

LEONARD FASHION.,
Opposer,
- versus -

IPC 14-2004-00069

Opposition to:
TM Application No. 4-2001-004492
(Filing Date: 25 June 2001)

SUSANA TAN,
Respondent-Applicant.

TM: "LEONARDO"

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Decision No. 2007 – 78

DECISION

This pertains to the NOTICE OF OPPOSITION filed by Leonard Fashion to Application Serial No. 4-2001-004492 for the trademark "LEONARDO" for Class 18 goods, namely, synthetic and natural leather handbags, wallets, and belts lodged by Susana Tan and published for opposition in the March 16, 2004 issue of the IP Philippines (IP Phil.) Official Gazette, Volume VI, No. 15.

Opposer is a company organized and existing under the laws of France with office address at 19, Avenue de l'Opera, 75001, Paris, France.

The grounds for opposition are as follows:

1. Opposer is the owner of the renowned mark "LEONARD, having used the mark in commerce since 1958 in France on a range of products such as silk scarves, men's ties, handbags, wallets, belts, briefcases, headgear, dresses, shirts, skirts, shoes, and other related goods;
2. As a result of its extensive promotion and quality products, the mark "LEONARD" is now in 250 cities around the world with a total of one hundred eleven (111) boutiques;
3. Opposer registered its mark "LEONARD" in numerous countries including the Philippines (Class 25), France (Classes 18, 20 and 25), Japan (Class 18), the U.S. (Class 18), and the European Community (Class 25), most of which countries are signatories to the Paris Convention for the Protection of Industrial Property;
4. Opposer's mark has acquired worldwide reputation and distinctiveness in respect to a range of products especially under Classes 18 and 25;
5. Respondent-Applicant's mark "LEONARDO" so resembles opposer's mark "LEONARD" as to likely deceive or cause confusion;
6. Respondent-Applicant's products and those of opposer's are similar/identical and/or related, being under the same class, such that use by respondent-applicant of the mark "LEONARDO" will deceive purchasers as to the source/origin of respondent-applicant's goods by believing that these are opposer's goods;
7. Opposer's and respondent-applicant's goods are used by the same people, and are traded and sold through the same channels of trade and in the same manner which increases the likelihood of confusion, mistake, or deception; and

8. The registration of respondent-applicant's mark would violate Section 123.1 (d), (e), and (f) of the Rules and Regulations on Trademarks, Service Marks, Trade Names, and Marked or Stamped Containers.

On August 13, 2004, respondent-applicant filed an ANSWER admitting only opposer's allegation in regard to the filing of the subject application for registration with this Office and its publication, and alleging the following affirmative defenses:

1. The subject application for registration herein is an application for re-registration of the mark "LEONARDO": On January 13, 1992, the then Bureau of Patents, Trademarks, and Technology Transfer (BPTTT) issued Certificate of Registration No. 51981 for the mark "LEONARDO and Device" in respondent-applicant's name which was based on Application Serial No. 72502 filed on July 9, 1990 with a claim of first use on December 1988;
2. Respondent-Applicant enjoys, thus, all the rights and privileges under Republic Act No. 166 which necessarily includes "the first to use" right enshrined therein and which right is respected under the Intellectual Property (IP) Code;
3. By virtue of its extensive use and advertisement of the mark "LEONARDO" in the Philippines since 1988, respondent-applicant has the goodwill over said mark in the Philippines such that purchasers would confuse respondent-applicant's products with that of opposer's products if said purchasers would see goods bearing the mark "LEONARDO";
4. The mark "LEONARDO" has not achieved the status of being an internationally known brand for goods under Class 25 and/or 18 in favor of opposer; and
5. The registration of the mark "LEONARD" in the Philippines was issued only for Class 25

On October 14, 2004 and January 26, 2005, pre-trial ensued. The parties agreed on the following issues:

1. Whether or not respondent-applicant's mark "LEONARDO" is confusingly similar with opposer's mark "LEONARD"; and
2. Whether or not opposer's mark "LEONARD" is internationally well-known.

