

VALENTINO S.P.A.,  
Opposer,

-versus-

AULIA SINGGIH,  
Respondent- Applicant.

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}  
} IPC No. 14-2011-00402  
} Opposition to:  
} Application No. 4-2010-011505  
} Date Filed: 20 October 2010  
} TM: " ANDRE VALENTINO"

**NOTICE OF DECISION**

**SAPALO VELEZ BUNDANG & BULILAN**

Counsel for the Opposer  
11<sup>th</sup> Floor, Security Bank Center  
6776 Ayala Avenue, Makati City

**PUYAT JACINTO & SANTOS**

Counsel for the Respondent-Applicant  
12<sup>th</sup> Floor, VGP Center (Manila Bank Building)  
6772 Ayala Avenue, Makati City

**GREETINGS:**

Please be informed that Decision No. 2016 - 383 dated October 14, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 14, 2016.

**MARILYN F. RETUTAL**  
IPRS IV  
Bureau of Legal Affairs

**VALENTINO S.P.A.,**  
Opposer,

-versus-

**AULIA SINGGIH,**  
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} **IPC NO. 14-2011-00402**  
} Opposition to:  
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} Appln. Ser. No. 4-2010-011505  
} Date Filed: 20 October 2010  
} Trademark: **ANDRE VALENTINO**  
}  
}  
} Decision No. 2016- *383*

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### DECISION

**VALENTINO S.P.A.**, (Opposer)<sup>1</sup> filed an opposition to Trademark Application Serial No. 4-2010-011505. The application, filed by **AULIA SINGGIH** Respondent-Applicant<sup>2</sup>, covers the mark “**ANDRE VALENTINO**”, for use on “leather, imitations of leather, articles made from these materials and not included in other classes, skins, hides, trunks and travelling bags, umbrellas, parasols and walking sticks” under Class 18 and “clothing for men , women and children, footwear such as soles, shoes , sandals, slippers, headgear such as bandanas, caps, and top hats” under Class 25 of the International Classification of Goods<sup>3</sup>.

The Opposer based its opposition on the following grounds:

“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 interest in, and the right to exclude others under Sec. 147 of Republic Act (R.A.) No. 8293 from registering or using identical or confusingly similar marks such as Respondent-Applicant’s trademark ‘**ANDRE VALENTINO**’ for goods falling under international class 18 and 25, pursuant also to Rule 7, Section 1(a) of the Regulations on Inter Partes Proceedings.

“2. There is a likelihood of confusion between Opposer’s ‘**VALENTINO**’ marks and Respondent-Applicant’s ‘**ANDRE VALENTINO**’ mark because Respondent-Applicant’s ‘**ANDRE VALENTINO**’ mark so resembles Opposer’s ‘**VALENTINO**’ marks in terms of appearance, sound, spelling and meaning, as to

<sup>1</sup> A foreign corporation organized and existing under the laws of Italy, Via Tureti, 16/18 Milano, Italy

<sup>2</sup> Indonesian citizen with address at 67 Agus Salim, Kebon Sirih, Jakarta 10340, Indonesia

<sup>3</sup> The Nice Classification of Goods and Services is for registering trademarks and service marks based on 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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likely, when applied to or used in connection with the goods of Respondent-Applicant under classes 18 and 25, causes confusion, mistake and deception on the part of the purchasing public as being a mark owned by Opposer, hence, the Respondent-Applicant's 'ANDRE VALENTINO' mark cannot be registered in the Philippines pursuant to the express provision of Section 147.2 of R.A. 8293. No doubt, the use of Respondent-Applicant's 'ANDRE VALENTINO' mark for its products under classes 18 and 25 will indicate a connection between them and those of the Opposer's.

"3. The Opposer's 'VALENTINO' marks for goods falling under International Class 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 at large, as being distinctive mark owned by the Opposer.

"4. Respondent-Applicant's appropriation and use of the 'ANDRE VALENTINO' mark under classes 18 And 25 infringes upon the Opposer's exclusive right to use as registered owner its 'VALENTINO' marks under classes 3, 8, 9, 11, 14, 16, 18, 19, 20, 21, 23, 24, 25, 27, 35, 36 and 43, which are protected under RA 8293, particularly 147 thereof.

