



INTELLECTUAL PROPERTY
OFFICE OF THE PHILIPPINES

SANTONI SOCIETA ' PER AZIONI,
Petitioner,

-versus-

PERFECT APPAREL, INC.,
Respondent-Registrant.

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IPC No. 14-2012-00524
Cancellation of:

Registration No. 053643
Date Issued: 13 October 1992

**TM: SANTONI WITH POCKET
DESIGN**

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2017 - 335 dated 26 September 2017 (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, 26 September 2017.

MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs



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IPC No. 14-2012-00524
Cancellation of:

Registration No. 053643
Date Issued: 13 October 1992
Trademark: **"SANTONI WITH
POCKET DESIGN"**

Decision No. 2017 - 335

DECISION

SANTONI SOCIETA' PER AZIONI ("Petitioner")¹, filed a petition for cancellation of Trademark Registration No. 053643. The registration, issued to PERFECT APPAREL, INC. (Respondent-Registrant)², covers the mark "SANTONI WITH POCKET DESIGN" for use of goods³ under classes 18, 24 and 25 namely: belts and bags; towel and handkerchiefs; and, jeans, skirts, jackets, children's wear, t-shirts, briefs, blouses, socks, shoes.

The Petitioner alleges that it is the registered owner and prior user of the internationally well-known marks "Andrea Santoni", "AndreaSantoni", "Santoni Gloria", "Santoni in Chinese Characters", "Santoni in Russian Characters", "Santoni in Japanese Characters", "Santoni Legenda", "Santoni Nauticus", "Santoni Nuvola", "Santoni Shabby Chic", "Santoni", and "Santoni with Drawing". It has also pending registrations worldwide and has been using the aforementioned marks for goods under International Classes 3, 9, 14, 18, 25 and 35. Since its creation in 1975, it pursued its vision refining the cultural heritage of craftsmanship and Italian excellence. Born with the creation of the haut de gamme shoes laboratory by "Andrea Santoni", the brand's legacy has been handed to his son Giuseppe, making the brand an international icon with 400 employees and a turnover of more than 50 million Euros. The Petitioner further avers that it owns several stores located worldwide to sell its goods and services, and published its marks in countless editorials from the most prestigious fashion and lifestyle magazines worldwide.

The Petitioner sets forth the following grounds for this instant cancellation case: (a) Respondent, without legitimate reason fails to use the mark 'Santoni with Pocket Design' within

¹ A corporation duly organized and existing under the laws of Italy with principal business address at Via Monte Napoleone 9, 20121, Milano (MI), Italy.

² With address at 20 General Wood Street, S.F.D.M. Quezon City, Metro Manila, Philippines.

³ The Nice Classification of goods and services is for registering trademark and service marks, based on a 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.

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the Philippines, or to cause it to be used in the Philippines during an uninterrupted period of three (3) years or longer; (b) Respondent's registered mark "Santoni with Pocket Design" was obtained fraudulently or contrary to the provisions of Republic Act No. 8293; (c) Respondent's registered mark "Santoni with Pocket Design" is identical with, or confusingly similar to petitioner's marks which are 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 marks of petitioners, and used for identical or similar goods or services of respondent; and, (d) Respondent's registered mark "Santoni with Pocket Design", particularly the word 'Santoni, consists of the surnames of petitioner's founder, Andrea Santoni, and his son, Giuseppe Santoni, particular living individuals without their written consent.

The Petitioner submitted the following evidence:

1. Photocopy of Power of Attorney and Appointment of Resident Agent in favor of the counsel, and Photocopy of Certificate of Authentication issued by the Embassy of the Philippines;
2. Verification and Certification against Forum Shopping;
3. Photocopy of Summary of International Registrations of Petitioner's trademarks;
4. Photocopy of Petitioner's Application Form for the mark ANDREASANTONI with attachments;
5. Photocopy of Acknowledgment Receipt SOA No. 0002220120105160; and,
6. Photocopy of the list of some of the editorials from fashion and lifestyle magazines worldwide.

