VALENTINO S.P.A.,
Opposer,

- versus -

PACIFIC RIM INDUSTRIES PTE. LTD.,
Respondent-Applicant.
x----------x

IPC No. 14-2011-00298
Opposition to:

Appln. Serial No. 4-2010-000158
(Filing Date: 06 Jan. 2010)
TM: **V (LOGO) EMILIO VALENTINO DEVICE**

Decision No. 2012 - 58

DECISION

VALENTINO S.P.A., ("Opposer")[1] filed on 31 August 2011 an opposition to Trademark Application Serial No. 4-2010-000158. The application, filed by PACIFIC RIM INDUSTRIES PTE. LTD., ("Respondent-applicant")[2], covers the mark "V (LOGO) EMILIO VALENTINO DEVICE" for use on *"belts (clothing), caps (headwear), coats, gloves, jackets, knitwear, neckties, pants, pyjamas, sandals, shirts, shoes, singlets, skirts, slippers, socks, suits, sweaters, swimsuits, tee-shirts, trousers, underclothing, underwear, uniform, vests"* under Class 25 of the International Classification of Goods and Services[3]. The Opposer alleges among other things, the following:

> "1. Opposer is the first to adopt, use and register worldwide including the Philippines, the `VALENTINO' trademark and its derivatives (collectively referred to as VALENTINO marks) and are well-known internationally and in the Philippines. Opposer, therefore, has an interest in, and the right to exclude others under Section 147 of Republic Act (R.A.) No. 8293 from registering or using identical or confusingly similar marks such as Respondent-Applicant's trademark `EMILIO VALENTINO DEVICE' for goods falling under International Class 25, pursuant also to Rule 7, Section 1(a) of the Regulations on Inter Partes Proceedings.
>
> "2. There is likelihood of confusion between Opposer's `VALENTINO' marks and Respondent-Applicant's `EMILIO VALENTINO DEVICE' mark because of respondent-Applicant's `EMILIO VALENTINO DEVICE' mark so resembles Opposer's `VALENTINO' marks in terms of appearance, sound, spelling and meaning, as to likely, when applied to or used in connection with the goods of Respondent-Applicant under Class 25, causes confusion, mistake and deception on the part of the purchasing public as being a mark owned by the Opposer, hence, the Respondent-Applicant's `EMILIO VALENTINO DEVICE' mark cannot be registered in the Philippines pursuant to the express provision of Section 147.2 of R.A. No. 8293. No doubt, the use of Respondent-Applicant's `EMILIO VALENTINO DEVICE' mark for its products under Class 25 will indicate a connection between them and those of the Opposer's.
>
> "3. The Opposer's `VALENTINO' marks for goods falling under International Classes 3, 8, 9, 11, 14, 16, 18, 19, 20, 21, 23, 24, 25, 27, 35, 36, and 43 are well-known in the Philippines, taking into account the knowledge of the relevant sector of the public, rather than public at large, as being a distinctive mark owned by the Opposer.

---

1 A foreign corporation, duly organized and existing under the laws of Italy, with business address at Via Turetic, 16/18, Milano, Italy.
2 With address at 17 Tai Seng Drive, #06-01 Yew Lee Building, Singapore 535221.
3 The Nice Classification is a classification of goods and services for the purpose of registering trademark and services marks, based on the multilateral treaty administered by the World Intellectual Property Organization. The treaty is called the Nice Agreement concerning the International Classification of goods and services for the purpose of the Registration of marks cancelled in 1957.

"4. Respondent-Applicant's appropriation and use of the `EMILIO VALENTINO DEVICE' mark under Class 25 infringes upon the Opposer's exclusive right to use as registered owner of its `VALENTINO' marks under Classes 3, 8, 9, 11, 14, 16, 18, 19, 20, 21, 23, 24, 25, 27, 35, 36, and 43 which is protected under R.A. 8293, particularly Section 147 thereof.

"5. The trademark `VALENTINO' is the dominant part of Opposer's trade/business name which under Section 165.2 of R.A. 8293 should be protected even to or without the obligation of registration.

The Opposer's evidence consists of the Affidavit executed by Mr. Gabriele Borasi and the annexes thereto, and a copy of the relevant page of the IPO Gazette containing among other things, the Respondent-Applicant's mark.[4] The annexes to Mr. Borasi's Affidavit are the photographs taken from magazines showing the products of VALENTINO, certified copy of the book *"30 Years of Magic"* containing pictures of models and works of Valentino through the years, pertinent pages from the book *"The Who's Who of the Italian Fashion"*, copy of the brochure entitled VALENTINO STORY, charts of the worldwide advertisement investments on Valentino S.p.A.'s trademark VALENTINO in Class 25 for years 2008 and 2010, collection of editorials showing Opposer's commercial use of the VALENTINO mark, Valentino's consent showing notarization date of 01 April 1987, brochures showing Opposer's boutiques and sales networks and copies of international publications and magazines, copies of articles in various international magazines from the internet bearing the VALENTINO mark, list of countries where the trademark VALENTINO have been registered, certified copies of Philippine Certificates of Registration, copies of Opposer's Certificates of Registration in various countries, copies of Opposer's numerous applications for registration covering the mark VALENTINO, copies of GFT's facsimile showing VALENTINO MISS V sales to customer Rustan and invoices, copies of some decisions rendered in China, Taiwan, and copies of relevant decisions rendered in Japan, Thailand, Taiwan and London.[5]

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 15 September 2011. The Respondent-Applicant, however, did not file an answer.

