



INTELLECTUAL PROPERTY  
OFFICE OF THE  
PHILIPPINES

**NEW BARBIZON FASHION INC.,**

*Opposer,*

**-versus-**

**THE ADF FAMILY TRUST AND THE CDF  
FAMILY TRUST,**

*Respondent-Applicant.*

**IPC No. 14-2014-00017**

Opposition to:

Appln. Serial No. 4-2013-0500697

Date Filed: 12 March 2013

**TM: SHASA**

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**NOTICE OF DECISION**

**SAPALO VELEZ BUNDANG & BULILAN**

*Counsel for Opposer*

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6776 Ayala Avenue, Makati City

**AUMENTO & ASSOCIATES LAW OFFICES**

*Counsel for Respondent- Applicant*

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26<sup>th</sup> Street, Bonifacio Global City, Taguig

**GREETINGS:**

Please be informed that Decision No. 2017 - 55 dated 28 February 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, 02 March 2017.

**MARILYN F. RETUAL**

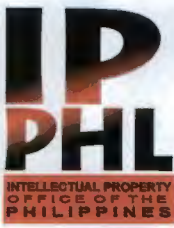
IPRS IV

Bureau of Legal Affairs

**Republic of the Philippines  
INTELLECTUAL PROPERTY OFFICE**

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**THE ADF FAMILY TRUST AND  
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IPC No. 14-2014-00017  
Opposition to:

Appln. No. 4-2013-0500697  
Date Filed: 12 March 2013  
Trademark: "SHASA"

Decision No. 2017 - 55

**DECISION**

NEW BARBIZON FASHION INC. ("Opposer"),<sup>1</sup> filed an opposition to Trademark Application Serial No. 4-2013-500697. The application, filed by THE ADF FAMILY TRUST AND THE CDF FAMILY TRUST ("Respondents-Applicants")<sup>2</sup>, covers the mark "SHASA" for use on goods under classes<sup>3</sup> **14**: *precious metals and their alloys, goods in precious metals or coated therewith, namely, ornamental pins, earrings, bracelets, necklaces, rings, jewelry, precious stones, horological and chronometric instruments, leather and imitation leather necklaces*; **25**: *clothing, namely, shirts, blouses, coats, sweaters, scarves, pants, shorts, belts, slacks, leggings, tights, shrugs, gloves, jackets, footwear, headgear, namely, hats, berets, headbands, earmuffs, scarves, leather and imitation leather*; and, **35**: *ace and embroidery*.

The Opposer alleges that is the owner of the "SASSA" trademarks having been the first to adopt and use the same in actual trade and commerce in the Philippines. On 28 March 2003, Opposer filed an application for registration of "SASSA" trademark with the Intellectual Property Office of the Philippines (IPOPIL) under Trademark Application No. 4-2003-002919 covering garments, ladies sportswear (jogging pants, jazz pants, shorts, tank tops, exercise tops, leotards, tights) and ladies swimwear under class 25. Opposer's "SASSA" trademark was first used locally on 28 July 2003. Its products were first sold and distributed by and/at several reputable department stores.

Subsequently, "SASSA" trademark was issued Registration No. 4-2007-008151 on 07 January 2008 by the IPOPIL, while "SASSA ACTIVEWEAR & LOGO" trademark was issued Registration No. 4-2007-009211 on 12 January 2009, both covering class 25.

Opposer's "SASSA" trademarks have been used, promoted and advertised for a considerable duration of time in several areas in the Philippines. It has invested tremendous amount of resources in promotion and advertisement, and has in fact, earned and reaped its distinction in the industry and are now patronized in almost all parts of the country.

<sup>1</sup> A domestic corporation duly organized, existing and in good standing under the laws of the Philippines with address at Unit 401 VFP-MDC Bldg., 2 Veterans Road, Veterans Center, Western Bicutan, Taguig, Metro Manila.

<sup>2</sup> With registered address at 1401 Mckinney Street, Suite 2200 Houston Texas.

<sup>3</sup> 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.



According to the Opposer, there is a likelihood of confusion between Respondents-Applicants' "SHASA" mark and Opposer's "SASSA" and "SASSA ACTIVEWEAR & LOGO" trademarks, as well as the undeniable identity and relation of the goods and services of the parties. The use by Respondents-Applicants' "SHASA" mark will definitely mislead the public into believing that its products originate from, or are licensed or sponsored by Opposer or that Respondents-Applicants are associated with or an affiliate of the Opposer.

