

WRANGLER APPAREL CORP.,	}	Inter Partes Case No. 14-2002-00012
<i>Opposer,</i>	}	Opposition to:
	}	
	}	Appln. Serial No.: 4-1996-110782
-versus-	}	Date Filed : 21 August 1996
	}	Trademark : "GAY GIANO &
	}	DESIGN"
NELSON CHAN,	}	
<i>Respondent-Applicant</i>	}	
x-----x	}	Decision No. 2005 - 10

DECISION

This is an opposition to the registration of the mark "GAY GIANO & DESIGN" filed on August 21, 1996 bearing Serial No. 4-1996-110782 for shoes, sandals, boots, jeans, pants, slacks, t-shirts, polo shirts, briefs, shorts, socks, jogging pants, sweatshirts, jackets under class 25 of the International Classification of Goods which application was published in page 56, Vol. IV No. II issue of the Intellectual Property Office (IPO) Official Gazette and officially released for circulation on March 4, 2002.

The Opposer in the instant opposition proceedings is "WRANGLER APPAREL CORPORATION" a corporation organized and existing under the laws of the State of Delaware, United States of America with business address at 3411 Silverside Road, Wilmington, Delaware, 19810, U.S.A.

On the other hand, the herein Respondent-Applicant is "NELSON CHAN" a Filipino citizen with address at 1218 Franco corner Moriones Streets, Tondo, Manila, Philippines.

The grounds for opposition are as follows:

- "1. The trademark "GAY GIANO & DEVICE" being applied for by Respondent-Applicant is confusingly similar and identical to Opposer's trademark "GITANO", as to be likely when applied to or used in connection with the goods (clothing) of Respondent-Applicant will cause confusion, mistake and deception on the part of the purchasing public.
- "2. The registration of the trademark "GAY GIANO & DEVICE" for class 25 (clothing and shoes) in the name of Respondent-Applicant will violate Section 123(d) Intellectual Property Code which states that a mark cannot be registered if it 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 and (ii) it nearly resembles such a mark as to be likely to deceive and cause confusion. (Sec. 123 (d) Intellectual Property Code.)
- "3. The registration and use by Respondent-Applicant of the trademark "GAY GIANO & DEVICE" will diminish the distinctiveness and dilute the goodwill of Opposer's trademark GITANO.
- "4. The registration of the mark "GAY GIANO & DEVICE" in the name of Respondent-Applicant for the same goods as those of Opposer is likely to mislead the public particularly as to the nature, quality,

characteristics and origin of the goods (Sec. 123(g), Intellectual Property Code).

- “5. The registration of the mark “GAY GIANO & DEVICE” in the name of Respondent-Applicant is contrary to the provisions of the Intellectual Property Code.

In support of this opposition, Opposer relied on the following facts:

- “1. Opposer is the registrant-assignee of the mark “GITANO & Four (4) Bar Design”, Registration No. 53850, issued on November 5, 1992 under Class 25 which mark has been registered in the United States Patent & Trademark Office for Class 25 per Registration No. 1,453,287 issued on August 18, 1987.
- “2. The Opposer has acquired the mark “GITANO & Four (4) Bar Design” for extensive commercial use in the Philippines as shown in the assignment executed on July 12, 2000 by GITANO FASHION LIMITED, former owner, in favor of Wrangler Clothing Corporation, which by virtue of corporate merger has change its name to Wrangler Apparel Corporation, now the current name of the Opposer. These assignment had been recorded while the merger will still be recorded with this Honorable Office.
- “3. By virtue of Opposer’s acquisition of said mark “GITANO & 4 Bar Design” in the Philippines and its prior registration not only in the Philippines but in almost every country in the world that said name and mark GITANO has become famous as shown by a certified true copy of Intellectual Property Assignment hereto attached as Annex “A” and made integral part thereof.
- “4. The registration and use of confusingly similar mark “GAY GIANO & Device” by the Respondent-Applicant for similar goods under class 25 will deceive and confuse purchasers into believing that Respondent-Applicant’s goods and/or products bearing the mark “GAY GIANO & Device” emanate from or are confused with those of Opposer.
- “5. The registration and use of confusingly similar mark “GAY GIANO & Device” by the Respondent-Applicant will diminish the distinctiveness and dilute the goodwill of Opposer’s famous trademark “GITANO”.
- “6. It is evident that the adoption of the trademark “GAY GIANO & Device” by Respondent-Applicant which is confusingly similar and almost identical in sound and appearance to Opposer’s trademark “GITANO” was not made in good faith. There is apparently an intent to ride on the goodwill established and to “pass off” Respondent-Applicant’s goods as those of Opposer because of its worldwide popularity. Respondent-Applicant obviously intends to trade and is trading on Opposer’s goodwill and we ask why Respondent-Applicant chose the designation “GAY GIANO” when it is not Respondent-Applicant’s name. Obviously, under said circumstances there is a clear intent to ride on the popularity and reputation of the name “GITANO”.

