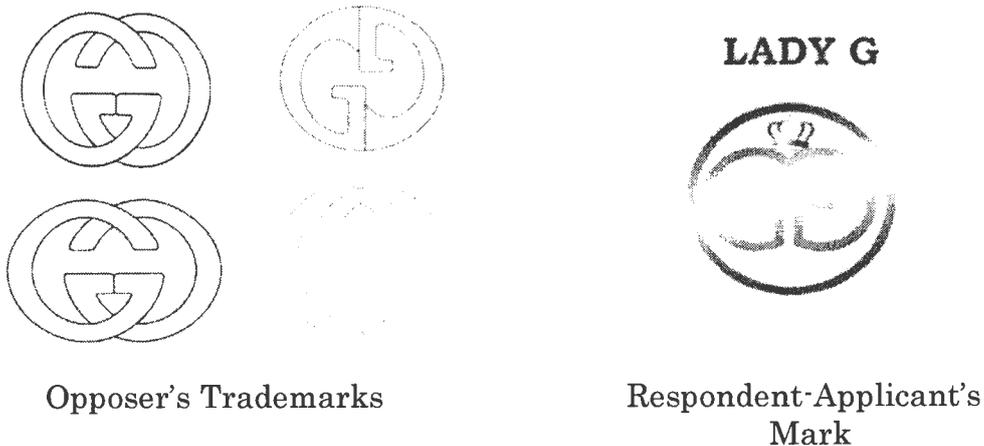
19. The holistic test, which considers the entirety of the marks, including the labels and packaging and focuses on the features appearing on the labels, it is clear that both marks are obviously different from each other.

From the color of the mark to the visual appearance of the logo, it is undeniably two (2) different marks from two (2) different owners.”

After the termination of the Preliminary Conference on 4 August 2014, the parties submitted their respective Position Papers.

The primary issue to be resolved in the instant case is whether to allow the trademark “LADY G” to be registered.

The competing trademarks are depicted below for comparison:



Upon examination of the competing trademarks and the arguments averred by the parties, this Bureau finds the Opposition meritorious.

The Opposition is anchored on Section 123.1 pars. (d), (e) and (f) of Republic Act No. 8293, also known as, the Intellectual Property Code of the Philippines (“IP Code”) which provide, as follows:

123.1. A mark cannot be registered if it:

x x x

(d) Is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date, in respect of:

- (i) The same goods or services, or
- (ii) Closely related goods or services, or
- (iii) If it nearly resembles such a mark as to be likely to deceive or cause confusion;

(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 services 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:

x x x

At the outset, records bear out that when Respondent-Applicant filed her trademark application on 11 June 2013, the Opposer has already a prior and existing trademark registrations: Trademark Registration No. 030659 with registration date of 15 February 1982; Trademark Registration No. 4-1996-107565 with registration date of 30 March 2001; Trademark Registration No. 4-2011-014798 with registration date of 29 March 2012; and Trademark Registration No. 4-2011-015041 with registration date of 29 March 2012.

The prior registered trademarks of the Opposer cover a number of goods including: *Non medicated toilet preparations, cosmetic preparations, perfumes, eau-de cologne, soaps, dentifrices, preparations for the hair, anti-perspirant, depilatory preparations, and toilet articles, goods in precious metals or coated therewith (except cutlery, fork and spoons), jewellery and imitation jewellery, precious stones, horological and other chronometric instruments, articles of leather or imitation of leather and not included in other classes; trunks, suitcases, travelling cases, handbags, purses, wallets, umbrellas, parasols and walking sticks, whips, harness and saddlery, articles of outer-clothing for men and women, knitwear, shirts, t-shirts, skirts, blouses, scarves, cravatas, ties, hats, socks, shoes, and belts, scientific, nautical, surveying and electrical apparatus and instruments (including wireless) namely; calculators; photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; coin or counter-freed apparatus; talking machines, cash registers, calculating machines, fire-extinguishing apparatus, vanity cases, dog collars, fur, tanned skin, imitation fur, name card cases of leather, purses not of precious metal, beach bags, brief cases, suit cases, ticket cases of leather, credit card cases of leather, traveling bags, traveling trunks, passport cases of leather, packing bags, handbags, leather boxes, leather packaging sacks, leather furniture covering, umbrellas, parasols, walking canes, saddle cloth for horses, riding saddles, belts, leather belts, eyeglasses, sunglasses, frames for glasses and parts thereof* under Classes 3, 9, 14, 18 and 25 of the International Classification of Goods and Services. From the above enumeration of Opposer's products and the goods subject of the Respondent's application, there is no doubt that the goods of both parties are similar and closely related. They are composed of jewellery, clothing, accessories and fashion related products.

