

KIDSTYLE FASHION, INC.,
Petitioner,

-versus-

EDWARD L. CANTOR,
Respondent- Registrant.

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} **IPC No. 14-2015-00555**
}
} Cancellation of:
} Reg. No. 4-2010-009201
} Date Issued: 24 March 2011
} **TM: "SABINIE"**
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NOTICE OF DECISION

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EDWARD L. CANTOR
Respondent-Registrant
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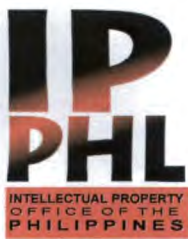
GREETINGS:

Please be informed that Decision No. 2016 - 211 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



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Cancellation of:
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Date Issued: 24 March 2011
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Decision No. 2016 - 211

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DECISION

Petitioner, **KIDSTYLE FASHION, INC.** ("Petitioner")¹, filed a Petition for Cancellation of Trademark Registration No. 4-2010-009201. The trademark registration issued in the name of **EDWARD L. CANTOR** ("Respondent-Registrant"),² covers the mark "SABINIE" for use on "clothing namely: shirts, pants, jeans, polos, jackets and shorts, footwear namely shoes, slippers, sandals, headwear namely: hats caps" under Class 25 of the International Classification of Goods.³

The Petitioner alleges that Respondent's trademark should be canceled on the ground that it was issued in violation of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines (the 'IP Code'). According to Petitioner, its mark has an earlier filing date than respondent. In particular, their trademark application was accorded a much later filing date of 20 August 2010 - a period spanning almost seven (7) years. Apart from having an earlier registration date, petitioner has consistently used the mark in all its business and marketing affairs. Petitioner also asserts that Respondent's 'Sabinie' mark is confusingly similar to its own mark 'Sabrini and Device' and cover the same product line and industry.

Petitioner's evidence consists of the following:

1. Exhibits "A" and "B" - certified copy of petitioner's Certificate of Incorporation and Articles of Incorporation;
2. Exhibit "C" - certified copy of petitioner's General Information Sheet;
3. Exhibit "D" - certified copy of Trademark Application for the mark SABRINI AND DEVICE;
4. Exhibit "E" - Certificate of Registration No. 4-2003-008834 for the mark SABRINI AND DEVICE issued to petitioner on 15 January 2007;
5. Exhibit "F" - Declaration of Actual Use filed on 20 March 2012 for the mark SABRINI AND DEVICE;
6. Exhibits "G" to "G-38" copies of pictures of petitioner's products from 2007 until the present;
7. Exhibits "H" and "H-1" - copies of petitioner's Periodic Sales Report for the of December 1 - 31, 2007 and August 1-31, 2008;

¹ A domestic corporation with address at 300 Kidstyle Compound, M. San Juan Street, Sta. Rosa 2, Marilao, Bulacan

² A Filipino citizen with address at No. 162 Northwest Ipil Street, Marikina Heights, Marikina City.

³The Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks based on a multilateral treaty administered by the World Intellectual Property Organization. This treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of Registration of Marks concluded in 1957.

8. Exhibit "I" - certified copy of the Deed of Assignment of Trademark Application in favor of petitioner dated 28 October 2014;
9. Exhibit "J" - Notice of Recordal issued by IPOPHL; and
10. Exhibit "K" = certified copy of Trademark Registration for the mark SABINIE.

This Bureau issued on 08 January 2016 a Notice to Answer and served a copy to Respondent-Applicant thru DHL on 13 January 2016. However, Respondent-Registrant failed to file the Answer. On 03 May 2016, Respondent-Registrant was declared in default. Hence, this case is deemed submitted for decision on the basis of the opposition, affidavits of witnesses and documentary evidence of the Petitioner.

Should Trademark Registration No. 4-2010-009201 for the mark **SABINIE** be cancelled?

Section 138 of the Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides, to wit:

Sec. 138. Certificates of Registration -A certificate of registration of a mark shall be 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.

A certificate of registration is merely prima facie evidence of the validity of registration, as such it may challenged and canceled and the presumption can be overcome, in an appropriate action, by proof of the nullity of the registration. Section 151 of the IP Code provides:

Sec. 151. Cancellation. -151.1 A petition to cancel a registration of mark under this Act may be filed with the Bureau of Legal Affairs by any person who believes that he is or will be damaged by the registration of a mark under this Act as follows:

x x x

(b) At any time, if the registered mark becomes generic name for the goods or services, or a portion thereof, for which it is registered, or has been abandoned, or *its registration was obtained fraudulently or contrary to the provisions of this Act*, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services or in connection with which the mark is used. Xxx

Petitioner's registration of its mark SABRINI AND DEVICE was issued way back in 15 January 2007. On the other hand, Respondent's Trademark Registration No. 4-2010-009201 consists of the word SABINIE was issued on 24 March 2011.

