MANGO TOURS, INCORPORATED,
Opposer,

- versus -

EASTGATE PUBLISHING CORP.,
Respondent-Applicant.
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IPC No. 14-2009-00179
Case Filed on: 22 July 2009

Opposition to:
App. Serial No. 4-2009-002487
Date Filed: 10 March 2009
TM: "MANGO (More than Travel) & Device"

Decision No. 2010-37

DECISION

MANGO TOURS, INCORPORATED ("Opposer"), is a domestic corporation with principal place of business at G/F Classica I Condominium, 112 H.V. Dela Costa, Salcedo Village, Makati City, filed an opposition to Trademark Application Serial No. 4-2009-002487.[1] The application, filed by EASTGATE PUBLISHING CORPORATION ("Respondent-Applicant"), also a domestic corporation with principal office address at 704 Prestige Tower Condominium, F. Ortigas Jr. Road, Pasig City1605, covers the mark "MANGO" for use on magazines under Class 16 of the International Classification of Goods. [2]

The Opposer alleges the following:

"1. Oppositor Mango Tours is a duly incorporated corporation engaged in providing travel arrangements and coordination, visa and passport application, as well as booking services domestic and abroad xxx.

"2. The oppositor has duly registered its conduct of business and corporate name as 'MANGO TOURS INCORPORATED'. x x x.

"3. Oppositor has six (6) branches overseas and currently affiliated and recognized by various international travel agencies such as the American Society of Travel Agents using the name Mango Tours in the market. x x x. Oppositor is currently an applicant before this Honorable Office for registration of the trademark 'Mango Tours' under Number 39 of the Nice Classification of services.

"4. Applicant on the other hand for trademark "Mango (More than Travel)' is one engaged in publication and printing magazines under Number 16 of the Nice Classification of goods with no direct relation in traveling. In fact, the trademark applied for does not bear any semblance in relation to publishing magazines or anything of that sort.

"5. Nevertheless, applicant included in its trademark application 'more than travel' which will be prejudicial to the entity using and applying the trademark "Mango Tours' engaged in the very business that the contested phrase depicts and suggests to the market and general public.

"6. Verily therefore, applicant should not be allowed to have such trademark applied for or, at the very least, referral to travel should at least be removed or deleted to avoid confusion and deception on the nature and type of business it is engaged in."

1 The application was published in the Intellectual Property E-Gazette on 24 June 2009

2 The 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.

The Opposer's evidence consists of the following:

1. Exhibit "A" - General Information Sheet and Articles of Incorporation of Mango Tours, Incorporated;
2. Exhibit "B" - Copy of Certificate of Registration of Business Name;
3. Exhibit "C" - Copy of Business Permit issued by Makati City;
4. Exhibit "D" - Copy of the Department of Tourism (DOT) Accreditation No. To-200-2008;
5. Exhibit "E" - Copy of Partners Profile; and
6. Exhibit "F" - Sample of domestic brochure.

This Bureau issued on 11 August 2009 a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 18 August 2009. On 14 September 2009, the Respondent filed its Answer alleging the following:

"2. In its Verified Notice, the Opposer submits that the trademark application 'Mango More than Travel' will be prejudicial to their trademark application. Opposer continues that the Respondent-Applicant 'should not be allowed to have such trademark applied for or, at the very least, referral to travel should at least be removed or deleted to avoid confusion and deception on the nature and type of business it is engaged in' .

"3.The issues at hand are whether the registration of the trademark MANGO by Respondent-Applicant is prejudicial to Opposer's mark MANGO TOURS with Application No. 42009007125?

"4. Respondent-Applicant's answer is in the negative. Firstly, the respondent-applicant is a duly registered corporation primarily engaged in magazine publication. It is the award winning publisher of Philippine Airlines' (PAL) award-winning travel and lifestyle magazine -MABUHAY magazine. To date, Eastgate Publishing Corporation has amassed fifteen (15) national and international awards.