On January 23, 2006, respondent-applicant's counsel, Atty. Jorge Cesar M. Sandiego filed a NOTICE OF WITHDRAWAL OF APPEARANCE. Though Order No. 2006-291 was issued on February 22, 2006 noting and making of record said counsel's withdrawal of appearance on behalf of respondent-applicant, Order No. 2006-514 was issued on March 29, 2006, upon motion of opposer's counsel, recalling Order No. 2006-291 and directing Atty. Jorge Cesar M. Sandiego to file within a period of ten (10) days from receipt of said Order respondent-applicant's conformity to his withdrawal. On May 16, 2006, Order No. 2006-704 was issued which ruled that Atty. Jorge Cesar M. Sandiego remains to be the counsel of record for respondent-applicant. Moreover, it is to be noted that at the hearing on June 28, 2006, said counsel manifested that he withdraws the NOTICE OF WITHDRAWAL OF APPEARANCE which the Hearing Officer noted and thereafter ruled that said counsel continues to be respondent-applicant's counsel (TSN, June 28, 2006, p.3).

Meanwhile, opposer's counsel made a formal offer of evidence at the hearing on June 7, 2006 of the following exhibits which were admitted per Order No. 2006-800 issued on June 8, 2006:

1. Exhibit "A" – Special Power of Attorney;

2. Exhibit "B" – Certificate of Registration No. 4-1994-93224 for Class 25 goods;
3. Exhibit "C" – authenticated affidavit of Nathalie Tribouillard;
4. Exhibit "D" – list/enumeration of countries where the mark "LEONARD" is registered;
5. Exhibits "E" to "E-5" – Trademark Identification Certificate in France and its English translation;
6. Exhibits "F" to "F-7" – authenticated Certificate of Registration No. 4024761 for the trademark "LEONARD" for Class 18 goods issued by the Japan Patent Office, in Japanese language and its English translation; and specimen of the mark "LEONARD" as applied for in the Japan Patent Office;
7. Exhibits "G", "G-2", "G-4", and "G-5" to "G-8" – authenticated Certificate of Registration No. 4624982 for the trademark "LEONARD and Device" for Class 18 goods issued by the Japan Patent Office, in Japanese language and its English translation, which includes Specimens of the mark "LEONARDO and Device" as applied for in the Japan Patent Office;
8. Exhibits "H" to "H-3" – authenticated certified true copy of U.S. Trademark Registration 2,150,233;
9. Exhibits "I" to "I-8" – authenticated Certificate of Registration No. 2169027 issued by the Office For The Harmonization In The Internal Market;
10. Exhibits "J" and "J-1" – photocopy of cover page of the IPO Official Gazette released on November 13, 2003 and the page of Cancellation Order 2003 – 2 showing that Registration No. 51981 for the mark "LEONARDO" is canceled;
11. Exhibits "K" to "K-18" – photocopies of advertisements and brochures for opposer's company and its products; and
12. Exhibit "L" – chronicle of the history of opposer's mark "LEONARD".

On July 27, 2006, respondent- applicant filed a FORMAL OFFER OF EVIDENCE, attaching thereto a photocopy of Certificate of Registration No. 51981 issued by this Office and a photocopy of respondent-applicant's application for re-registration of the mark "LEONARDO".

On August 7, 2006, opposer filed an OBJECTION TO SUSANA TAN'S FORMAL OFFER OF EVIDENCE, alleging that as this case has already been submitted for decision on July 25, 2006, the parties are not allowed to submit any pleading or documents other than their respective memorandum, and that respondent-applicant should have moved for the admission of such offer of evidence by filing a Motion to Admit as the FORMAL OFFER OF EVIDENCE was filed after the case has been submitted for decision.

On August 7, 2007 likewise, opposer filed an OPPOSER'S MEMORANDUM.

On October 3, 2007, Order No. 2006-1361 was issued, granting the OBEJECTION TO SUSANA TAN'S FORMAL OFFER OF EVIDENCE for which reason respondent-applicant's FORMAL OFFER OF EVIDENCE was not admitted.

As to the first issue, this Office rules in the positive.