But is Respondent-Registrant's mark SABINIE validly registered under the IP Code?

Section 123.1 (d) of the IP Code provides for the grounds for registration of a mark, to wit:

Section 123.Registrability. - 123.1. 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;

The marks of the parties are herein reproduced for comparison:



Petitioner's Mark

SABINIE

Respondent-Registrant's Mark

Petitioner mark consists of the word SABRINI written in stylized manner with a butterfly above the second letter "I". It also contains a representation of a lady above the word SABRINI. In contrast, Respondent's mark consists of the word SABINIE plainly written in uppercase letters. However, despite the differences that can be observed between the two marks, this Bureau finds that there is likelihood of confusion between the two mark as to cause confusion or mistake on the consumers. Both marks consists of seven (7) letters, S-A-B-R-I-N-I and S-A-B-I-N-I-E . The marks contain the same first letters "SAB" and the last syllables "NIE" and "NI" when pronounced sound the same.

Trademarks are designed not only for the consumption of the eyes, but also to appeal to the other senses, particularly, the faculty of hearing. Thus, when one talks about the Petitioner's trademark or conveys information thereon, what reverberates is the sound made in pronouncing it. Especially when the products bearing the marks are advertised in the radio, the consumers would not be able to distinguish one from the other because they sound the same. When Respondent's mark is pronounced, the sound of Petitioner's SABRINI mark is practically replicated. The similarity of sound is sufficient ground to rule that two marks are confusingly similar when applied to merchandise of same descriptive properties. In fact, the Supreme Court has in many cases took into account the aural effects of the words and letters contained in the marks in determining the issue of confusing similarity. In *Marvex Commercial Co., Inc. v Petra Hawpia & Co., et al.*⁴, the Court held:

The following random list of confusingly similar sounds in the matter of trademarks, culled from Nims, *Unfair Competition and Trade Marks*, 1947, Vol. 1, will reinforce our view that "SALONPAS" and "LIONPAS" are confusingly similar in sound: "Gold Dust" and "'Gold Drop"; "Jantzen" and "Jass-Sea"; "Silver Flash" and "Supper Flash"; "Cascarete" and "Celborite"; "Celluloid" and "Cellonite"; "Chartreuse" and "Charseurs"; "Cutex" and "Cuticlean"; "Hebe" and "Meje"; "Kotex" and "Femetex"; "Zuso" and "Hoo Hoo." Leon Amdur, in his book "Trade-Mark Law and Practice," pp. 419-

⁴ G.R. No. L-19297. December 22, 1966 cited in *McDonald's Corporation v. L.C. Big Mak Burger, Inc.* G.R. No. 143993. August 18, 2004.

421, cities [sic], as coming within the purview of the idem sonans rule, "Yusea" and "U-C-A," "Steinway Pianos" and "Steinberg Pianos," and "Seven-Up" and "Lemon-Up." In *Co Tiong vs. Director of Patents*, this Court unequivocally said that "Celdura" and "Condura" are confusingly similar in sound; this Court held in *Sapolin Co. vs. Balmaceda*, 67 Phil. 795 that the name "Lusolin" is an infringement of the trademark "Sapolin," as the sound of the two names is almost the same.

Further, the goods to which the parties use their respective marks are also similar or related. Respondent-Registrant's mark SABINIE is used on goods such as "*clothing namely: shirts, pants, jeans, polos, jackets and shorts, footwear namely shoes, slippers, sandals, headwear namely: hats caps*" while Petitioner's mark SABRINI is used on "*underwear (bras, sandos, chemiso, shorts, panty, shirts); sleepwear/housewear (shirts, sandos, pants, shorts, dress)*". Because of the similarity of the marks and the goods upon which the marks are used, it will likely cause confusion, mistake or deception on the part of the public that the goods of Respondent-Registrant are manufactured by or sourced from Petitioner or vice versa. Furthermore, Respondent was given the opportunity to defend his right over the mark SABINIE. However, despite notice, he chose not to.

Aptly, 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 into the market a superior article of merchandise, the fruit of his industry and skill; to assure the public that they are procuring the 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.⁵ Respondent-Registrant's mark does not meet this function and therefore cancellation is warranted.

WHEREFORE, premises considered, the instant Petition for Cancellation is hereby **GRANTED**. Let the filewrapper of Trademark Reg. No. 4-2010-009201 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

⁵See *Pribhdas J. Mirpuri v. Court of Appeals*, G. R. No. 114508, 19 Nov. 1999.