"5. The trademark 'VALENTINO' is also the dominant part of Opposer's trade/business name which under section 165.2 of RA No. 8293 should be protected even prior to or without the obligation of registration.

The Opposer alleges, among others, the following facts:

"1. Opposer is the owner of the 'VALENTINO' marks. The 'VALENTINO' marks which Opposer herein originated and adopted in 1959 are well-known internationally and have been registered in over ninety countries worldwide. The goods and/or services carried under said VALENTINO marks has, through the years, earned international acclaim, as well as the distinct reputation of high quality goods and services long before the application and registration of respondent-registrant's questioned mark. xxx

On the other hand Respondent-Applicant filed its application for registration of the 'ANDRE VALENTINO' mark only on October 20, 2010 under Application No. 42010011505 for goods under classes 18 and 25. xxx

"2. The 'VALENTINO' marks which originated in 1959 have acquired a strong degree of distinctiveness as marks owned by the Opposer.

The Opposer's 'VALENTINO' marks have been and are continuously being used, promoted and advertised for a considerable duration of time and over wide geographical areas. Opposer's 'VALENTINO' marks are well-known internationally and have been registered in over ninety (90) countries worldwide. They are subject of pending applications with earlier filing and registration dates, and being on commercial sale both locally and abroad.xxx

The goods carried under the said 'VALENTINO' marks had, through years, earned international acclaim, as well as distinct reputation of being high quality goods. There is already a high degree of distinction as regards Opposer's 'VALENTINO' marks.

Opposer has invested tremendous amounts of resources in the promotion of its 'VALENTINO' marks, i.e. advertisements in various international magazines, well-known newspapers and other publications around the world, amounting to a total of E10,333,212 in Euro Dollars for investments related to Class 25 products for years 2008 to 2010. Further, Opposer's sales revenues for its clothing and accessories line from 2008 to 2010 amounted to a total of E260,337; E231,906,000 and E274,309,000 in Euro respectively. xxx"

Further, the products of 'VALENTINO' and the world of 'VALENTINO' have been featured in over 300 international magazine covers worldwide, including Vogue-Company-Harper's & Queen, G.Q. (Gentlemen Quarterly), Bazaar, Men's Bazaar, Hello!, Elle, Bazaar-Gente-La Settima Incom and the like.xxx"

To support its opposition, the Opposer submitted as evidence the following:

1. Print-out of Philippine registrations for the "VALENTINO" marks;
2. Print-out of Respondent-Applicant's mark as published in the IPO Official Gazette;
3. Affidavit of Antonella Andrioli dated 13 October 2011<sup>4</sup>

The Respondent-Applicant filed its Answer on 27 February 2012, alleging among other things, the following facts and defenses:

"3. Respondent-Applicant is engaged in the business of manufacturing, designing and marketing of footwear and garments in Jakarta, Indonesia. Subsequently, Respondent-Applicant expanded her business to neighboring countries such as Singapore, Malaysia, Vietnam and now, the Philippines.

"4. Respondent-Applicant developed a brand of footwear and garments, which are chic and comfortable targeted to middle-income customers. Since 1993, she has been producing quality shoes and sandals at affordable prices, distributed and sold at major department stores in Indonesia and available at more than 60 stores throughout Southeast Asia.

"5. In the early 1990's, Respondent-Applicant decided to develop and use a brand for her footwear and men's undergarment product line. After conducting an extensive market study, Respondent-Applicant, together with her business partners, found the words 'ANDRE VALENTINO' appropriate for the business.

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<sup>4</sup> Exhibits "A" to "C" inclusive of submarkings

"5.1. The mark 'ANDRE VALENTINO' is composed of two equally important terms, 'ANDRE' from the Indonesian name of Respondent-Applicant's early business, and 'VALENTINO', specifically adopted as part of the brand to commemorate the date the Respondent-Applicant first started her business, or Valentine's day, 14 February 2013.

