

SUYEN CORPORATION,
Opposer,

-versus-

SHAPESHIFTER SURF PRODUCTS, INC.,
Respondent- Applicant.

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} IPC No. 14-2014-00522
} Opposition to:
} Appln. Serial No. 1206561
} Date Filed: 12 April 2014
} TM: "SHAPESHIFTER"
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NOTICE OF DECISION

MIGALLOS & LUNA LAW OFFICES
Counsel for the Opposer
7th Floor, The PHINMA Plaza
39 Plaza Drive, Rockwell Center
Makati City

SHAPESHIFTER SURF PRODUCTS, INC.
Respondent-Applicant
10835 Sorrento Valley Rd.
San Diego, CA 92121
USA

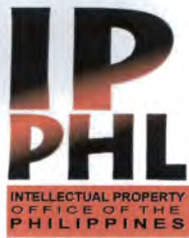
GREETINGS:

Please be informed that Decision No. 2016 - 206 dated June 30, 2016 (copy enclosed) was promulgated in the above entitled case.

Taguig City, June 30, 2016.

For the Director:

MARILYN F. RETUTAL
IPRS IV
Bureau of Legal Affairs



SUYEN CORPORATION,
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-versus-

SHAPESHIFTER SURF
PRODUCTS, INC.,
Respondent-Applicant.
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IPC No. 14-2014-00522
Opposition to:

Appln. Serial No. 1206561
Date Filed: 12 April 2014
TM: "SHAPESHIFTER"

Decision No. 2016 - 206

DECISION

SUYEN CORPORATION ("Opposer")¹ filed an opposition to Trademark Application Serial No. 1206561. The application filed by SHAPESHIFTER SURF PRODUCTS INC. ("Respondent-Applicant")² covers the mark "SHAPESHIFTER" for "*bags especially designed for surfboards; boards used in the practice of water sports; kits for building surfboards; leashes for surfboards; paddle boards*" under class³ 28 of the International Classification of Goods and Services.

The Opposer alleges the following grounds for opposition:

"3.1 The Intellectual Property Code (the 'IP Code') precludes the registration of a mark which " 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 x x

"3.2 Respondent-Applicant seeks to register the mark 'SHAPESHIFTER' which is identical to and confusingly similar with the Suyen's 'SHAPE SHIFTER' trademark. The use by respondent-applicant of its mark will certainly result in a common perception that respondent-applicant's products are connected with Suyen or under the sponsorship of Suyen.

The facts are provided as follows:

"2.1 Suyen Manufactures, distributes, markets and sells apparel and lifestyle products carrying different brands and trademarks, including its flagship brand BENCH'. From its incorporation in 1985 as a manufacturing company dealing in clothing apparel, garments and accessories, Suyen has become, and continues to make its mark, as a leading lifestyle retailer in the Philippines and the region. x x x

"2.3 Suyen has grown and continues to grow at an unparalleled rate by being the pioneer in the use of celebrity endorsers, television and giant billboards to propel the growth of its fashion brands that offer premium quality products at affordable prices. Other popular and successful

¹ A corporation organized and existing under the Philippine laws with office at 2214 Tolentino Street, Pasay City.
² A foreign corporation with address at 10835 Sorrente Valley Rd. San Diego CA 92121, United States.
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.

brands owned by Suyen include 'FIX BENCH SALON', 'HUMAN', 'DIMENSIONE', 'PCX', and 'KASHIECA', among others. x x x

“2.7 Suyen has become a household name in the retail industry, associated with premium and highly quality products that are one hundred percent (100%) Filipino. Suyen has likewise become a global company with a brand presence outside the Philippines. At present, Suyen has over four hundred (400) trademarks registered in its name in the Philippines and abroad. x x x

“2.12 Suyen adopted and used the trademark and word 'FIX' and other derivative marks to clearly identify their FIX Products. Suyen first used the FIX Trademarks in March 20001 and has continuously used the said trademarks since then. x x x

“2.15 Suyen’s hair care products under FIX Trademarks and brand have become immensely popular in the market. They have achieved outstanding market sales and have become one of the leading and most successful locally-manufactured hair care brands.

“2.16 There are at present over twenty-five (25) hair products bearing the FIX Trademarks. x x x

“2.17 One such product is a styling wax or 'shaping fiber crème' marketed and sold by Suyen under the BENCH/FIX PROFESSIONAL sub-brand 'SHAPE SHIFTER'. Suyen first adopted and used 'SHAPE SHIFTER' on 01 July 2009 when the styling cream was first released in the market. x x x

“2.18 Suyen filed a Trademark Application for the registration of its trademark 'SHAPE SHIFTER' with the IPOPHL on 17 December 2010, and obtained said registration on 12 May 2012 under Certificate of Registration No. 13771. On 03 December 2013, or within three (3) years from registration, Suyen filed its Declaration of Actual Use for 'SHAPE SHIFTER' as required by Section 124.2 of the Intellectual Property Code. x x x

“2.19 Suyen, by itself and through B-Cut, has extensively used 'SHAPE SHIFTER' as an integral part of its business and as part of its advertising and promotional strategies. It has exerted substantial efforts and has spent substantial amounts in using and promoting 'SHAPE SHIFTER'. Suyen has undertaken and continues to undertake extensive promotional campaigns featuring famous celebrity endorsers. x x x

“2.20 As a result of said extensive promotional campaigns, the 'SHAPE SHIFTER' products of Suyen have become popular in the market and have established goodwill among purchasers of hair products.