The Opposer submitted the following evidence:

1. Affidavit by Irish Hazel Manaois, Opposer's Accounting Manager;
2. Certificate of Registration No. 4-2007-008151 for the mark "SASSA" under class 25;
3. Certificate of Registration No. 4-2007-009211 for the mark "SASSA ACTIVEWEAR & LOGO" under class 25;
4. Sample hangtags of the "SASSA" trademarks;
5. Photographs of billboards and other promotional and advertising materials using "SASSA" and "SASSA ACTIVEWEAR & LOGO";
6. Photographs of stores selling products bearing the "SASSA" trademarks;
7. Certified true copy of flyers used in Opposer sponsored events;
8. Copies of newspaper advertisements in Manila Bulletin on 09 March 2005;
9. Photographs taken during the Bb. Lungsod ng Batangas 2005; and,
10. Sales Report and Invoices for "SASSA" products.

This Bureau issued and served upon Respondents-Applicants a Notice to Answer. Respondents-Applicants filed its Answer on 13 June 2014. However, the attached Special Power of Attorney is a mere photocopy, thus, this Bureau issued an Order directing the filing of the original, legalized and authenticated Special Power of Attorney. Respondents-Applicants failed to comply with the Order despite reasonable period provided. Thus, Respondent-Applicant is declared in default and this case is deemed submitted for decision.<sup>4</sup>

Should the Respondents-Applicants be allowed to register the trademark SHASA?

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.<sup>5</sup>

Records show that at the time the Respondents-Applicants filed its application for the trademark "SHASA" on 12 March 2013<sup>6</sup>, herein Opposer already has existing registration for the trademarks "SASSA"<sup>7</sup> and "SASSA ACTIVEWEAR & LOGO"<sup>8</sup> with Registration Nos. 4-2007-008151 and 4-2007-009211, respectively. Both are dated prior to that of Respondents-Applicants.<sup>9</sup> Moreover, the goods are deemed related, which in particular includes class 25. In the Philippines, a certificate of registration constitutes a prima facie evidence of the validity of the registration, the registrant's ownership of the

<sup>4</sup> Order of Default dated 26 July 2016.

<sup>5</sup> 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).

<sup>6</sup> Filewrapper records.

<sup>7</sup> Exhibit "B" of Opposer.

<sup>8</sup> Exhibit "C" of Opposer.

<sup>9</sup> Trademark registrations dated 07 January 2008 and 12 January 2009.

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.<sup>10</sup>

The competing marks are reproduced below for comparison and scrutiny:

SASSA

The logo for SASSA activewear, featuring the word "sassa" in a lowercase, sans-serif font with a curved line above it, and the word "activewear" in a smaller, lowercase font below it.

Opposer's Trademarks

The logo for shasa, featuring the word "shasa" in a lowercase, serif font with a decorative flourish above the "a".

Respondents-Applicants Trademark

It appears that the competing marks are phonetically similar, consisting of two syllables and similar letters, except for the letter "h" located in between the dominant letters "s" and "a". They have similar sound and appearance which apparently produce significant similarity when pronounced. Further, the illustrated marks cover similar and/or related goods, more particularly class 25. Indeed, 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 merely adding, removing or changing some letters of a registered mark. 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.<sup>11</sup> 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.<sup>12</sup>

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:<sup>13</sup>

Callman 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

<sup>10</sup> Sec. 138, IP Code.

<sup>11</sup> Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 04 April 200, 356 SCRA 207, 217.

<sup>12</sup> Converse Rubber Corporation v. Universal Rubber Products, Inc., et al., G.R. No. L-27906, 08 January 1987.

<sup>13</sup> Id.

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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;

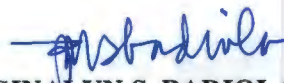
Corollarily, the public interest requires that the two marks, identical to or closely resembling each other and used on the same and closely related goods, but utilized by different proprietors should not be allowed to co-exist. Confusion, mistake, deception, and even fraud, should be prevented. It is 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 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.<sup>14</sup>

In contrast, the Respondents-Applicants despite the opportunity given, failed to explain how it arrived at using the mark "SHASA". The Opposer's marks "SASSA" and "SASSA ACTIVEWEAR & LOGO" containing the word "SASSA" are unique and highly distinctive with respect to the goods it is attached with.

**WHEREFORE**, premises considered, the instant Opposition to Trademark Application No. 4-2013-500697 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. **28 FEB 2017**



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

<sup>14</sup> Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114508, 19 Nov. 1999.