On 11 December 2013, Respondent-Registrant filed its Answer. It alleges that it adopted and started the use in good faith of the mark "SANTONI WITH POCKET DESIGN" on 01 January 1983 for use on goods falling under Classes 18, 24 and 25, the word "SANTONI" being the contraction of the name of the patron saint, SAN ANTONIO, of Respondent-Registrant's President Nenita Silviejo. In fact, when Respondent-Registrant adopted and used its mark, there was no mark being used in the Philippines identical or confusingly similar to the word mark "SANTONI". On 11 July 1991, Respondent-Registrant filed in good faith an application for the subject mark. At that time, Petitioner had no existing registration nor a pending application for any of the alleged marks. Thus, Certificate of Registration No. 53643 was issued on 14 October 1992 for Respondent-Registrant's "SANTONI WITH POCKET DESIGN", and was renewed for ten years on 13 October 2012, and valid until 13 October 2022.

Respondent-Registrant further states that it has not abandoned its mark but instead, continued the use of its registered mark "SANTONI AND DEVICE" up to the present. In fact, it submitted representative sales invoices showing the continued use thereof. As such, Respondent-Registrant claims that the Petitioner cannot invoke the provisions of Section 151 of the IP Code for lack of substantial evidence. The application by the Petitioner for the registration of the trademark ANDREASANTONI on 30 July 2012 does not render the subject trademark registration cancellable, as it was issued in accordance with the provisions of Section 4(d), Republic Act No. 166, as amended.

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Finally, the Respondent-Registrant invokes that Petitioner's Exhibits "C" to "C-6", "D" to "D-5" and "E" to "E-9" do not comply with Office Order No. 79, as amended.

The Respondent-Registrant submitted the following evidence:

1. Certified True Copy (CTC) of Certificate of Renewal of Registration No. 53643;
2. Certified machine copy of Respondent-Registrant's Certificate of Incorporation and Articles of Incorporation issued by the Securities and Exchange Commission;
3. Ctcs of the Accepted Affidavits of use by the Respondent-Registrant following the 5th, 10th and 15th anniversaries of Registration No. 53643;
4. Representative Sales Invoices of Respondent-Registrant on its continued use of its registered mark "SANTONI WITH POCKET DESIGN"; and,
5. Duly notarized affidavit of Nenita Salviejo, President of Perfect Apparel, Inc.

On 06 May 2014, this Bureau issued Order No. 2014-584, granting Respondent-Registrant's Motion to Expunge Petitioner's Reply from the records. Under the applicable rules⁴, the instant motion is deemed prohibited because pleadings subsequent to the filing of an Answer in Inter Partes Cases shall not be allowed. On a similar note, this Bureau cannot admit the additional documentary evidence of the Petitioner on 30 July 2014. It appears that Petitioner's submission of additional evidence is contrary to existing rules, and absolutely has no legal and factual justification for the very late submission.

This case is now submitted for resolution.

Should Respondent-Registrant's trademark SANTONI WITH POCKET DESIGN be cancelled?

Section 151.1 of R.A. No. 8293, also known as the Intellectual Property Code ("IP Code") provides:

x x x A petition to cancel a registration of a mark under this Act may be filed with the Bureau of Legal Affairs by any person who believes that he is or will be damaged by the registration of a mark under this Act as follows:

x x x

(b) At any time, if the registered mark becomes generic name for thee goods or services, or a portion thereof, for which it is registered, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of this Act, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used. x x x

⁴ Sec. 11, Rule 2, Office Order No. 99, Series of 2011 or Amendments to the Rules and Regulations on Inter Partes Proceedings. Section 11. Prohibited pleadings.-No motion to dismiss shall be entertained. Instead, all grounds for dismissal shall be pleaded as affirmative defenses, the resolution of which shall be made in the decision on the merits. Neither shall a motion for bill of particulars, motion for reconsideration of interlocutory orders, and all other pleadings subsequent to the filing of an Answer, shall be allowed.