The Opposer’s evidence consists of the following:

1. Affidavit of Mr. Dale Gerald G. Dela Cruz, Assistant Vice President (AVP) Brand Marketing of Suyen Corporation;
2. Certificate of Registration of the mark “FIX”.
3. Certificate of Registration of the mark “I-FIX”.
4. Certificate of Registration of the mark “BENCH/FIX PROFESSIONAL”.
5. Certificate of Registration of the mark “SHAPE SHIFTER”
6. Declaration of Actual Use evidencing that Opposer was the first to use the “SHAPE SHIFTER” trademark in the Philippines.

7. Photographs of "SHAPE SHIFTER" in its different containers.⁴
8. Photographs and Print Copes of the "SHAPE SHIFTER" advertising and promotional materials featuring famous celebrities.⁵

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant on 17 February 2015. Said Respondent-Applicant, however, did not file an Answer. Hence, this case is submitted for decision.

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

It is emphasized that the essence of trademark registration is to give protection to the owners of 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 out into the market a superior 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.⁶

Sec. 123.1 (d) R.A. No. 8293, also known as the Intellectual Property Code ("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;

Records show that at the time Respondent-Applicant filed its trademark application on 12 February 2014 for the trademark SHAPESHIFTER, the Opposer already owns trademark registration for "SHAPE SHIFTER", under Reg. Nos. 13771 which "Hair Styling Crème" in Class 3.

The competing marks are reproduced for comparison:

SHAPE SHIFTER

Opposer's Trademark

SHAPESHIFTER

Respondent-Applicant's Trademark

⁴ Exhibits "H to K-8" of Opposer.

⁵ Exhibits "N-N10" of Opposer.

⁶ Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999. See also Article 15, par. (1), Art. 16, par. 91 of the Trade-related Aspect of Intellectual Property (TRIPS Agreement).

The competing marks are identical. The space between the words "SPACE" and "SHIFTER" in Respondent-Applicant's mark is negligible and does not distinguish the same from the Opposer's mark.

Confusion of goods is evident where the litigants are actually in competition; but confusion of business may arise between non-competing interests as well. Non-competing goods may be those which, although they are not in actual competition, are related to each other that it can reasonably be assumed that they originate from one manufacturer, in which case, confusion of business can arise out of the use of similar marks.⁷ In the instant case, confusion is inevitable because the hair products sold by the Opposer under its "SHAPE SHIFTER" mark cater to the same demographic. Said products are both marketed towards and appeal to teens, young adults and young professional, and will likely be sold in the same malls or retail spaces. It is therefore likely for patrons of the Opposer's "SHAPE SHIFTER" products to find their way to stores where the Respondent-Applicant's products will be sold, and vice versa. It cannot be uncommon, and in fact likely, for customers of the said products to associate "SHAPE SHIFTER" as belonging to the same owner.

Succinctly, the Respondent-Applicant's product could be mistaken with those of the Opposer's product and services. Thus, it is likely that the consumers will have the impression that these goods or products originate from a single source or origin. The confusion or mistake would subsist not only on the purchaser's perception of goods but on the origin thereof as held by the Supreme Court, to wit:⁸

Callman notes two types of confusion. The first is the confusion of goods in which even 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 which, in fact does not exist.

Courts have consistently recognized that the extent of protection owing to a registered mark covers use of confusingly similar marks even on different goods. The following are cases where an owner of an earlier registered mark was protected by the courts from the use by another of a similar mark even on different goods:

1. "DERMALIN" for pharmaceutical products against the use of "DERMALINE" for health and beauty services;⁹
2. "SEVENTEEN" for magazines against the use of "MISS SEVENTEEN" for girdles;¹⁰
3. "AUNT JENIM" for flour, against the use on syrup;¹¹
4. "DUNHILL" for smoking pipes, against its use for shirts;¹²
5. "TIFFANY" for jewelry against its use for a motion picture house;¹³
6. "ROLLS-ROYCE" for automobiles, against its use for radio tubes;¹⁴ and,
7. "VOGUE" as the name of magazines, against its use for hats.¹⁵

⁷ Esso Standard Eastern, Inc. v. Court of Appeals, 116 SCRA 336, 341 (1982)

⁸ Converse Rubber Corporation v. Universal Rubber Products Inc., et al., G.R. No. L-27906, 08 Jan. 1987.

⁹ Dermaline, Inc. v. Myra Pharmaceuticals, Inc. G.R.No. 190065, 16 August 2010

¹⁰ Triangle Publications v. Rohrlick, 167 F.2d 969 (2d Cir. 1948)

¹¹ Aunt Jemima Mills Co. v. Rigney & Co. (247 F., 407)

¹² Alfred Dunhill of London v. Dunhill Shirt Shop

¹³ Tiffany & Co., v. Tiffany Productions, Inc. (264 N.Y.S., 459; 23 Trade-mark Reporter, 183)

¹⁴ Wall v. Rolls Royce of America (4 F. [2d], 333)

¹⁵ Vogue Co. v. Thompson-Hudson Co. (300 F., 509)

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 1206561 is hereby **SUSTAINED**. 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 30 JUN 2016


Atty. NATHANIEL S. AREVALO
Director IV, Bureau of Legal Affairs