"5.2. On 10 March 2008, Respondent-Applicant successfully registered the mark 'ANDRE VALENTINO' for, among others, clothing, undergarments, shoes and sandals.xxx

"9.1. Opposer did not submit evidence which may be admitted in support of its Opposition. The lone document supporting the allegations in the opposition are contained in the affidavit of Opposer's witness, Ms. Antonella Andrioli. This affidavit, however, which was executed abroad and annexed to the Opposition as Exhibit 'c' was not authenticated before a Philippine consular office before the filing of the Opposition contrary to the express requirements of Section 7 (b) of Office Order No. 99.xxx

"9.2. Pursuant to Section 12.2 of Office Order No. 79, Series of 2005, affidavits of witnesses which have not been duly authenticated by the concerned Philippine consular or diplomatic office may not be admitted or allowed as evidence. xxx

"13. There is no basis for Opposer to claim exclusive use of the word 'VALENTINO' since it is not, by itself distinctive. The term 'VALENTINO' is a common surname which lay be Italian or Filipino in origin. It was neither created, nor originated by Opposer. In fact, in Italy alone, there are at least two designers marketing and selling their products under the surname 'Valentino'.

"14. Truth be told, 'VALENTINO' is a very common mark which may not be appropriated solely by Opposer under a claim of exclusivity. In the Philippines, there are already existing marks using the word 'Valenetino', some for the same class of goods as those manufactured and sold by Opposer, marks which may have been registered in the Philippine Intellectual Property Office even before Opposer registered its marks in the country. A print-out of the Philippine Trademark Search of this Honorable Office as posted in the website as of 25 January 2012 discloses at least 54 documents retrieved referring to existing registrations and pending applications involving the term 'Valentino' and variants thereof. Moreover, an online search at the Securities and Exchange Commission ('SEC') reveals that there are more than 40 registered corporations bearing the name 'Valentino', with several engaged in the garments, clothing or shoe retail business. Considering the foregoing, Opposer cannot claim exclusive right to use the word 'VALENTINO'. xxx

"21. A visual comparison of the foregoing mark with the cited marks shows that they do not bear any significant resemblance with each other. From a mere brief and casual comparison of the 'ANDRE VANETINO' against the 'VALENTINO GARAVANI & V. ELIPSE', VALENTINO GARAVANI & V LOGO' and 'VALENTINO' marks, it is clear that their general and over-all appearances are far from similar, much less confusingly so.xxx

"39.3. Opposer likewise alleges that in the Philippines, the 'VALENTINO' marks are commercially sold nationwide, with seasonal brochures distributed in Opposer's boutiques and sales network. However, the only evidence which Opposer was able to present is a facsimile acknowledgement receipt of GFT Hong Kong Limited stating that 'VALENTINO MISS V' products were sold in Rustan's Department Store dated sometime in 1997 with several sales invoices dated 1994-1997.

"39.3.1. An examination of purported sales invoices attached to the GFT Hong Kong Limited acknowledgement receipt will reveal that the items sold were for the mark 'VALENTINO MISS V', which is not even among the alleged trademarks registered or pending registration in the name of the Opposer and which marks Opposer claims are being infringed. Moreover, contrary to Opposer's allegation, a visit to the Rustan's website indicates that Valentino goods are not among the items or brands which the Department Store carries. As such, there is no basis for Opposer to claim that its marks were ever used in the Philippines.xxx"

The Respondent-Applicant submitted as evidence, the following:

1. Print-out of list of retail outlets appearing in Andre Valentino website;
2. Copy of brand certificate issued by Ministry of Justice and Human Rights for the mark "ANDRE VALENTINO";
3. List of marks bearing the word "VALENTINO" published in the IPO website;
4. List of business names of corporations duly registered with the Securities and Exchange Commission ('SEC') bearing the word 'Valentino' as published in SEC1-View; and
5. Screenshot of website of Rustan's Corporation.<sup>5</sup>

The Preliminary Conference was held on 24 September 2012 wherein the parties were directed to file their respective position papers. The Respondent-Applicant submitted her position paper on October 2012.

