

PERFECT APPAREL, INC.,
Opposer,

-versus-

SANTONI SOCIETA'PER AZIONI,
Respondent-Applicant.

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} **IPC No. 14-2013-00148**
} Opposition to:
} Appln. Serial No. 4-2012-012525
} Date Filed: 11 October 2012

} **TM: SANTONI**

NOTICE OF DECISION

SIOSON SIOSON AND ASSOCIATES
Counsel for Opposer
Unit 903 AIC-Burgundy Empire Tower
ADB Avenue corner Garnet and Sapphire Roads,
Ortigas Center, Pasig City


VILLARAZA & ANGANGCO
Counsel for Respondent- Applicant
V&A Law Center
11th Avenue corner 39th Street,
Bonifacio Triangle, Bonifacio Global City,
1634 Metro Manila

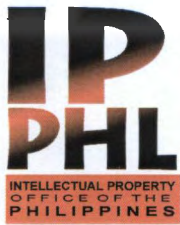
GREETINGS:

Please be informed that Decision No. 2017 - 61 dated 07 March 2017 (copy enclosed) was promulgated in the above entitled case.

Pursuant to Section 2, Rule 9 of the IPOPHL Memorandum Circular No. 16-007 series of 2016, any party may appeal the decision to the Director of the Bureau of Legal Affairs within ten (10) days after receipt of the decision together with the payment of applicable fees.

Taguig City, 08 March 2017.


MARILYN F. RETUAL
IPRS IV
Bureau of Legal Affairs



PERFECT APPAREL, INC.,
Opposer,

IPC No. 14-2013-00148
Opposition to:

- versus -

Appln. No. 4-2012-012525
Date Filed: 11 October 2012
Trademark: "SANTONI"

SANTONI SOCIETA' PER AZIONI,
Respondent-Applicant.

Decision No. 2017 - 61

X ----- X

DECISION

PERFECT APPAREL, INC. ("Opposer")¹ filed a verified opposition to Trademark Application Serial No. 4-2012-012525. The application, filed by SANTONI SOCIETA' PER AZIONI ("Respondent-Applicant")², covers the mark "SANTONI" for use on following classes of goods³: **18** for *"leather and imitation of leather, goods made from these materials, not included in other classes, trunk and suitcases, umbrellas, parasols, walking sticks, rucksacks, all-purpose sport bags, travelling bags, garment bags, duffel bags, brief cases, purses, wallets, bags and clutch bags, carrier bags made of fabric, wheeled carrier bags, tote bags, leather leashes, book bags, satchel cases, sport bags, beach bags, should bags, waist-bags, empty cosmetic bags;"* and, **25** for *"clothing items, namely: sweaters, cardigans, waistcoats, suits, trousers, shorts, jumpers, raincoats, clothing made of leather, stockings and socks, stocking suspenders, sock suspenders, wind resistant jackets, ski trousers, fur coats, overcoats, skirts, dresses, jackets, undershirts, t-shirts, jerseys and breeches for sports, blouses, shirt collars, shirts, foulards, beachwear, swimsuits, bikini, tracksuits; wedding dresses; underwear, bras, brassiere, corsets, underpants, briefs, vests, nightgowns, negligees, pyjamas, gloves, shawls, scarves, neckties, bowties, belts (clothing) suspenders, hats, caps; shoes; boots, half boots, leather shoes, galoshes, rain boots, sports footwear, sandals, slippers, shoe soles, shoe heels, footwear uppers."*

The Opposer alleges that it is the registered owner of the trademark "SANTONI WITH POCKET DESIGN" for use on jeans, skirts, jackets, children's wear, t-shirts, briefs, towels, belts, blouses, socks, bags, shoes, handkerchief in Classes 18, 24 and 25, under Registration No. 53643 issued on 13 October 1992 and renewed last 11 February 2013. Opposer is also the registered owner of the trademark "SANTONI & REP. OF SMOKING MAN WITHIN TRIANGULAR DEVICE" for use on t-shirts, jeans, pants, blouses, polo shirts, jackets, brief, bra and socks in Class 25 under Registration No. 35987 issued on 29 September 1986 and renewed on 29 September 2006.

