ELPODIO VALENTINO,
Opposer,

-versus-

STEPHEN LEE KENG,
Respondent-Applicant.
x----------x

INTER PARTES CASE NO. 3472
MNO-89-016
Application Serial No. 58723
Trademark: CLUB VALENTINE
Filed: 15 April 1986
Decision No. 98-06

DECISION

On April 15, 1986, Application Serial No. 58723 for the registration of the trademark CLUB VALENTINE used on shirts, t-shirts, pants, jeans, shorts, panties, bra, socks, shoes, sandals was filed by Respondent-Applicant STEPHEN LEE KENG of Manila. The said application was published for Opposition on page 26 of Volume I, Issue No. 7 dated 31 July 1989 of the BPTTT Official Gazette.

Subsequently, on September 28, 1989, one ELPIDIO VALENTINO, a Filipino citizen of legal age and with postal address at Valentino Shoes, #48 Malaya St., Malanday, Marikina, Metro Manila, filed the Notice of Opposition to the said application. The ground relied upon by the Opposer is the alleged identicalness or confusing similarity of the trademark CLUB VALENTINE applied for by Respondent Lee Keng with his own registered trademark VALENTINO.

A timely Answer to the Notice of Opposition was filed by Respondent-Applicant. Thereafter, the case was scheduled for Pre-Trial Conference which failed to bring about an amicable settlement between the parties. After a series of postponement of hearings, counsels for both parties submitted a Stipulation of Facts which was subsequently found in order in accordance with existing rules and thus merited the approval of this Office.

A perusal of the parties' stipulations reveal uncontested allegations of Opposer and Respondent. The respective dates of first use of both parties are not disputed as well as other matters relative to the parties' legal personality and capacity to sue which will be affected by the Decision hereunder. This leaves only one issue to be resolved by this forum and it pertains to the possibility of confusing similarity between the marks "CLUB VALENTINE" of Respondent-Applicant and "VALENTINO" of Opposer. Needless to say, should the marks under consideration be found confusingly similar and inevitably leads public to the wrong conclusion as to be product they intend to purchase, the denial of Application Serial No. 58723, under the circumstances, shall be the primary duty of this Office.

Based on the approved Stipulation of Facts between the parties in the above-entitled case, the case was submitted for Decision.

The Stipulation of Facts are hereinafter reproduced verbatimly, to wit:

"1. That on February 1, 1946, Opposer adopted and started the use in lawful commerce in the Philippines of the trademark VALENTINO for shoes;

"2. That on December 1, 1972, Opposer extender the use of the trademark VALENTINO for shirts, t-shirts, pants, jeans, shorts, blouses, skirts, hankies and socks;

"3. That on August 31, 1967, Opposer was issued by this Office Registration Certificate No. 13174 for the trademark VALENTINO for use on shoes. A xerox copy of said certificate is hereto attached as Annex "A" and made an integral part hereof;

"4. That on February 27, 1981, Opposer was issued Registration Certificate No. 28953 for the trademark VALENTINO for use on shoes, in place of Annex "A" which was cancelled due to the failure of Opposer to file the required affidavit of use through oversight. A copy of said certificate is hereto attached as Annex "B" and made an integral part hereof;

"5. That on March 5, 1981, Opposer applied for the registration of the trademark VALENTINO for use on shirts, t-shirts, pants, jeans, shorts, blouses, skirts, hankies and socks under Application Serial No. 44183, which application is now pending before this Honorable Office. A copy of said application, as well as the acknowledgement of filing thereof, is hereto attached as Annexes "C" and "C-1", respectively and made integral parts hereof;

"6. That on January 31, 1981, respondent-applicant adopted and started the use in lawful commerce in the Philippines the trademark CLUB VALETINE for garments particularly shirts, t-shirts, pants, jeans, shorts, panties, bar and socks;

"7. That last April 15, 1986, respondent-applicant filed Application Serial No. 58723 for the registration of the trademark CLUB VALENTINE for use on garments particularly shirts, t-shirts, pants, jeans, shorts, panties, bra, socks, shoes and sandals;

"8. That respondent-applicant's Application Serial No. 58723 was published for opposition on page 26 of Volume I, Issue No. 7 dated July 31, 1989 of the Official Gazette;

"9. That the Notice of Opposition was filed on September 28, 1989 after Opposer was given an extension of thirty (30) days from August 30, 1989 within which to file said Notice of Opposition;

"10. That Opposer is still using up to present the trademark VALENTINO for shoes, shirts, t-shirts, pants, jeans, shorts, blouses, skirts, hankies and socks;

"11. That respondent-applicant is still using up to the present the trademark CLUB VALENTINE for shirts, t-shirts, pants, jeans, shorts, panties, bras and socks;

"12. That respondent-applicant has not used and has no intention of using the trademark CLUB VALENTINE for shoes and sandals or any other leather products."

