

**BATA BRANDS S.A.R.L.,**  
*Opposer,*

**-versus-**

**MICHELL CHENG YEUNG,**  
*Respondent-Applicant.*

X-----X

}	<b>IPC No. 14-2013-00051</b>
}	Opposition to:
}	Appln. Serial No. 4-2012-007235
}	Date Filed: 15 June 2012
}	
}	
}	<b>TM: COMFIT &amp; DEVICE</b>

**NOTICE OF DECISION**

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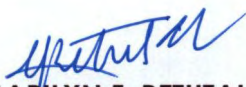
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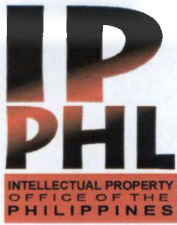
**GREETINGS:**

Please be informed that Decision No. 2017 - 18 dated 19 January 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, 23 January 2017.

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



BATA BRANDS S.A.R.L.,

Opposer,

-versus-

MICHELL CHENG YEUNG,

Respondent-Applicant.

IPC No. 14-2013-00051

Opposition to:

Application No. 4-2012-007235

Date Filed: 15 June 2012

Trademark: "COMFIT & DEVICE"

Decision No. 2017- 18

x-----x

DECISION

BATA BRANDS S.A.R.L.<sup>1</sup> ("Opposer") filed an opposition to Trademark Application Serial No. 4-2012-007235. The application, filed by Michell Cheng Yeung<sup>2</sup> ("Respondent-Applicant"), covers the mark "COMFIT & DEVICE" for use on "sunglasses" under Class 09, "women's and children's fashion accessories, jewelry and imitation jewelry, namely: necklaces, earrings, bangles, rings, bracelets, watches, watch straps, brooches, finger rings, toe rings, anklets, pendants, and chokers, and other jewelry and imitation jewelry and jewelry made out of or coated with gold, silver, pewter, ivory, and mother of pearl; men's and children's fashion accessories, jewelry and imitation jewelry, namely: dog tags, necklaces, earrings, rings, watches, watch straps, pendants, and other men's jewelry and imitation jewelry and jewelry made out of or coated with gold, silver, pewter, ivory, and mother of pearl" under Class 14, "bags, women's, men's and children's bags, namely: handbags, tote: bags, satchel bags, backpacks, laptop bags, straw bags, clutch bags, messenger bags, purses, shoulder bags, wallets, duffel bags, hobo bags, bucket bags, book bags, brief cases, travel bags, luggages and travelling bags made of leather and imitation leather, animal skins and hides" under Class 18, "footwear, women's shoes, namely: heels, platforms, office shoes, boots, booties, knee high boots, loafers, sandals, ballet flats, ankle strap shoes, wedges, special occasion shoes, dress shoes, thigh high boots, flats, slippers, sneakers, rubber shoes, clogs, mules, stilettos, ankle high boots, sling-backs, sandal heels, pumps, calf high boots, peep-toe shoes, athletic shoes, oxfords, brogues, boat shoes, flip flops, slide shoes, t-strap shoes, mary janes, gladiators, moccasins, espadrille, rain boots, slough, scuff, high tops, d'orsay, cleats, huarache, fisherman, saddle shoes, chukka, spectator, jelly shoes, gaiters, creepers, plain-toes, and cap-toes; men's shoes, namely: dress shoes, sneakers, office shoes, oxfords, lace-ups, rubber shoes, high tops, sandals, slippers, jelly shoes, boat shoes, loafers, slip-ons, monk-straps, brogues, plain-toes, cap-toes, boots, espadrilles, moccasins, dogs, mules, flip flops, t-strap shoes, derby dress shoes, blucher dress shoes, black tie dress shoes, flat, athletic shoes, and rain boots; children's shoes, namely dress shoes, sneakers, lace-ups, rubber shoes, high tops, sandals, slippers, jelly shoes, boat shoes, loafers, slip-ons, monk-straps, brogues, plain-toes, captoes, boots, espadrilles, moccasins, clogs, mules, flip flops, t-strap shoes, derby dress shoes, blucher dress shoes, black tie dress shoes,

<sup>1</sup> A foreign corporation organized under the laws of The Netherlands, with business address at Weena 455, Rotterdam, 3013 AL, The Netherlands. <sup>2</sup> With address at 2<sup>nd</sup> Floor Madison Square Bldg. cor. Madison Street, North Greenhills San Juan Metro Manila, Philippines.