According to the Opposer, it adopted and first used the marks "SANTONI WITH POCKET DESIGN" and "SANTONI & REP. OF SMOKING MAN WITHIN TRIANGULAR DEVICE" on 01

¹ A corporation duly organized and existing under the laws of the Philippines with postal and business address at 1072 Carmen Planas Street, Tondo, Manila.

² With address at Via Monte Napoleone 91 20121 Milano (MI), Italy.

³ The Nice Classification of goods and services is for registering trademark and service marks, based on a 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.

January 1983 and has continued to the present. Thus, the approval of the application in question is contrary to Sections 123.1 (d), 138, and 147 of the Intellectual Property Code. Accordingly, it will violate Opposer's right to the exclusive use of its registered trademarks and cause irreparable damage and injury.

The Opposer further alleges that the trademark "SANTONI" being applied for registration by the Respondent-Applicant, is identical and/or confusingly similar to Opposer's registered trademarks "SANTONI WITH POCKET DESIGN" and "SANTONI & REP. OF SMOKING MAN WITHIN TRIANGULAR DEVICE". Through the nationwide and continuous use since 01 January 1983 of these trademarks, the Opposer has acquired valuable goodwill and business reputation over said marks which merits protection. The approval of the subject application will cause irreparable damage and injury to the Opposer and the consuming public as the latter will likely think and assume that Opposer has expanded its business operation and that Respondent is an affiliate and/or a business associate authorized by the Opposer to register and use the opposed mark.

The Opposer submitted the following evidence:

1. Certified True Copy (CTC) of Certificate of Registration No. 53643;
2. CTC of the Petition for Renewal of Registration No. 53643;
3. Copy of the Certificate of Renewal of Registration No. 00053643;
4. CTC of Certificate of Registration No. 35987;
5. CTC of the Certificate of Renewal of Registration No. 35987;
6. CTCs of the Affidavits of Use/Declaration of Actual Use following the 5th, 10th and 15th anniversaries of Registration No. 53643;
7. CTCs of the Affidavits of Use/Declaration of Actual Use following the 5th, 10th and 15th anniversaries of Registration No. 35987;
8. CTCs of Opposer's representative Sales Invoices and photographs using the registered marks SANTONI WITH POCKET DESIGN and SANTONI & REP. OF SMOKING MAN WITHIN TRIANGULAR DEVICE;
9. Printout of Application Serial No. 4-2012-012525 as published in the e-Gazette; and,
10. Duly notarized affidavit of Nenita Salviejo, President of Perfect Apparel, Inc.

On 09 May 2013, Respondent-Applicant filed its Answer, alleging among others, that while its mark "ANDREASANTONI" may be identical with Opposer's registered marks "SANTONI WITH POCKET DESIGN" and "SANTONI & REP. OF SMOKING MAM WITH TRIANGULAR DEVICE" with an earlier filing date, however, it fraudulently uses the surname "Santoni" of Andrea Santoni, the founder of Respondent-Applicant; and his son, Giuseppe Santoni, who are both living individuals who did not give written consent to Opposer for the use of their surname. Additionally, Opposer's registered marks "SANTONI WITH POCKET DESIGN" and "SANTONI & REP. OF SMOKING MAN WITHIN TRIANGULAR DEVICE" are identical with, or confusingly similar to Opposer's marks which are well-known internationally and in the Philippines, whether or not it is registered in this jurisdiction, as being already the marks of Respondent-Applicant, and used for identical or similar goods or services.