Should the Respondent-Applicant be allowed to register the trademark ANDRE VALENTINO?

Records show that at the time Respondent-Applicant applied for registration of the mark "ANDRE VALENTINO" on 10 October 2010, the Opposer already registered

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<sup>5</sup> Exhibits "1" to "5"

the mark "VALENTINO" under Registration No. 4-2008-070274<sup>6</sup> on 25 February 2010 and "VALENTINO GARAVANI & V LOGO" under Registration No. 4-1990074377<sup>7</sup>. The goods covered by the Opposer's trademark registration include goods under Class 25, same as indicated in the Respondent-Applicant's trademark application.

Do the competing marks depicted below, resemble each other such that confusion, even deception, is likely to occur?

Opposer's marks

VALENTINO



Respondent-Applicant's mark

**ANDRE  
VALENTINO**

Scrutinizing the composition of the trademarks involved in this case, it is observed that both marks contain the name VALENTINO, differing in that Opposer's mark includes the name GARAVANI while Respondent-Applicant includes the name ANDRE. Such similarity however, is not sufficient to conclude that confusion among the consumers is likely to occur. According to the Respondent-Applicant, ANDRE is the name she used when she began her business. The name VALENTINO commemorates the date she began her business, which is Valentine's day. Republic Act No. 8293 provides that a mark cannot be registered if it:

(c) Consists of a name, portrait or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the Philippines, during the life of his widow, if any, except by written consent of the widow

As alleged, the use of the name ANDRE VALENTINO refers to a fictitious person and not any living individual. Besides, the use of the name VALENTINO appears to be commonplace as shown in the SEC website<sup>8</sup> showing various companies incorporating the name VALENTINO in their corporate name. Visually, the consumers can easily see the difference between the two marks because they employ different name combinations, ANDRE and GARAVANI. Moreover, the Respondent-Applicant has proven that her mark was registered in Indonesia and is used in stores there. On the other hand, the Opposer while showing that its mark is advertised in several newspapers and publications<sup>9</sup> the record is bereft of evidence of commercial use in the Philippines. As correctly pointed out by the Respondent-Applicant, Opposer's evidence show that its invoice indicate the mark VALENTINO MISS S, but not its registered marks.

<sup>6</sup> Exhibit "B"

<sup>7</sup> Exhibit "B"

<sup>8</sup> Exhibit "4"

<sup>9</sup> Exhibit "C"

More importantly, the product upon which the marks are used are clothing, which are not inexpensive. The buying public should be credited with a modicum of intelligence and discernment in purchasing articles, such as clothing.

In *Emerald Garment Manufacturing Corporation v. Court of Appeals*<sup>10</sup>, the Supreme Court held:

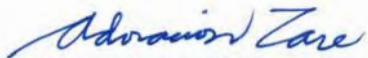
Finally, in line with the foregoing discussions, more credit should be given to the "ordinary purchaser." Cast in this particular controversy, the ordinary purchaser is not the "completely unwary consumer" but is the "ordinarily intelligent buyer" considering the type of product involved.

The definition laid down in *Dy Buncio v. Tan Tiao Bok*<sup>35</sup> is better suited to the present case. There, the "ordinary purchaser" was defined as one "accustomed to buy, and therefore to some extent familiar with, the goods in question. The test of fraudulent simulation is to be found in the likelihood of the deception of some persons in some measure acquainted with an established design and desirous of purchasing the commodity with which that design has been associated. The test is not found in the deception, or the possibility of deception, of the person who knows nothing about the design which has been counterfeited, and who must be indifferent between that and the other. The simulation, in order to be objectionable, must be such as appears likely to mislead the ordinary intelligent buyer who has a need to supply and is familiar with the article that he seeks to purchase."

**WHEREFORE**, premises considered, the instant Opposition to Trademark Application No. 4-2010-011505 is hereby **DISMISSED**. Let the filewrapper of the subject trademark be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 14 OCT 2016.

  
Atty. ADORACION U. ZARE, LL.M.  
Adjudication Officer  
Bureau of Legal Affairs

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<sup>10</sup> G.R. 100098, 29 December 1995