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Records show that Respondent-Registrant was issued Registration No. 053643 for the trademark "SANTONI WITH POCKET DESIGN" on 13 October 1992⁵, and a Certificate of Renewal of Registration with validity date until 13 October 2022⁶. Moreover, Respondent-Registrant presented Affidavits of Use/Declaration of Actual Use following the 5th, 10th and 15th anniversaries of the subject trademark.⁷

Under the law, a certificate of registration constitutes a *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.⁸ In fact, the owner of a registered mark 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 or containers for goods or services which are identical or similar to those in respect of which the trademark is registered where use would result in a likelihood of confusion.⁹

Prima facie evidence is defined as:

Evidence good and sufficient on its face. Such evidence as, in the judgment of the law, is sufficient to establish a given fact, or the group or chain of facts constituting the parties claim or defense, and which if not rebutted or contradicted, will remain sufficient. **Evidence which, if unexplained or uncontradicted, is sufficient to sustain a judgment in favor of the issue it supports, but which may be contradicted by other evidence** (emphasis supplied).¹⁰

In this instant case, the Respondent-Registrant holds prima facie evidence of exclusive ownership over its registered mark "SANTONI WITH POCKET DESIGN". Petitioner, who seeks the cancellation of such mark on the grounds set forth in the petition has the onus probandi or burden of proof to rebut by sufficient evidence the presumption of validity, and/or overturn the prima facie evidence established by the fact of its registration. However, the Petitioner failed to invalidate the presumption of ownership of Respondent-Registrant over its registered trademark "SANTONI WITH POCKET DESIGN".

The Petitioner alleged ownership of the internationally well-known marks containing the word "SANTONI". It also contended that Respondent-Registrant fraudulently used the surname "Santoni" of its founder, without consent. These allegations nonetheless, are not supported nor substantiated by documentary evidence. The Petitioner's submissions are mere photocopies of original documents, therefore, contrary to the rules on admissibility of evidence.¹¹ Granting arguendo that the documents are admissible, the Petitioner still failed to rebut the prima facie validity of Respondent-Registrant's registration. The Petitioner merely showed a list of

⁵ Exhibit "1-A" of Respondent-Registrant.

⁶ Exhibit "1" of Respondent-Registrant.

⁷ Exhibits "3", "3-A" and "3-B" of Respondent-Registrant.

⁸ Sec. 138, Intellectual Property Code (IP Code).

⁹ Sec. 147, IP Code.

¹⁰ H. Black, et al., BLACKS LAW DICTIONARY 1190 (6th ed.,1990).

¹¹ Sec. 7, Rule 2, Office Order No. 99, Series of 2011 or Amendments to the Rules and Regulations on Inter Partes Proceedings.

international registrations of its trademarks¹². They are not verified and/or authenticated, and bears no assurance of legal credibility. Thus, bare allegations, unsubstantiated by corroborating evidence, are not equivalent to proof. In short, mere allegations are not evidence.¹³

On the other hand, Respondent-Registrant showed sufficient proof of ownership of the subject trademark. In addition to the registration certificates issued on its behalf, it likewise submitted sales invoices confirming actual and continuous presence and use of its trademarks in the Philippines.¹⁴ On this note, the Petitioner failed in its attempt to prove damage caused by the alleged confusingly similar subject trademark registration.

Finally, it is emphasized that the essence of trademark registration is to give protection to the owners of trademarks. 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 out into the market a superior 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.¹⁵

WHEREFORE, premises considered, the instant Petition for Cancellation of Trademark Registration No. 053643 is hereby **DENIED**. Let the filewrapper of the subject trademark registration be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City. 26 SEP 2017



Atty. GINALYN S. BADIOLA, LL.M.
Adjudication Officer, Bureau of Legal Affairs

¹² Exhibits "C" to "C-6" of Petitioner.

¹³ Dra. Dela Llana vs. Rebecca Biong, doing business under the name and style of Pongkay Trading, G.R. No. 182356, 04 December 2013.

¹⁴ Exhibits "4", "4-A" to "4-C" of Respondent-Registrant.

¹⁵ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999. See also Article 15, par. (1), Art. 16, par. 91 of the Trade-related Aspect of Intellectual Property (TRIPS Agreement).