Respondent-Applicant stated that it is the registered owner and prior user of the internationally well-known marks "Andrea Santoni", "AndreaSantoni", "Santoni Gloria", "Santoni in Chinese Characters", "Santoni in Russian Characters", "Santoni in Japanese Characters", "Santoni Legenda", "Santoni Nauticus", "Santoni Nuvola", "Santoni Shabby Chic", "Santoni", and "Santoni with Drawing". It has also pending registrations worldwide and has been using the aforementioned marks for goods under International Classes 3, 9, 14, 18, 25 and 35. Since its creation in 1975, Respondent-Applicant pursued its vision refining the cultural heritage of craftsmanship and Italian excellence. Born with the creation of the haut de gamme shoes laboratory by "Andrea Santoni", the brand's legacy has been handed to his son

Giuseppe, making the brand an international icon with 400 employees and a turnover of more than 50 million Euros. Respondent-Applicant averred owning several stores located worldwide to sell its goods and services, and published its marks in countless editorials from the most prestigious fashion and lifestyle magazines worldwide.

The Respondent-Applicant submitted the following evidence:

1. Summary of International Registrations of Respondent-Applicant's trademarks;
2. Photocopy of Respondent-Applicant's Application Form for the mark SANTONI with attachments;
3. Photocopy of the Notice of Allowance Paper for the mark SANTONI SOCIETA' PER AZIONI's application; and,
4. Copy of the list of some of the editorials from fashion and lifestyle magazines worldwide.

On 21 May 2013, the Opposer in its Comment to Respondent-Applicant's Answer cited the irresponsible and unsubstantiated allegation of the latter that it has no valid registration with the Securities and Exchange Commission and the Department of Trade and Industry. Conversely, the Opposer attached a certified machine copy of the Certificate of Incorporation issued by the Securities and Exchange Commission and its Articles of Incorporation.⁴ Thereafter, Respondent-Applicant filed its Reply to Opposer's Comment⁵, and the corresponding Motion to Expunge by the Opposer. An examination of these documents show that Respondent-Applicant's arguments in its Reply, functions to supplement its Answer. This Bureau therefore resolves to expunge Respondent-Applicant's Reply. Under the applicable rules⁶, the instant motion is deemed prohibited because pleadings subsequent to the filing of an Answer in Inter Partes Cases shall not be allowed.

After the preliminary conference, the parties submitted their respective position papers on 14 February 2014. Consequently, this instant case is submitted for decision.

Should the Respondent-Applicant be allowed to register the trademark SANTONI?

A careful perusal of the records show that at the time Respondent-Applicant filed its application for registration of the trademark "SANTONI" on 11 October 2012⁷, herein Opposer already has registration for the trademark "SANTONI WITH POCKET DESIGN" with Certificate of Registration No. 53643 dated 13 October 1992⁸; and filed a Petition for Renewal on 11 February 2013⁹. In addition, Opposer has registration for the trademark "SANTONI & REP. OF SMOKING MAN WITHIN TRIANGULAR DEVICE" with Certificate of Registration No. 35987 dated 29 September 1986¹⁰; and a Certificate of Renewal of Registration¹¹. Moreover, Opposer presented Affidavits of Use/Declaration of Actual Use following the 5th, 10th and 15th anniversaries of the mentioned trademarks.¹²

⁴ Attached in the Comment to Respondent-Applicant's Answer.

⁵ 06 September 2013.

⁶ Sec. 11, Rule 2, Office Order No. 99, Series of 2011 or Amendments to the Rules and Regulations on Inter Partes Proceedings. Section 11. Prohibited pleadings.-No motion to dismiss shall be entertained. Instead, all grounds for dismissal shall be pleaded as affirmative defenses, the resolution of which shall be made in the decision on the merits. Neither shall a motion for bill of particulars, motion for reconsideration of interlocutory orders, and all other pleadings subsequent to the filing of an Answer, shall be allowed.

⁷ Filewrapper records.

⁸ Exhibit "A" of Opposer.

⁹ Exhibit "B" of Opposer.

¹⁰ Exhibit "C" of Opposer.

¹¹ Exhibit "D" of Opposer.

¹² Exhibits "E" and "F" with sub-markings of Opposer.