The respondent-applicant applied for the trademark 'MANGO (More than Travel) & Device' to cover magazine under Class 16. The magazine does away with boring straightforward articles on travel destination. Mango caters to discriminating magazine readers who seek multifarious articles and features designed to leave its readers with the deeper and more meaningful appreciation and interaction with the featured destination. The said trademark, together with its distinct design, is a result of rigorous conceptualization with the prime motive of being appealing to its chosen clientele. The overall appearance of the trademark is made to be distinctive and catchy in order to 'nail a niche' in the industry market. The aforementioned explanation is consistent with the essence of true trademark, as recited in Sec. 121.1 of Republic Act No. 8293, otherwise known as 'The Intellectual Property Code'.

"5. The respondent-applicant submits the following arguments negating 'prejudice' as claimed by the Opposer;

The trademark MANGO (More than Travel) & Device is capable of trademark registration.

The trademark 'MANGO (More than Travel) & Device' is distinct and as eloquently stated in Opposer's Notice 'the trademark applied for does not bear any semblance in relation to publishing magazine'. While it is true that 'no semblance' can be found with the trademark vis-a-vis the product being applied, it's not a hindrance to its registrability in accordance with Republic Act 8293. The trademark is arbitrarily chosen to cover the magazine publication; preliminary observation does bring about a 'no semblance' setting. This nonetheless strengthen its trademark registrability, as contemplated in the Supreme Court Ruling under G.R. No. 143993 (August 18, 2004), which states, 'xxx arbitrary marks as it bears no logical relation to the actual characteristics of the product it represents. As such, it is highly distinctive and thus valid.'

Respondent-applicant's trademark is not similar with the mark being applied by Opposer.

Notwithstanding the fact that herein trademark is a senior application compared to Opposer's trademark, respondent-applicant sees no conflict of interest between the two commodities being pushed by both parties. The likelihood of confusion between the two marks in the minds of the relevant public is practically nil. Respondent-applicant takes into consideration the purchasers, the nature of the products, and whether or not the products are related to each other. The characteristics of purchasers of our magazine are not likely to be confused with patrons catered by Opposer's business operation. This is mainly attributed to the measure of association between 'magazines' and travel agency services'. Without need of reference, the aforementioned product lines have little association as it flows 'through different trade channels', thus, not enough to confuse the relevant public on the originators of these commodities being one and the same."

The Respondent-Applicant submitted the following pieces of evidence:

1. Exhibit "A" - Secretary's Certificate;

2. Exhibit "B" - Copy of Eastgate Publishing Corporation's Articles of Incorporation;

3. Exhibit "C" - Copy of Trademark Application No. 4-2009-002487 for the mark "MANGO (More than Travel) & Device" and Notice of Allowance;

4. Exhibit "D" - Copy of Mango (More than Travel) Magazine; and

5. Exhibit "E" won by Mabuhay Magazine published by Opposer -List of Awards.[3]

The Opposer filed a Reply on 25 September 2009 attaching thereto a copy of a Certificate of Registration of the mark "Mango Tours" in the United States[4] and a printout of its pending application for its mark with this Office[5] as additional evidence. During the preliminary conference on 25 November 2009, only the Opposer's counsel appeared. The counsel moved that the Respondent-Applicant be deemed to have waived its right to submit the position paper. The motion was granted and the preliminary conference was terminated. Accordingly, this Bureau issued Order No. 2010-194 requiring the Opposer to submit its position paper which it did on 22 February 2010.

Should the Respondent-Applicant be allowed to register the mark "MANGO (More than Travel) & Device"?

The essence of trademark registration is to give protection to the owner of the trademarks. The function of a trademark is to point out distinctly the origin or ownership of the article to which it is affixed, to secure to him, who has been instrumental in bringing into a 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 products.[6]

The Opposer anchors its opposition on the ground that it has used the mark MANGO TOURS long before the Respondent-Applicant has used the mark MANGO (More than Travel) & Device and filed a trademark application.

The contending marks are reproduced below for comparison.