*flat, athletic shoes, and rain boots. women's, men's and children's clothing apparel, namely: dresses, pants, skirts, t-shirts, jump suits, sweaters, tube dress, bolero jackets, blazers, jackets, cardigans, overalls, leggings, tops, shorts, jeans, slacks, tank tops, tunics, skinny jeans, sweat suits, boyfriend blazers, coats, blouses, vests, overalls, peasant blouse, maxi dresses, mini skirts, swimwear, underwear, intimates, boxers, briefs, dress shirts, board shorts, hoodies, sweat shirts, socks, pajamas, rompers, sun dresses, cocktail dresses, cargo pants, pencil skirts, poles, ties, and suits. belts, wristbands and cuffs. women's, men's and children's headgear, namely: fedoras, caps and hats" under Class 25, and "baguettes" under Class 30 of the International Classification of Goods and Services.*<sup>3</sup>

The Opposer alleges:

x   x   x  
"GROUNDS FOR OPPOSITION"

"1. The Respondent-Applicant's 'COMFIT & DEVICE' mark cannot be registered as its registration will violate Section 123.1 (d) of the IP Code which provides, in part, that a mark cannot be registered if it:

x x x

"2. Moreover, the registration of Respondent-Applicant's 'COMFIT & DEVICE' is expressly proscribed by Section 123.1 (e) and (f) which prohibits the registration of marks identical with or confusingly similar to a well-known mark. Thus:

x x x

"3. Applicant-Registrant's application for the mark 'COMFIT & DEVICE' likewise violates Article 6bis of the Paris Convention which provides that:

x x x

"4. Indeed, the damage to Opposer by virtue of the attempted registration made by Respondent-Applicant for its 'COMFIT & DEVICE' is clearly palpable considering that Respondent-Applicant virtually copied Opposer's 'COMFIT' (Reg. No. 4-2008-500450) which is owned, used and first registered by Opposer in the Philippines and in several countries around the world.

"5. The Respondent-Applicant's mark 'COMFIT & DEVICE' is confusingly similar to Opposer's 'COMFIT' trademark and is applied for the same class of goods which similarity would be likely to deceive or cause confusion as to the origin of the goods. For Respondent-Applicant to adopt an almost identical mark for the same class of goods clearly belies its intention to unfairly trade on the carefully honed goodwill and reputation of Opposer's 'COMFIT' trademark. In the present case, there is no doubt as to the existence of confusing similarity considering that both marks use identical words and cover a common class of goods.

"6. The foregoing more than clearly show Respondent-Applicant's attempt to get a 'free-ride' on the positive brand reputation of Opposer's 'COMFIT' trademark

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

which Opposer had painstakingly established and spent substantial amounts of money on to develop. Why out of all the combinations of letters to use on its goods, Respondent-Applicant had to choose one that is identical to a mark that is known and associated with quality goods and products that is known to be manufactured and sold by Opposer? It is therefore clear that the registration of Respondent-Applicant's 'COMFIT & DEVICE' mark will create confusion in the minds of the purchasers and consumers, who will be deceived into believing that Opposer and Respondent-Applicant are affiliated entities, or that Respondent-Applicant has the Opposer's sponsorship, all to the latter's great prejudice. It thus becomes incumbent upon this Honorable Bureau to disallow the registration of Respondent-Applicant's mark as such registration is a clear violation of Section 123.1, paragraph (d) of the IP Code and will cause grave damage to the Opposer.

"7. There is a second reason why Respondent-Applicant's mark must be denied registration. Applying Section 123.1 (e) and (f) of the IP Code, Respondent-Applicant's 'COMFIT & DEVICE' cannot be registered as it is confusingly similar to and in fact, nearly identical with Opposer's trademark 'COMFIT' which, we respectfully submit qualifies as a well-known mark under the parameters set forth in Rule 102 of the Trademark Rules and Regulations. Under Rule 102, any one or a combination of the following criteria shall be sufficient for a finding that a mark is internationally well-known, to wit:

x x x

"8. Opposer, the owner of one of the leading footwear brands in the world, owns the 'COMFIT' trademark. Opposer's 'COMFIT' trademark is used in conjunction with Opposer's well-known BATA trademark which has commercial presence in over one hundred fifty (150) countries, including the Philippines. Opposer owns trademark registrations and applications for the 'COMFIT' trademark in the countries referred to above. Use of COMFIT will ultimately expand to almost all countries in which BATA has a commercial presence.