During the pre-trial conference, the parties lamentably failed to reach an amicable settlement whereby trial on the merits conducted and the parties presented their respective evidences.

The Opposer filed its Formal Offer of Evidence consisting of Exhibits "A" to "N-2" inclusive of sub-markings which was admitted under Order No. 2004-459 dated 5 August 2004.

On the other hand, the Respondent-Applicant filed his Formal Offer of Evidence consisting of Exhibits "1" to "7", which were likewise admitted under Order No. 2004-459 dated August 05, 2004.

The only issue to be resolved in this particular case is:

WHETHER OR NOT THE MARK "GAY GIANO & DEVICE" IS
CONFUSINGLY SIMILAR TO THE MARK "GITANO" DESIGN".

To be noted in this particular case is the fact that the trademark application subject of the instant opposition was filed on August 21, 1996 during the affectivity of Republic Act No. 166, as amended.

The applicable provision of law is Section 4(d) of Republic Act No. 166, as amended, which provides as follows:

Section 4. – *Registration of trademarks, trade names and service marks on the Principal Register.* x x x The owner of a trademark, trade name or service mark used to distinguish his goods, business or services from the goods, business or services of others shall have the right to register the same on the principal register, unless it:

"x x x

"(d) consist of or comprise a mark or trade name which so resembles a mark or trade name registered in the Philippines or a mark or trade name previously used in the Philippines by another and not abandoned, as to be likely when applied to or used in connection with the goods, business or services of the applicant, to cause confusion or mistake or to deceive purchaser."

In the history of trademark cases in the Philippines, particularly in ascertaining whether one trademark is confusingly similar to or is a colorable imitation of another, no set rules can be deduced. Each case must be decided on its own merits.

In the case of "Esso Standard Eastern, Inc. vs. Court of Appeals [116, SCRA 336 (1982)] the Supreme Court held:

"But likelihood of confusion is a relative concept to be determined only according to the particular and sometimes peculiar circumstances of each case. It is unquestionably true that, as stated in "Caburn vs. Puritan Mills, Inc." in trademark cases, even more than in other litigations, precedent must be studied in the light of the facts of the particular case."

Likewise, it has been observed that:

"In determining whether a particular name or mark is a "colorable imitation" of another, no all-embracing rule seems possible in view of the great number of factors which must be necessarily be considered in resolving the question of fact, such as the class of products or business to

which the article belongs; the products quality, quantity, or size, including its wrapper or container, the dominant color, style, size, form, meaning of the letters, words, designs and emblems used; the nature of the package, wrapper or container; the character of the products, purchasers, location of business; the likelihood of deception or the mark or names tendency to confuse; etc., (Jamie N. Salazar Trademarks and Tradenames, 55 SCRA 422) to cause him to purchase the one supposing it to be the other.”

The decisive issue at bar is a simple one of *confusing similarity*.

Upon visual comparison of the Opposer’s trademark GITANO and Device and that of the Respondent-Applicant’s trademark GAY GIANO & Device, we arrive at the conclusion that no confusing similarity exist between the two marks. Theirs compositions are very different from each other. The two competing marks are composite marks. The words GITANO of Opposer and GAY GIANO & G of Respondent-Applicant, are entirely dissimilar. They differ in sound, appearance and spelling. Under the principle of *idem sonans*, two names are said to be similar only “if the attentive ear finds difficulty in distinguishing them when pronounced” (p.670, Blacks Law Dictionary, Fifth Edition). It is not so in this case. No amount of tongue-twisting exercise could make Opposer’s mark GITANO sound like Respondent-Applicant’s mark GAY GIANO. There is not much phonetic similarity between the two. More importantly, the two marks are accompanied by “Designs”, which are very different and clear before the keen eye. The Opposer’s mark is accompanied by Four (4) Bar Design, while the Respondent-Applicant’s mark is accompanied by a Design consisting of a *representation of a rapid transformation of the letter G*;

The two competing marks as illustrated below:



Opposer

Respondent-Applicant

In line with the doctrine enunciated by the Supreme Court in the case of Etepha vs. Director of Patents, G.R. No. L-20635, March 31, 1966, “in sound, appearance, form, style, size, format; ideas connoted by marks; the meaning, spelling and pronunciation of words used, the two competing marks are distinctly different and the likelihood of confusion, deception or mistake on the part of the purchasing public is far fetch.

WHEREFORE, premises considered, the Opposition filed by WRANGLER APPAREL CORPORATION is, as it is hereby DENIED. Accordingly, Application bearing Serial No. 4-1996-110782 for the mark “GAY GIANO & DEVICE” consisting of a representation of a rapid transformation of letter G filed on August 21, 1996 by NELSON CHAN is hereby allowed registration.

Let the filewrapper of GAY GIANO & Device, subject matter of this case be forwarded to the Administrative, Financial and Human Resources Development Services Bureau (AFHRDSB) for appropriate action in accordance with this DECISION with a copy furnished the Bureau of Trademarks (BOT) for information and to update its record.

SO ORDERED.

Makati City, 18 May 2005

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs