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| NEW BARBIZON FASHION, INC., | } | IPC NO. 14-2007-00330 |
| Opposer, | } | Opposition to: |
| | } | Application Serial No. 4-2005-009348 |
| -versus- | } | Date Filed: September 21, 2005 |
| | } | Trademark: SASA (STYLIZED) |
| SA SA OVERSEAS LIMITED, | } | |
| Respondent-Applicant. | } | Decision No. 2009-06 |
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DECISION

For decision is the Notice of Opposition filed by NEW BARBIZON FASHION, INC., herein after referred to as opposer, a corporation duly organized and existing under the laws of the Philippines, with office address at Unit 401, VFP-MDC Veterans Center, 1630 Taguig, Metro Manila against Application Serial No. 4-2005-009348 for the mark "SASA (STYLIZED)" on the following goods under Class 16, 41 and 25 namely; Class 16- "paper, cardboard and goods made from these materials, not included in other classes; magazines, books, pamphlets, posters, printed cards, circulars, catalogues, calendars, price tags, price labels, printed matters; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; instructional and teaching material (except apparatus); plastic materials for packaging; carry bags of paper, cardboard and plastic"; Class 41- "educational services relating to health, make up, beauty care, beauty treatment, pharmaceutical and medical services, provision of training courses in relation to make-up; conducting classes, seminars, and conferences in the fields of make-up, beauty care, beauty treatment, pharmaceutical and medical services and in relation to weight control and weight reduction; providing on-line electronic publications; physical fitness instruction, training services relating to fitness, exercise fitness training services and health club fitness services; gymnasium services relating to body building and weight training, gymnasium club services; provision of gymnasium facilities; provision of health club services"; Class 25- "Clothing, scarves, gloves, belts (not made of leather), footwear and headgear", filed by SA SA OVERSEAS LIMITED, hereinafter referred to as Respondent-applicant, a corporation organized and existing under the laws of the British Virgin Islands with address at the Offshore Incorporation Centre Road Town, Tortola, British Virgin Islands.

The grounds relied upon in the opposition are as follows:

1. The Opposer is the first to adopt, use and file an application for the registration of the trademark "SASSA" in the Philippines, for several goods under Class 25, among which are sports wear, swim wear, t-shirts, pants and dresses, and therefore enjoys under Section 147 of Republic Act (R.A.) No. 8293, the right to exclude others from registering or using an identical or confusingly similar mark such as Respondent-Applicant's mark "SA SA" for similar and identical goods, i.e., sports wear, swim wear, t-shirts, pants and dresses.
2. The "SASA" mark resembles the "SASSA" trademark of Opposer, in sound, spelling, and appearance as to be likely to deceive or cause confusion as contemplated under Section 123(d), R.A. 8293.
3. The Opposer's "SASSA" trademark, used among others, for sports wear, swim wear, t-shirts, pants and dresses, is well-known in the Philippines, taking into account the knowledge of the relevant sector of the public, as being a trademark owned by Opposer.
4. The Respondent-Applicant, in adopting "SASA" for sports wear, swim wear, t-shirts, pants and dresses, is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection or association with the Opposer, or as to origin, sponsorship, or approval of its goods by the Opposer,

for which it is liable for false designation of origin; false description or representation under Section 169 of R.A. No. 8293.

Opposer submitted the following evidence:

| EXHIBIT | DESCRIPTION |
|---------|---|
| "A" | Sales Invoices |
| "B" | Sample Hangtags |
| "C" | Sample tags |
| "D" | Trademark Application No. 4-2007-008151 |
| "E" | Trademark Application No. 4-2007-009211 |
| "F" | newspaper clippings |
| "G" | copies of magazines, posters |
| "H" | Brochures |
| "I" | Pictures |
| "J" | Sales Invoices |
| "K" | Picture of display at outlets |
| "L" | Compact Disc |

In the Answer filed by the respondent-applicant on 9 April 2008, it raised the following specific denials:

"For lack of knowledge or information sufficient to form a belief as to the truth or falsity thereof, respondent-applicant specifically denies the allegations in the Opposition contained in:

1. The second sentence of the first paragraph on page 1, in so far as it alleged the circumstances of the opposer, its business address, and that it will be damaged by respondent-applicant's application.

2. Second paragraph on page 1, insofar as it alleged the grounds on which opposer lodges its opposition, particularly that:

2.1. Opposer is the first to adopt, use and file an application for the registration of the trademark "SASSA" in the Philippines, for several goods under Class 25, among which are sports wear, swim wear, t-shirts, pants and dresses and therefore enjoys under Section 147 of Republic Act No. 8293 the right to exclude others from registering or using an identical or confusingly similar mark,

2.2. "SASA" mark resembles the "SASSA" trademark in sound, spelling and appearance,

2.3. The opposer's trademark is well-known in the Philippines, and

2.4. The trademark of respondent-applicant is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection or association with the opposer, or as to origin, sponsorship or approval of its goods by the opposer for which it is liable for false designation of origin; false description under Section 169 of R.A. N. 8293.

3. The four paragraphs on page 3, insofar as it was alleged that the opposer's date of first use and filing date of application of the trademark "SASSA" are earlier than the filing date of respondent-applicant's application for registration of the "SA SA" trademark, that opposer is the registered owner of the mark "SASSA" under Application No. 4-2007-008151 and that the opposer has a pending application for the registration of the "SASSA ACTIVEWEAR & LOGO" trademark under Application No. 4-2007-009211 for class 25 goods.

4. Paragraphs 2 and 2.1 on page 4, in so far as it is alleged that the "SA SA" mark nearly resembles the "SASSA" mark of the opposer in terms of appearance, sound and the goods which the two competing marks pertain to.

5. Paragraph 3 on page 4 to include the sub-paragraphs thereto, in so far as it is alleged that the trademark "SASSA" is well known in the Philippines.

6. Paragraphs 4 and the sub-paragraphs thereto on page 6, in so far as it is alleged that the use of respondent-applicant's "SA SA" mark would indicate a connection between its goods and the goods of opposer's "SASSA" trademark resulting to damage to the interests of the latter.

7. Paragraph 5 on pages 6 to 7, in so far as it is alleged that the affidavit of its witness is attached to support the allegations stated therein."

The issues for consideration are: whether the opposer is the prior adopter and user of the mark SASSA, whether the mark is confusingly similar to respondent-applicant's mark, whether opposer's mark can be considered well-known and consequently, whether the mark SASSA (STYLIZED) can be registered.

The sales invoice dated 19 September 2003 (Exhibit "A") of opposer indicated that it has sold merchandise bearing the SASSA mark in the year 2003. Opposer submitted its sales hangtags/labels (Exhibit "B") purportedly used in its commercial dealings using the SASSA mark. Opposer also submitted newspaper articles, magazines, brochures (Exhibits "F", "G" and "H") which contain advertising of the merchandise with the SASSA mark. To prove its being well-known, opposer submits liquidation reports indicating sales in various stores (Exhibit "J"). In addition, it also presented pictures of actual display of its mark in store outlets. (Exhibit "K"). Therefore, it is clear that opposer has earlier use of the mark SASSA for goods under class 25.

Opposer claims to have filed an application for the mark "SASSA" as early as 23 March 2003 but no evidence was submitted to prove this fact. On the other hand, file wrapper shows that respondent-applicant filed its application for the mark SASSA (STYLIZED) on 21 September 2005 for goods under class 16, 25 and 41. It appears that opposer filed an application for the mark SASSA for goods under class 25 on 30 July 2007 as evidenced by a photocopy of Application No. 4-2007-008151 (Exhibit "D") and Application No. 4-2007-009211 for the mark SASSA ACTIVEWEAR & LOGO covering goods under class 25 on 23 August 2007 (Exhibit "E").

Respondent-applicant in a Manifestation filed with the Bureau on 8 May 2008 stated that it has filed a Manifestation with the Bureau of Trademarks that it was deleting or removing its claim to Class 25 but retained its claim to class 16 and 41 in the challenged application. In view of this event, the issue for discussion would be whether there the opposer's mark SASSA and respondent-applicant's mark SASSA (STYLIZED) are confusingly similar when used by opposer on goods under class 25 while respondent-applicant's use is for goods under classes 16 and 41.

Section 123.1 of Republic Act No. 8293 (IP Code) provides:

“Section 123. Registrability – 123.1. A mark cannot be registered if it:

(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;”

The contending marks are SASA (STYLIZED) and SASSA which are phonetic equivalents and have the same literal elements except for an additional letter “S” when used by the opposer. The marks of the parties sound the same when pronounced. In spite of this, the Bureau believes that no confusion is likely to result because the marks are used on different classes of goods. even if evidence points out to the earlier adoption and use by the opposer of the mark SASSA for clothing under Class 25, no confusion will result by respondent-applicant’s adoption of a similar sounding mark for goods under Class 16, namely: “Paper, cardboard and goods made from these materials, not included in other classes; magazines, books, pamphlets, posters, printed cards, circulars, catalogues, calendars, price tags, price labels, printed matters; bookbinding material; photographs; stationery; adhesives for stationery or household purposes; instructional and teaching material (except apparatus); plastic materials for packaging; carry bags of paper, cardboard and plastic”; and Class 41, namely: “Educational services relating to health, make up, beauty care, beauty treatment, pharmaceutical and medical services, provision of training courses in relation to make-up; conducting classes, seminars, and conferences in the fields of make-up, beauty care, beauty treatment, pharmaceutical and medical services and in relation to weight control and weight reduction; providing on-line electronic publications; physical fitness instruction, training services relating to fitness, exercise fitness training services and health club fitness services; gymnasium services relating to body building and weight training, gymnasium club services; provision of gymnasium facilities; provision of health club services”.