"9. Luxembourg, the country where Opposer is a subject, is a member of the Convention of Paris for the Protection of Industrial Property (Paris Convention) and the World Trade Organization (WTO). It is also a signatory to the Trade Related Aspects of Intellectual Property Rights Agreement (TRIPS). If Respondent-Applicant's trademark application Serial No. 4-2012-007235 is allowed to proceed to registration, the provisions of the IP Code will not only be violated but also the commitment of the Philippines to the international community through its accession to the Paris Convention and membership with the World Trade Organization (WTO) and as signatory to the Trade Related Aspects of Intellectual Property Rights Agreement (TRIPS).

"10. In support of all the foregoing facts and allegations, Opposer hereby attaches as Exhibit 'E' a duly executed Affidavit of Bata Limited's Secretary and General Counsel, Mr. Leslie Tenenbaum.

"11. In view of all the foregoing, Respondent-Applicant's trademark application for 'COMFIT & DEVICE' under Application Serial No. 4-2012-007235 filed on June 15, 2012 covering goods in Class 9, 14, 18, 25 and 30 in the name of Michell Cheng Yeung SHOULD BE DENIED, in accordance with Section 123.1 (d), (e) and (f) of the IP Code.

"12. Opposer reserves its right to present such other evidence in support of its claims and allegations as well as in rebuttal to the evidence to be presented by Respondent-Applicant in support of its Answer to this Notice of Opposition. Opposer also reserves its right to present such other facts as may be necessary in the course of these proceedings.

The Opposer's evidence consists of the Special Power of Attorney/Director's Certificate authorizing Opposer's counsel to prosecute this Opposition; copy of Trademark Reg. No. 4-2008-500450 issued on 21 January 2010 for the mark "COMFIT" for goods in Class 25; copy of details of various foreign registration of Opposer's mark "COMFIT"; copy of Application Serial No. 4-2012-007235 for the mark "COMFIT & DEVICE"; and the Affidavit of Bata Limited's Secretary and General Counsel, Mr. Leslie Tenenbaum.<sup>4</sup>

This Bureau issued a Notice to Answer and served a copy thereof upon Respondent-Applicant on 30 April 2013. The Respondent-Applicant filed her Answer on 19 July 2013 and avers the following:

x x x

"SPECIAL AND AFFIRMATIVE DEFENSES

"6. At the outset, the instant Notice of Opposition must be dismissed for utter failure to state a valid cause of action. Section 134 of the Intellectual Property Code provides the lone ground for an opposition case to wit:

x x x

"7. In this case, Opposer would not be damaged by the registration of the 'COMFIT & DEVICE' since Respondent-Applicant is the exclusive owner and prior actual user of the 'COMFIT & DEVICE' mark in the Philippines as would be discussed thoroughly in the subsequent paragraphs. Thus, Opposer's Notice of Opposition must likewise fail for lack of a ground/cause of action.

"8. To protect its ownership over the trademark 'COMFIT & DEVICE', Respondent-Applicant applied with the Intellectual Property Office (IPOP HL) for its registration under Serial No. 4-2012-007235 for 'women's shoes and accessories' under Classes 9, 14, 18, and 25. After undergoing a thorough process of examination, the said application was found registrable by the Examiner and the same was recommended for allowance. The recommendation was then approved by the Chief Trademark Examiner and the Director of Trademarks.

"9. Respondent-Applicant is a Filipino entrepreneur who envisions a shoe brand which can be affordable and durable alternative to today's selection of women's footwear, with focus on one main aspect: 'Comfort'; thus the birth of the brand, COMFIT, an abbreviation of the phrase 'comfortable fit'. To further emphasize her dedication to offering unique and quality designed shoes to the market without sacrificing the comfort of the shoe, Respondent-Applicant coined COMFIT's slogan: 'Walk Comfortably'.

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<sup>4</sup> Marked as Exhibits "A" to "K", inclusive.

"10. After a long and vigorous preparation of her business plan, the first COMFIT store was opened and established in SM North EDSA. Respondent-Applicant's 'COMFIT & DEVICE' mark has been used continuously and uninterruptedly since the beginning of Respondent-Applicant's shoe shop in its outdoor signages, marketing/promotional materials as well as products including other in-store merchandise.

"11. Since the establishment of the first COMFIT store, the COMFIT brand has made an indelible mark in women's footwear brand in the Philippines. Its footwear ranging from timeless classic flats to trendy flats and low-heeled shoes have garnered popularity and positive reviews from diverse patrons. COMFIT's products are easily distinguished by its 'COMFIT & DEVICE' mark. The evidence of use of the 'COMFIT & DEVICE' mark in signages, billboards, magazines, marketing/promotional materials and in-store merchandise are hereto attached and made integral parts hereof as Exhibits '1' series. COMFIT products even have various local and international celebrity ambassadors. Photographs of these promotional materials are hereto attached and made integral parts hereof as Exhibits '2' series.