Although the trademark being applied by the Respondent-Applicant is a composite mark with many design elements, this Bureau finds that the most dominant feature thereof is still the two letter Gs in the middle facing each other and covering the majority area of the mark. This dominant face-to-face design of letter Gs in the Respondent-Applicant mark is conceptually the same and closely resembles the earlier registered interlocking Double "G" trademarks of the Opposer.

This Bureau is not persuaded by the argument of the Respondent-Applicant's that the presence of the other elements, such as: the silver color of the mark, the presence of the word "Lady G", the big circle, and the crown on top, differentiated the applied trademark from the mark of the Opposer. This Bureau noted that the two letter Gs facing together in the center of the Respondent-Applicant's trademark remain to be the most conspicuous elements of the mark. It is the one that will leave an impression on the consumer or the buying public. The differences mentioned by Respondent-Applicant are at most negligible and would not be enough to negate the confusing similarity of the contending marks.

Verily, our intellectual property laws do not require that the competing trademarks be so identical as to produce actual error or mistake. It would be sufficient that the similarity between the two labels is such that there is a possibility or likelihood that the purchaser of the older brand would be mistaking the newer brand for it.⁴ Our laws do not require actual confusion, a mere likelihood of confusion is enough.⁵ Since the Respondent-Applicant will use the subject trademark on the same or similar products of the Opposer, it is not far-fetched that the consumer would likely to assume that the Respondent-Applicant's goods originate or sponsored by the Opposer, or at the very least, believe that there is a connection between these goods. Definitely, the likelihood of confusion would subsist not only on the purchaser's perception of goods but also on its origin or its source.⁶

Time and again, our Supreme Court has held that the field from which a person may select a trademark is practically unlimited and hence there is no excuse for impinging upon or even closely approaching the mark of a business rival.⁷ Furthermore, 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 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 This is especially true in the instant case where the Opposer had registered its similar trademark more than thirty years earlier than the Respondent-Applicant.

⁴ American Wire & Cable Co. vs. Director of Patents, et. al., G.R. No. L-26557, February 18, 1970

⁵ Philips Export B.V. et. al. vs. Court of Appeals, et. al., G.R. No. 96161, February 21, 1992

⁶ Converse Rubber Corporation vs. Universal Rubber-Products, Inc. et. al. G.R. No. L27906, January 8, 1987

⁷ Ang vs. Teodoro G.R. No. L-48226, December 14, 1942, Kalaw ng Khe vs. Lever Brotehr Co. G.R> No. L-46817 April 18, 1941, citing the US Case of Kassman & Kessner, Inc. vs. Rosenberg Bros. Co.

⁸ American Wire & Cable Company vs. Dir. Of Patent , G.R. No. L-26557, February 18, 1970; Birkenstock Orthopaedic GMBH and Co. KG vs. Philippine Shoe Expo Marketing Corp. G.R. No. 194307, November 20, 2013

WHEREFORE, premises considered the instant Opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2013-006798 be returned, together with a copy of this Decision, to the Bureau of Trademark for information and appropriate action.

SO ORDERED.

Taguig City, 07 JUN 2017


Atty. ~~Leonardo~~ Oliver Limbo
Adjudication Officer
Bureau of Legal Affairs