It is emphasized that the essence of trademark registration is to give protection to the owners of the 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 into the market a superior article of merchandise, the fruit of industry and skill; to assure the public that they are procuring the genuine article; to prevent fraud and imposition; and to protect the manufacture against and sale of an inferior and different article of his products[6]. In this regard, Section 123.1 (d) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides 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 the same goods or services or closely related goods or services, or if it is nearly resembles such a mark as to be likely to deceive or cause confusion.

Records show that at the time the Respondent-Applicant filed its trademark application on 06 January 2010, the Opposer already has several trademark registration or applications filed in the Philippines. These registrations cover marks that are composed of the word

---

4 Marked as Exhibits "A" and "B".
5 Marked as Annexes "A" to "V" (of Exh. 'B").
6 See *Pribhdas J. Mirpuri v. Court of Appeals*, G.R. No. 114509, 19 November 1999.

VALENTINO alone, and/or together with the word GARAVANI and/or a device dubbed as "V ellipse" which looks like this:

Some of these registrations or applications cover goods that are similar or closely related to the goods indicated in the Respondent-Applicant's application. Reg. No. 4-2008-009615 for the mark VALENTINO GARAVANI & V ELLIPSE was issued on 15 April 2010 (application filed on 08 August 2008) for use on *"belts, coats, raincoats, overcoats, blouses, pullovers, jackets, pants, gowns, dresses, suits, shirts, and chemises, t-shirts, sweaters, underwear, socks, stockings, gloves, ties, scarves, hats and caps, boots, shoes and slippers"*, while Reg. No. 4-2000-010487 for the mark V IN ELLIPSE was issued on 30 July 2006 (application filed on 22 December 2000) for use on *"suits, jackets, sport jackets, coats, overcoats, raincoats, shirts, shorts, Bermuda shorts, trousers, evening dresses, blouses, gowns, dresses, scarves, ties, brassieres, underwear, lingerie, hosiery, pajamas, jumpers, sweaters, skirts, vests, jeans, slacks, socks, stockings, bathing suits, excluding gloves and footwear."* Other trademark registrations obtained by the Opposer prior to the filing of the Respondent-Applicant's application, which also cover goods under Class 25 include Reg. No. 4-2008-009614 for the mark V IN ELLIPSE issued on 26 Nov. 2009 (application filed on 08 Aug. 2008), Reg. No. 4-1989-070274 for the mark VALENTINO issued on 25 Feb. 2010 (application filed on 13 Dec. 1989), Reg. No. 4-1990-074377 for the mark VALENTINO GARAVANI AND V LOGO issued on 02 July 2008 Class 25 (application filed on 13 Dec. 1990), and Reg. No. 4-1989-070274 for the mark VALENTINO issued on 25 Feb. 2010 (application filed on 13 Dec. 1989).

This Bureau noticed that the Respondent-Applicant's mark, as shown below:

contains the name or word VALENTINO and a stylized letter "V" which looks similar to the Opposer's "V ellipse" mark or logo. Because the mark is or will be used on goods that are similar and/or closely related to the Opposer's, it is likely that the consumers may confuse the Respondent-Applicant's mark with the Opposer's marks. The presence of the name or word "EMILIO" in the Respondent-Applicant's mark is inconsequential. Confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusing similarity exists when there is such a close ingenuous imitation as to be calculated to deceive ordinary persons, or such resemblance to the original as to deceive ordinary purchaser as to cause him to purchase the one supposing it to be the other[7]. It has been stated time and again that, "the conclusion created by use of the same word as the primary element in a trademark is not

7 See *Societe Des Produits Nestle, S.A. v. Court of Appeals*, G.R. No. 112012, 4 Apr. 2001 356 SCRA 207, 217.

counteracted by the addition of another term"[8]. It is likely that consumers may assume that one mark is just a variation of the other or there is a connection or association between the two marks and/or between the contending parties themselves, when in fact there is none.

The field from which a person may select a trademark is practically unlimited. As in a ll cases of colorable imitation, the unanswered riddle is why, of the millions of terms and combination of letters and designs 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[9].

To conclude, this Bureau finds that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) of the IP Code.

WHEREFORE, premises considered, the opposition is hereby SUSTAINED. Let the filewrapper of Trademark Application Serial No. 4-2010-000158 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 28 March 2012.

ATTY. NATHANIEL S. AREVALO
Director IV
Bureau of Legal Affairs

8 See *Continental Connector Corp. v. Continental Specialties Corp.*, 207 USPQ 60.
9 See *American Wire and Cable Co. versus Director of Patents et. al.*, [31 SCRA 544] G.R. No. L-26557 18 Feb. 1970.