"12. Respondent-Applicant's 'COMFIT & DEVICE' mark has been openly and continuously used for several years. Respondent-Applicant's COMFIT brand also maintains a website, [www.shopcomfit.com](http://www.shopcomfit.com), to promote its stores and products. Print-outs of the website and domain name registration are hereto attached as Exhibits '3' series. The brand is also featured in several social network sites and application, i.e., Facebook (with 33,631 followers as of May 13, 2013, Instagram (with 1,821 followers as of May 13, 2013, and Twitter (with 288 followers as of May 13, 2013). Print-outs of these websites and application are hereto attached as Exhibits '4' series.

"13. Respondent-Applicant is the exclusive owner and user of the 'COMFIT & DEVICE' mark. Contrary to Opposer's claim that it already registered the trademark 'COMFIT'. Such registration does not exist.

"14. To support its Notice of Opposition, Opposer claims that it was issued a Philippine Certificate of Registration for the trademark 'COMFIT' under Registration No. 4-2008-500450 for 'footwear namely, men's and women's casual comfort shoes' in Class 25. Opposer erroneously and misleadingly posits that this registration bars Respondent-Applicant's application for registration of her 'COMFIT & DEVICE' mark.

"15. Upon verification with the records of the Bureau of Trademark (BOT) of the IPOPHL, Respondent-Applicant discovered that the alleged Registration No. 4-2008-500450 is subject for removal from the Registry of the BOT. Certifications issued by the BOT stating the current status of Registration No. 4-2008-500450 is hereto attached and made an integral part hereof as Exhibits '5' and '6', respectively.

"16. Rule 204 of the Rules and Regulations on Trademarks, Service Marks, Tradenames and Mark of Stamped Containers (Trademark Rules and Regulations) clearly provides the refusal or removal of a trademark for non-filing of the required DAU, to wit:

x x x

"17. This is consistent with Section 124.2 of the IP Code, which states that:

x x x

"18. In the absence of any valid and existing registration for the trademark 'COMFIT' in the name of any party, including the Opposer, there should be no reason to bar the allowance of Respondent-Applicant's application for registration of her 'COMFIT & DEVICE' mark.

"19. Moreover, Opposer's pending application of its 'COMFIT' trademark under Application No. 4-2013-500348 for 'footwear, namely, men's and women's casual comfort shoes' in Class 25 may not serve as an obstacle in granting Respondent-Applicant's application for registration of her 'COMFIT & DEVICE' mark. Print-out of Application No. 4-2013-500348 as shown in IPOPHL's online database is hereto attached and made integral part hereof as Exhibit '7'.

"20. Opposer falsely and erroneously claims that it is the prior user and adopter of the trademark 'COMFIT'.

"21. The fact that Opposer failed to file its DAU for its 'COMFIT' trademark within three (3) years from the filing date shows that Opposer failed to actually use its 'COMFIT' trademark in the Philippine market prior to and during the filing of Respondent-Applicant's application for registration for her 'COMFIT & DEVICE' mark.

"22. Opposer attached copies of marketing and other visual materials of its 'COMFIT' trademark that do not prove actual use of said trademark. The list of Opposer's mark's registrations is obviously prepared by Opposer, and thus, self-serving and lacks any value. It should be noted that under the Philippine category, Registration No. 4-2008-500450 was not included in the list instead, Application No. 4-2013-500348 was listed. Again, this is another acknowledgement from Opposer that its Registration No. 4-2008-500450 was cancelled.

"23. Print-outs of Opposer's websites advertising and marketing its alleged 'COMFIT' mark are also not sufficient to prove that the 'COMFIT' mark is actually and presently used by Opposer, or at least used any time prior to the filing Respondent-Applicant's application for registration for her 'COMFIT & DEVICE' trademark.

"24. In *Berris Agricultural Co., Inc. v. Abyadang*, the Supreme Court held that mere advertisements do not translate to use that will ripen into ownership of a trademark, to wit:

x x x

"25. Even assuming that Opposer used its 'COMFIT' mark after Registration No. 4-2008-500450 was cancelled; the so-called ownership over the trademark cannot be sustained. The effect of a cancellation is to terminate Opposer's ownership over the mark. Otherwise, or to claim that the cancellation of Opposer's Registration No. 4-2008-500450 did not deprive it of ownership over the mark, is tantamount to rewarding an applicant or registrant who failed to comply with the DAU requirement with continued exclusive right over the cancelled mark. The danger in this erroneous postulation is that this will lead to an absurd

situation where applicants or registrants who fail to file their DAU can claim perpetual rights over the cancelled marks by merely alleging its continued use of the marks.