The question now before us, as aforementioned, which is also the sole issue to be resolved by this Office: whether or not the trademark CLUB VALENTINE is identical or confusingly similar with the Opposer's trademark VALENTINO.

Section 123 (d) of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines, provides in part that a mark cannot be registered if it:

"(d) Is identical with a registered mark belonging to a different proprietor or mark with an earlier filling 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."

Without much ado on comparison and scrutiny of the two trademarks under consideration, “CLUB VALENTINE” and “VALENTINO”, one will no doubt be of the opinion that there are similarities apparent on general examination. The dominant and striking similarity lies on the word “VALENTIN”, one ends with an ‘e’, the other with an ‘o’. Though one has the word ‘club’ affixed to it, the whole picture still presents possible confusion as to which mark in their mind is associated with the goods they want to buy.

Added to this is the line of product to which both marks are being used. It did not escape the attention of this forum that both opposer and respondent-applicant are engaged in the manufacture and sale of similar products with the exception of shoes, sandals and other leather products which respondent claimed it has no intention of selling much less using their mark on the said leather products.

Both marks apparently came from the word “valentine”, though one is “Valentino”, still the first eight letters of the world identical. Now, a question arises as to whether this is sufficient to cause possible confusion to the minds of the public where they may be mislead into buying an article of a manufacturer which they would not have chosen were it not for the name or mark it bears. This Office is included to rule in the affirmative.

The likeness in the letters, similarity in the sounds, and the apparent similarity of goods to which the marks are to be found are among the many considerations that leads this Office to the conclusion in the minds of purchasers. The fact that Respondent has no intention of using mark “Club Valentine” in shoes, sandals and other leather goods much less engage in the manufacture of the said articles is irrelevant, immaterial and of no moment in the issue at hand.

It is a settled jurisprudence in Trademark Cases that it is not material whether confusion really takes place. What the law asks for is a mere possibility of confusion. ‘’Club valentine’’ and ‘’valentino’’ can easily be confused with each other and can easily be mistaken as originating from the same source.

In operators, Inc. vs. Director of Patents, 15 SCRA 147, October 29,1965, the Supreme Court had this to say;

> ‘’We find no cogent reason to disagree with the Director of Patents that ‘considering the similarities in appearance and sound between the marks AMBISCO and NABISCO, the nature and similarity of the products of the parties together with the fact that Opposer’s NABISCO has been used in commerce in the Philippines for more than fifty-five [55] years before AMBISCO was adopted by applicant, confusion of purchasers is likely.’’

Furthermore , in Co Tiong Sa vs., Director of Patents, 95 PHIL. 1, the High Tribunal had the occasion to reiterate the settled principle in trademark cases that ‘’imitation” is not necessary to constitute a violation;

> ‘’If the competing trademark contains the main or essential or dominant features of another, and confusion and deception is likely to result, infringement takes place. Duplication or imitation is not necessary; nor is it necessary that the infringing label should suggest an effort to imitate.
>
> ‘’The ordinary customer does not scrutinize the details of the label; he forget or overlooks these, but retains a general impression, or a central figure, or a dominant characteristic.
>
> “The question of infringement is to be determined by the test of dominancy. The dissimilarity in size, form, and color of the label and the place where applied are not conclusive. If the competing labels contain the trademark of another, and confusion or deception is likely to result, infringement takes place, Duplication or exact imitation is not necessary; nor is it necessary that the infringing label should suggest an effort to imitate.”

To the issued posed in this case, this Office is more than convinced that there is indeed a confusing similarity between the two marks, ”Valentino” and “Club Valentine”. For this, Respondent’s applicant must fail.

WHEREFORE, after finding merit in the Opposition and finding that there is a possibility and likelihood that purchasers may be confused as to the marks of the products subject of their purchase, this Office sustains the Opposition. Application Serial No. 28723 for the trademark CLUB VALENTINE used on shirts, t-shirts, pants, jeans, panties, bra, socks, shoes, sandals filed on April 15, 1986 by Respondent Stephen Lee Keng is, as it is , hereby REJECTED.

Let the filewrapper of this case be forwarded to the Administrative, Financial and Human Resource Development Services Bureau for appropriate action in accordance with this Decision with a copy thereof to be furnished the Bureau of Trademarks for information and update of its record.

SO ORDERED.

04 November 1998. Makati City.

ESTRELLITA BELTRAN-ABELARDO
Caretaker/Officer-In-Charge

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