A Side by side comparison of opposer's and respondent-applicant's respective marks shows that both marks are confusingly similar as shown below:

LEONARD

Opposers Mark



Respondent's Mark

Though respondent-applicant's mark is composite as it consists not only of the word "LEONARDO" but also three concentric ovals that encircle such word, the dominant feature of such mark is the word "LEONARDO" (See the copy of drawing of respondent-applicant's mark "LEONARDO" attached to Exhibit "1" which is respondent-applicant's response to this Office's Action paper No. 2). Comparing this mark, in turn, with opposer's mark "LEONARD", there is a striking similarity between the two in the following manner: Both marks consist of the dominant word "Leonard" which is in uppercase letters, the font and straight/vertical slant of which are almost identical; and the pronunciation of the dominant word both marks are the same. Based on the Dominancy Test, thus, the visual and aural comparison and impression created by both marks is that one mark may likely be confused as the other mark; that one's goods may likely be confused as the goods of the other and vice versa; and that the goods manufactured by one may likely be confused as having been manufactured by the other and vice versa, or that the public would likely be confused that there is some connection between opposer and respondent-applicant in terms of business which does not exist (*Societe Des Produits Nestle, S.A. and Nestle Philippines, Inc. v. Court of Appeals, et al.*, G.R. No. 104720, April 4, 2001; *Co Tlong Sa v. Director of Patents, et al.*, G.R. No. L-5378, May 24, 1954).

Before this Office decides on the merits of the second issue, a determination of whether or not the respective goods of opposer and respondent-applicant are related is in order considering that opposer's registration pertains to Class 25 goods while the subject application is for Class 18 goods.

Respondent-applicant is applying for the registration of the mark "LEONARDO" to be used for synthetic and natural leather handbags, wallets, and belts while opposer's mark "LEONARD" was registered basically for different kinds of clothing apparel and for different kinds of footwear. A reading of opposer's and respondent-applicant's respective goods shows, thus, that they are related: 1) They essentially serve the same or complementary purpose; and 2) It might be reasonably assumed that they originate from one manufacturer (*ESSO Standard Eastern, Inc. v. Court of Appeals, et al.*, G.R. No. L-29971, August 31, 1982). Moreover, although goods may be non-competing because they have different descriptive properties, they may still be considered as related if the simultaneous use on them of identical or closely similar trademarks would be likely to cause confusion as to the origin, or personal source, of the second user's goods (*Ang v Teodoro*, G.R. No. 48226, December 14, 1942).

In the instant case, they are all apparel worn either as necessities by themselves or as articles to complement each/one another. Handbags, wallets, and belts on the one hand complement clothing apparel and shoes is commonly done out of necessity, practical considerations, or aesthetic values. For instance, nylon sports bags are necessarily used and matched with sports attire and sports shoes. Certain kinds of bags are matched with certain kinds of clothing and footwear for practical considerations: For instance, large tote bags are usually matched with casual tees and jeans, and open-toed flats for errands or casual activities such as trips to the supermarket or mall. Small silk purse bags are used for aesthetic purposes during formal occasions as to complement, for instance, a dress or gown. Opposer's and respondent-applicant's goods, thus, have the same descriptive characteristics or physical attributes, and they essentially serve the same or complementary purpose.

Section 123.1 (d) of the IP Code provides:

“A mark cannot be registered if it:

(d) Is identical with a registered mark belonging to a different proprietor...in respect of:

ii. Closely related goods...or

iii. If it nearly resembles such a mark as to likely to deceive or cause confusion...”

Pursuant to the afore quoted provision, the application for registration of the subject mark may not be allowed: Opposer’s mark “LEONARD” which is confusingly similar to respondent-applicant’s mark “LEONARDO” and which is applied to goods that are closely related to respondent-applicant’s goods, is registered for goods under Class 25, with Registration No. 41994093224 and the registration having been made on August 26, 1999. To repeat, opposer has already registered a mark which respondent-applicant’s mark nearly resembles as to likely deceive or cause confusion and which is applied to goods-clothing apparel and footwear under Class 25-to which respondent-applicant’s goods under Class 18 are closely related.

With the foregoing discussion, a resolution of the issue as to whether or not opposer’s mark is well-known is now moot and academic. Section 123.1 (d) squarely applies to the instant case.

WHEREFORE, the opposition is, as it is, hereby SUSTAINED. Consequently, Application Serial No. 4-2001-004492 for the mark “LEONARDO” on goods under Class 18 filed on June 25, 2001 by Susana Tan is, as it is hereby, REJECTED.

SO ORDERED.

Makati City, 25 June 2007.

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs
Intellectual Property Office