"For failure of Opposer to show proof of use of its alleged 'COMFIT' trademark prior to, during, and after the filing Respondent-Applicant's application for registration for her 'COMFIT & DEVICE' trademark, Respondent-Applicant's application for registration for her 'COMFIT & DEVICE' trademark should be granted registration. As already discussed, Respondent-Applicant's prior and actual use of the 'COMFIT & DEVICE' trademark is clear and undeniable.

"26. Rule 102 of the Trademark Rules and Regulations enumerates the criteria in determining whether a mark is well-known, said rule states:

x x x

"27. Upon examination of all the evidence attached to Opposer's Notice of Opposition, Opposer failed to sufficiently prove that its 'COMFIT' trademark is well-known internationally and in the Philippines. None of the criteria listed above have been met.

"28. It must be stressed that Opposer's list of registration is scanty and unauthenticated. Further, Opposer failed to present any evidence that its claimed websites are interactive, e-commerce enabled and may be accessed commercially. Thus, the Opposer's website may not serve as basis in determining the character of the Opposer's marks as supposed well-known marks.

"29. The glaring lack of proof that the Opposer's 'COMFIT' trademark is well-known internationally and in the Philippines negates its claim that the use by Respondent-Applicant of the 'COMFIT & DEVICE' trademark will cause it grave damage.

"30. The affidavit of Respondent-Applicant's witness is hereto attached and made an integral part hereof as Exhibit '8' which shows/explains that Respondent-Applicant is the exclusive owner and actual prior user of the 'COMFIT & DEVICE' trademark.

"31. Respondent-Applicant reserves the right to present such other documents as may be necessary to prove the foregoing allegations in the course of the proceedings.

The Respondent-Applicant's evidence consists of photographs of signages, billboards, magazines marketing/promotional materials and in-store merchandise evidencing use of the mark "COMFIT & DEVICE"; photographs of various local and international celebrity ambassadors using COMFIT's products; print-outs of the website [www.shopcomfit.com](http://www.shopcomfit.com) and domain name registration; print-outs of several social network sites and application which featured the brand "COMFIT & DEVICE"; copy of Certifications issued by the Bureau of Trademarks of IPOPHL stating the current status



of Reg. No. 4-208-500450; print-out of Application No. 4-2013-500348 for the trademark "COMFIT"; and the Affidavit of Michell Cheng Yeung, herein Respondent-Applicant.<sup>5</sup>

Should the Respondent-Applicant be allowed to register the trademark COMFIT & DEVICE?

The Opposer anchors its opposition on the following provisions of Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"):

Sec. 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;"
- (e) Is identical with, or confusingly similar to, or constitutes 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;
- (f) Is identical with, or confusingly similar to, or constitutes a translation of a mark considered well-known in accordance with the preceding paragraph, which is registered in the Philippines with respect to goods or service which are not similar to those with respect to which registration is applied for: *Provided*, That use of the mark in relation to those goods or services would indicate a connection between those goods or services, and the owner of the registered mark: *Provided further*, That the interests of the owner of the registered mark are likely to be damaged by such use;

A comparison of the competing marks reproduced below:

**COMFIT**

Opposer's trademark

**Comfit**

Respondent-Applicant's mark

<sup>5</sup> Marked as Exhibits "1" to "8", inclusive.