As regards the application of the mark SASA (STYLIZED) for goods under class 25, there is no need to belabor the issue of confusing similarity as the same has become moot and academic, in view of the respondent-applicant’s deletion of goods under class 25.

The mere fact that a mark has been adopted by one person does not prevent the adoption of the same mark for dissimilar goods. In *Philippine Refining Co., Inc. v. Ng Sam GR No. I-26676*. 30 July 1982, the Supreme Court explained:

“A rudimentary precept in trademark protection is that “the right to a trademark is a limited one, in the sense that others may use the same mark on unrelated goods (Sec. 221, Nims, *Unfair Competition and Trade Mark*, Vol. 1, p. 657). Thus, as pronounced by the United States Supreme Court in the case of *American Foundries v. Robertson* (269 US 372, 381, 70 L ed 317, 46 Sct. 160), “the mere fact that one person has adopted and used a trademark on his goods does not prevent the adoption and use of the same trademark by others on articles of a different description.” Such restricted right over a trademark is likewise reflected in our Trademark Law. Under Section 4(d) of the law, registration of a trademark which so resembles another already registered or in use should be denied, where to allow such registration could likely result in confusion, mistake or deception to the consumers. Conversely, where no confusion is likely to arise, registration of a similar or even identical mark may be allowed.”

As regards to opposer’s assertion that its mark is well-known in the Philippines is devoid of merit. Assuming that it is well-known in the Philippines, the same does not

afford the opposer relief against the respondent-applicant's claim to the mark SASA (STYLIZED). The law states:

"Sec. 123., Registrability. 123.1 A mark cannot be registered if it:

x x x

(e) Is identical with, or confusing similar to, or constitute a translation of a mark which is considered by the competent authority of the Philippines to be well-known internationally and in the Philippines, whether or not it is registered here, as being already the mark of a person other than the applicant for registration, and used for identical or similar goods or services: *Provided*, That in determining whether a mark is well-known, account shall be taken of the knowledge of the relevant sector of the public, rather than of the public at large, including knowledge in the Philippines which has been obtained as a result of the promotion of the mark;

Meanwhile, Rules 102 of the Rules and Regulations on Trademarks, Service Marks, Trade Names and Marked or Stamped Containers provides:

"Rule 102. Criteria for determining whether a mark is well-known. In determining whether a mark is well-known, the following criteria or any combination thereof may be taken into account:

- (a) the duration, extent and geographical area of any use of the mark, in particular, the duration, extent and geographical area of any promotion of the mark, including advertising or publicity and the presentation, at fairs or exhibitions, of the goods and/or services to which the mark applies;
- (b) the Market share, in the Philippines and in other countries, of the goods and/or services to which the mark applies;
- (c) the degree of the inherent or acquired distinction of the mark;
- (d) the quality-image or reputation acquired by the mark;
- (e) the extent to which the mark has been registered in the world;
- (f) the exclusivity of registration attained by the mark in the world;
- (g) the extent to which the mark has been used in the world;
- (h) the exclusivity of use attained by the mark in the world;
- (i) the commercial value attributed to the mark in the world;
- (j) the record of successful protection of the rights in the mark;
- (k) the outcome of litigations dealing with the issue of whether the mark is a well-known mark; and
- (l) the presence or absence of identical or similar marks validly registered for or used on identical or similar goods or services and owned by persons other than the person claiming that his mark is well-known mark."

That opposer's goods have been sold in the Philippines since 2005 does not sustain the finding of it achieving a status of being well-known in accordance with the criteria set under the law.

WHEREFORE, premises considered the OPPOSITION filed by New Barbizon Fashion, Inc., opposer is hereby DISMISSED. Accordingly, Application Serial No. 4-2005-009348 filed by Respondent-Applicant, SA SA Overseas Limited, Inc. on 21 September 2005 for registration of the mark "SASA (STYLIZED)" used on goods under Classes 16, 41, is as it is hereby GIVEN DUE COURSE. The OPPOSITION against Application Serial No. 4-2005-009348 for registration of the mark on goods under Class 25 has been rendered MOOT and ACADEMIC in view of respondent-applicant's withdrawal of its application for the mark "SASA (STYLIZED)" for goods under Class 25.

Let the filewrapper of "SASA (STYLIZED)", subject matter of this case together with this Decision be forwarded to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 19 January 2009.

ESTRELLITA BELTRAN-ABELARDO
Director, Bureau of Legal Affairs
Intellectual Property Office