Under the law, a certificate of registration constitutes a prima facie evidence of the validity of the registration, the registrant's ownership of the mark, and of the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate.¹³ In fact, the owner of a registered mark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs or containers for goods or services which are identical or similar to those in respect of which the trademark is registered where use would result in a likelihood of confusion.¹⁴ In the instant case, the Opposer showed sufficient proof of ownership. In addition to the registration certificates issued in its behalf, it likewise submitted sales invoices confirming actual and continuous presence and use of its trademarks in the Philippines.¹⁵

Respondent-Applicant however, alleged ownership and prior use of the internationally well-known marks containing the word "SANTONI". It also contended that Opposer fraudulently used the surname "Santoni" of its founder, without consent. However, these allegations are not supported or substantiated by documentary evidence. Respondent-Applicant's submissions are mere photocopies of original documents, therefore, violation of the admissibility of evidence.¹⁶ Granting arguendo that the documents are admissible, the Opposer still failed to rebut the prima facie validity of Respondent-Applicant's registration. Opposer merely showed a list of international registrations of its trademarks. They are not verified and/or authenticated, and bears no assurance of legal credibility. Thus, bare allegations, unsubstantiated by corroborating evidence, are not equivalent to proof. In short, mere allegations are not evidence.¹⁷

But are the competing marks, as shown below, confusingly similar?



Opposer's Trademarks

Santoni

Respondent-Applicant's Trademark

¹³ Sec. 138, Intellectual Property Code (IP Code).

¹⁴ Sec. 147, IP Code.

¹⁵ Exhibits "G" to "G-3" of Opposer.

¹⁶ Sec. 7, Rule 2, Office Order No. 99, Series of 2011 or Amendments to the Rules and Regulations on Inter Partes Proceedings.

¹⁷ Dra. Dela Llana vs. Rebecca Biong, doing business under the name and style of Pongkay Trading, G.R. No. 182356, 04 December 2013

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Obviously, the competing marks contain the identical word "SANTONI" Further, they cover similar and/or related goods, more particularly classes 18 and 25. These goods are found in the same channels of business and trade and/or cater its products to the same segment of consumers.

Confusion cannot be avoided by the miniscule differences in the trademarks. Confusing similarity exists when there is such a close or 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.¹⁸ Colourable imitation does not mean such similitude as amount to identify, nor does it require that all details be literally copied. Colourable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark with that of the other mark or trade name in their over-all presentation or in their essential substantive and distinctive parts as would likely to mislead or confuse persons in the ordinary course of purchasing the genuine article.¹⁹

Also, considering the similarity or relatedness of goods carried by the contending marks, the consumers will have the impression that these products originate from a single source or origin or they are associated with one another. The likelihood of confusion therefore, would subsist not only on the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:²⁰

Cullman notes two types of confusion. The first is the confusion of goods in which event the ordinarily prudent purchaser would be induced to purchase one product in the belief that he was purchasing the other. In which case, defendant's goods are then bought as the plaintiff's and the poorer quality of the former reflects adversely on the plaintiff's reputation. The other is the confusion of business. Hence, though the goods of the parties are different, the defendant's product is such as might reasonably be assumed to originate with the plaintiff and the public would then be deceived either into that belief or into belief that there is some connection between the plaintiff and defendant which, in fact does not exist.

Thus, Sec. 123.1 (d) of the IP Code provides:

A mark cannot be registered if it:

x x x

(d) 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, 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;

Corollarily, the public interest requires that the two marks, identical to or closely resembling each other and used on the same and closely related goods, but utilized by different proprietors should not be allowed to co-exist. Confusion, mistake, deception, and even fraud, should be prevented, It is emphasized that the function of 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 his industry and skill; to assure the public that they are procuring the

¹⁸ Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 04 April 200, 356 SCRA 207, 217.

¹⁹ Converse Rubber Corporation v. Universal Rubber Products, Inc., et al., G.R. No. L-27906, 08 January 1987.

²⁰ Id.

genuine article; to prevent fraud and imposition; and to protect the manufacturer against substitution and sale of an inferior and different article as his product.²¹

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2012-012525 is hereby **SUSTAINED**. Let the file wrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City 07 MAR 2017



Atty. GINALYN S. BADIOLA, LL.M.
Adjudication Officer, Bureau of Legal Affairs

²¹ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.