shows that confusion is likely to occur. This Bureau noticed that the goods covered by the marks are similar or closely-related. Designated as COMFIT & DEVICE, Respondent-Applicant's goods are "sunglasses" under Class 09, "women's and children's fashion accessories, jewelry and imitation jewelry, namely: necklaces, earrings, bangles, rings, bracelets, watches, watch straps, brooches, finger rings, toe rings, anklets, pendants, and chokers, and other jewelry and imitation jewelry and jewelry made out of or coated with gold, silver, pewter, ivory, and mother of pearl; men's and children's fashion accessories, jewelry and imitation jewelry, namely: dog tags, necklaces, earrings, rings, watches, watch straps, pendants, and other men's jewelry and imitation jewelry and jewelry made out of or coated with gold, silver, pewter, ivory, and mother of pearl" under Class 14, "bags, women's, men's and children's bags, namely: handbags, tote bags, satchel bags, backpacks, laptop bags, straw bags, clutch bags, messenger bags, purses, shoulder bags, wallets, duffel bags, hobo bags, bucket bags, book bags, brief cases, travel bags, luggages and travelling bags made of leather and imitation leather, animal skins and hides" under Class 18, "footwear, women's shoes, namely: heels, platforms, office shoes, boots, booties, knee high boots, loafers, sandals, ballet flats, ankle strap shoes, wedges, special occasion shoes, dress shoes, thigh high boots, flats, slippers, sneakers, rubber shoes, clogs, mules, stilettos, ankle high boots, sling-backs, sandal heels, pumps, calf high boots, peep-toe shoes, athletic shoes, oxfords, brogues, boat shoes, flip flops, slide shoes, t-strap shoes, mary janes, gladiators, moccasins, espadrille, rain boots, slough, scuff, high tops, d'orsay, cleats, huarache, fisherman, saddle shoes, chukka, spectator, jelly shoes, gaiters, creepers, plain-toes, and cap-toes; men's shoes, namely: dress shoes, sneakers, office shoes, oxfords, lace-ups, rubber shoes, high tops, sandals, slippers, jelly shoes, boat shoes, loafers, slip-ons, monk-straps, brogues, plain-toes, cap-toes, boots, espadrilles, moccasins, dogs, mules, flip flops, t-strap shoes, derby dress shoes, blucher dress shoes, black tie dress shoes, flat, athletic shoes, and rain boots; children's shoes, namely dress shoes, sneakers, lace-ups, rubber shoes, high tops, sandals, slippers, jelly shoes, boat shoes, loafers, slip-ons, monk-straps, brogues, plain-toes, captoes, boots, espadrilles, moccasins, clogs, mules, flip flops, t-strap shoes, derby dress shoes, blucher dress shoes, black tie dress shoes, flat, athletic shoes, and rain boots. women's, men's and children's clothing apparel, namely: dresses, pants, skirts, t-shirts, jump suits, sweaters, tube dress, bolero jackets, blazers, jackets, cardigans, overalls, leggings, tops, shorts, jeans, slacks, tank tops, tunics, skinny jeans, sweat suits, boyfriend blazers, coats, blouses, vests, overalls, peasant blouse, maxi dresses, mini skirts, swimwear, underwear, intimates, boxers, briefs, dress shirts, board shorts, hoodies, sweat shirts, socks, pajamas, rompers, sun dresses, cocktail dresses, cargo pants, pencil skirts, poles, ties, and suits. belts, wristbands and cuffs. women's, men's and children's headgear, namely: fedoras, caps and hats" under Class 25, and "baguettes" under Class 30. Opposer's products covered under COMFIT are "footwear, namely, men's and women's casual comfort shoes" under Class 25.

Confusion is likely in this instance because of the close resemblance between the marks, both contain the dominant word COMFIT, and the goods are intimately related. Opposer's goods and the Respondent-Applicant's products are in the category of shoes, bags, men's/women's accessories, clothing and apparel; in the fashion industry they are composite and admittedly integral part of each other. By their being basically in the design or fashion industry, both products are classified as fashion items and may be marketed similarly. The Supreme Court in *ESSO Standard Eastern, Inc. vs. Court of Appeals, et. al.*,<sup>6</sup> defined what are essentially closely related goods under the trademark law as :

"Goods are related when they belong to the same class or have the same descriptive properties; when they possess the same physical attributes or essential characteristics with reference to their form, composition, texture or quality. They may also be related because they serve the same purpose or are sold in grocery stores. Thus, biscuits were held related to milk because they are both food products."

As such, there is likelihood that the public will be confused or mistaken into believing that Respondent-Applicant's mark is just a variation of Opposer's mark or that their goods come from the same source or manufacturer.

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:

Callman notes two types of confusion. The first is the confusion of goods in which event the ordinary 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. Here, 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.<sup>7</sup>

However, Respondent-Applicant claims that it has prior right over Opposer despite the earlier application filed by Opposer for its mark COMFIT. Thus, it is necessary to determine who between Opposer and the Respondent-Applicant has prior right.

Records show that at the time the Respondent-Applicant filed its trademark application on 15 June 2012 for the mark COMFIT & DEVICE, the Opposer had previously filed application for registration of the mark COMFIT on 11 December 2008, which was allowed and was issued Trademark Registration No. 4-2008-500450 on 21 January 2010. Due to Respondent-Applicant's failure to file the required Declaration of

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<sup>6</sup> 201 Phil 803.

<sup>7</sup> *Converse Rubber Corp. v. Universal Rubber Products, Inc. et. al.*, G.R. No. L-27906, 08 Jan. 1987.

Actual Use, Reg. No. 4-2008-500450 was removed from or was subject for removal from the registry. The Respondent-Applicant, however, filed for re-registration of the mark COMFIT on 05 February 2013 bearing Application Serial No. 4-2013-500348.

In *E.Y. Industrial Sales, Inc. et Al. v. Shendar Electricity and Machinery Co. Ltd.*<sup>8</sup>, the Supreme Court held:

Sec. 134 of the IP Code provides that any person who believes that he would be damaged by the registration of a mark xxx may file an opposition to the application. The term any person encompasses the true owner of a mark, the prior continuous user.

Notably, the Court has ruled that the prior and continuous use of a mark may even overcome the presumptive ownership of the registrant and be held as the owner of the mark. As aptly stated by the Court in *Shangri-la International Hotel Management, Ltd v. Developers Group of Companies, Inc.*:

Registration, without more, does not confer upon the registrant an absolute right to the registered mark. The certificate of registration is merely a prima facie proof that the registrant is the owner of the registered mark or trade name. Evidence of prior and continuous use of the mark or trade name by another can overcome the presumptive ownership of the registrant and may very well entitle the former to be declared owner in an appropriate case.

xxx

Ownership of a mark or trade name may be acquired not necessarily by registration but by adoption and use in trade or commerce. As between actual use of a mark without registration, and registration of the mark without actual use thereof, the former prevails over the latter. For a rule widely accepted and firmly entrenched, because it has come down through the years, is that actual use in commerce or business is a pre-requisite to the acquisition of the right of ownership.

xxx

By itself, registration is not a mode of acquiring ownership. **When the applicant is not the owner of the trademark being applied for, he has no right to apply for registration of the same.** Registration merely creates a prima facie presumption of the validity of the registration, of the registrant's ownership of the trademark and of the exclusive right to the use thereof. Such presumption, just like the presumptive regularity in the performance of official functions, is rebuttable and must give way to evidence to the contrary. (Emphasis and underscoring supplied)

In this case, although Opposer's registration (Certificate of Registration No. 4-2008-500450) was ordered removed from the Register for failure to file the 3-yr Declaration of Actual Use, Opposer continued to use the mark and did not abandon its rights over the mark COMFIT. Generally, abandonment means the complete, absolute or total relinquishment or surrender of one's property or right, or the voluntary giving up or non-enjoyment of such property or right for a period of time which results in the

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<sup>8</sup> G.R. No. 184850. October 20, 2010

forfeiture or loss thereof. It requires the concurrence of the intention to abandon it and some overt acts from which it may be inferred not to claim it anymore.<sup>9</sup> To work abandonment, the disuse must be permanent and not ephemeral; it must be intentional and voluntary, and not involuntary or even compulsory. There must be a thorough ongoing discontinuance of any trade-mark use of the mark in question.<sup>10</sup> Applying the said concept to ownership or registration of trademarks, in order for a trademark registration to be considered as abandoned, the owner/registrant must relinquish or voluntarily surrender its rights over the trademark. There was no overt act from which it can be inferred that Opposer abandoned its right over the mark COMFIT. In fact, to ensure continuity of its registration and to prove that Opposer is the prior user of the trademark COMFIT in the concept of an owner, Opposer filed application for registration of the mark COMFIT in 2013 bearing Application No. 4-2013-500348. Hence, Opposer's re-application or re-registration of the mark COMFIT plus the continued use by Opposer of its mark, Opposer has prior right than Respondent-Applicant.

There is no doubt, therefore, that the subject trademark application is covered by the proscription under Sec. 123.1 (d) (iii). The proscription, however, is only with respect to sunglasses, men's, women's and children's fashion accessories, bags, footwear, clothes under Classes 09, 14, 18 and 25, as the said goods are similar or intimately-related to Opposer's. As to the other goods of Respondent-Applicant's namely "*baguettes*" under Class 30, these are not included for they are not similar or related to the goods covered under Opposer's Trademark Registration No. 4-2008-500450 and 4-2013-500348, specifically, footwear, namely, men's and women's casual comfort shoes.

**WHEREFORE**, premises considered, the instant Opposition to Trademark Application No. 4-2012-007235 covering "*sunglasses*" under Class 09, "*women's and children's fashion accessories, jewelry and imitation jewelry, namely: necklaces, earrings, bangles, rings, bracelets, watches, watch straps, brooches, finger rings, toe rings, anklets, pendants, and chokers, and other jewelry and imitation jewelry and jewelry made out of or coated with gold, silver, pewter, ivory, and mother of pearl; men's and children's fashion accessories, jewelry and imitation jewelry, namely: dog tags, necklaces, earrings, rings, watches, watch straps, pendants, and other men's jewelry and imitation jewelry and jewelry made out of or coated with gold, silver, pewter, ivory, and mother of pearl*" under Class 14, "*bags, women's, men's and children's bags, namely: handbags, tote: bags, satchel bags, backpacks, laptop bags, straw bags, clutch bags, messenger bags, purses, shoulder bags, wallets, duffel bags, hobo bags, bucket bags, book bags, brief cases, travel bags, luggages and travelling bags made of leather and imitation leather, animal skins and hides*" under Class 18, "*footwear, women's shoes, namely: heels, platforms, office shoes, boots, booties, knee high boots, loafers, sandals, ballet flats, ankle strap shoes, wedges, special occasion shoes, dress shoes, thigh high boots, flats, slippers, sneakers,*

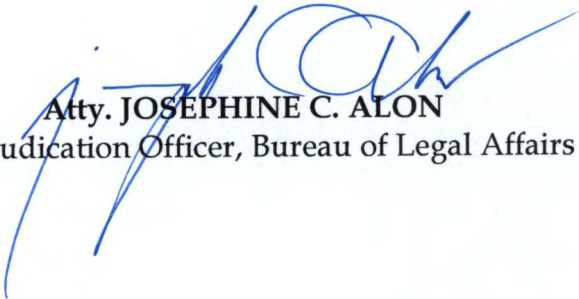
<sup>9</sup> Agpalo, Ruben E., *Legal Words and Phrases*, 1997 Ed., page 1.

<sup>10</sup> *Philippine Nut Industry vs. Standard Brands, Incorporated, Et. al.*, G.R. No. L-23035. July 31, 1975 citing *Callman, Unfair Competition and Trademark*, 2nd Ed., p. 1341)

*rubber shoes, clogs, mules, stilettos, ankle high boots, sling-backs, sandal heels, pumps, calf high boots, peep-toe shoes, athletic shoes, oxfords, brogues, boat shoes, flip flops, slide shoes, t-strap shoes, mary janes, gladiators, moccasins, espadrille, rain boots, slough, scuff, high tops, d'orsay, cleats, huarache, fisherman, saddle shoes, chukka, spectator, jelly shoes, gaiters, creepers, plain-toes, and cap-toes; men's shoes, namely: dress shoes, sneakers, office shoes, oxfords, lace-ups, rubber shoes, high tops, sandals, slippers, jelly shoes, boat shoes, loafers, slip-ons, monk-straps, brogues, plain-toes, cap-toes, boots, espadrilles, moccasins, dogs, mules, flip flops, t-strap shoes, derby dress shoes, blucher dress shoes, black tie dress shoes, flat, athletic shoes, and rain boots; children's shoes, namely dress shoes, sneakers, lace-ups, rubber shoes, high tops, sandals, slippers, jelly shoes, boat shoes, loafers, slip-ons, monk-straps, brogues, plain-toes, captoes, boots, espadrilles, moccasins, clogs, mules, flip flops, t-strap shoes, derby dress shoes, blucher dress shoes, black tie dress shoes, flat, athletic shoes, and rain boots. women's, men's and children's clothing apparel, namely: dresses, pants, skirts, t-shirts, jump suits, sweaters, tube dress, bolero jackets, blazers, jackets, cardigans, overalls, leggings, tops, shorts, jeans, slacks, tank tops, tunics, skinny jeans, sweat suits, boyfriend blazers, coats, blouses, vests, overalls, peasant blouse, maxi dresses, mini skirts, swimwear, underwear, intimates, boxers, briefs, dress shirts, board shorts, hoodies, sweat shirts, socks, pajamas, rompers, sun dresses, cocktail dresses, cargo pants, pencil skirts, poles, ties, and suits. belts, wristbands and cuffs. women's, men's and children's headgear, namely: fedoras, caps and hats" under Class 25, is hereby SUSTAINED. Insofar as Respondent-Applicant's "baguettes" under Class 30, the instant Opposition to Trademark Application No. 4-2012-007235 is hereby DISMISSED. Let the filewrapper 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, 19 JAN 2017.

  
Atty. JOSEPHINE C. ALON  
Adjudication Officer, Bureau of Legal Affairs