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3 Evidence should have been marked as Exhibits "1" to "5" instead of Annexes "A" to "E" as required by the Inter Partes Rules and Regulations

4 See Exhibit "G" attached to the Reply

5 See Exhibit "H" attached to the Reply

6 *Pribhdas J. Mirpuri v. Court of Appeals,* G.R. No. 114508, 19November 1999, citing *Etepha v. Director of Patents,* 16 SCRA 495.

Opposer's Mark Respondent-Applicant's Mark

Obviously, the word "Mango" and the representation or picture of the mango fruit are the distinctive features of both marks. In this regard, "mango" is not a coined or invented word and is used as a mark for different goods. The Trademark Registry reveals that the word MANGO has been used and registered as a mark in various classes such as goods in Class 03[7] and Class 16[8] , or a feature in composite marks like MANGO BLOOM for goods under Class 01[9] and GOLDEN DRAGON MANGO for goods under Class 30[10].

Thus, the question now is: Would the Respondent-Applicant's registration and use of the mark MANGO (More than Travel) & Device cause confusion or mistake on the part of the consumers?

There are two (2) 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 purchasing the other."... 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 the belief that there is some connection between the plaintiff and defendant which, in fact, does not exist."[11] In cases of confusion of business or origin, the question that usually arises is whether the respective goods or services of the senior user and the junior user are so related as to likely cause confusion of business or origin, and thereby render the trademark or trade names confusing similar. [12]

In Esso *Standard Eastern, Inc. v. Court of Appeals*[13], the Supreme Court held that:

> "Goods are related when they belong to the same class or have the same class or descriptive properties; when they possess the same physical attributes or essential characters with reference to their form, composition, texture or quality. They may also be related because they serve the same purpose or sold in grocery store. Thus, biscuits were held related to milk because they are both food products. Soap and perfume, lipstick and nail polish are similarly related because they are common household items nowadays. The trademark 'Ang Tibay' for shoes and slippers and pants were disallowed to be used for shirts and pants because they belong to the same general class of goods. Soap and pomade, although non-competitive, were held to be similar or to belong to the same class, since both are toilet articles."

In the instant case, the mark MANGO TOURS is used on travel assistance services, which include providing travel arrangement and coordination, passport processing/visa application and booking services whether domestic or international under Class 39. On the other hand, the Respondent-Applicant's mark MANGO (More than Travel) & Device is used on magazines under Class 16. The parties' goods and/ or services do not belong to the same class of goods nor do they serve the same purpose. They do not flow through the same channels of trade. Clearly, the parties' goods and/or services are unrelated and non-competing. A person

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7 See Registration No. 4-2002-005356, Trademark Registry of IPO.
8 See Registration No. 4-2002-002057, Trademark Registry of IPO
9 See Registration No. 4-2000-7292, Trademark Registry of IPO.
10 See Registration No. 4-1995-100391, Trademark Registry of IPO.
11 *McDonald's Corporation vs. L.C. Big Mak Burger, Inc.,* G.R. No. 143993. 18 August 2004.
12 *Canon Kabushiki Kaisha vs. Court of Appeals,* G.R. No. 120900, 20 July 2000.
13 G.R. No. L-29971, August 31, 1982.

who wants to avail of the travel assistance services of the Opposer would not go to a store or a stall that sells magazines or vice versa. Hence, the possibility that the public will connect or associate the Opposer's goods and/ or services with that of the Respondent-Applicant is very remote. The disparity in the class and the nature of the goods and/or services covered by the competing marks would prevent any likelihood of confusion or deception.

The rule that ownership of a trademark or trade name is a right that the owner is entitled to protect has been upheld in our jurisdiction. However, when a trademark is used by a party on a product in which the other party does not deal, the use of a same trademark on the latter's product cannot be validly objected to. [14]

The mere fact that one person has adopted and used a trademark on his goods or services does not prevent the adoption and use of the same trademark by others on unrelated articles/services of a different kind.[15] The evident disparity of the goods and/or services of the parties in this case renders unfounded the apprehension of the Opposer that confusion of business or origin might occur if the Respondent-Applicant is allowed to register its mark.

Thus, that the Respondent-Applicant was inspired or motivated by intent to ride in on the goodwill of the Opposer's mark, cannot be inferred. The vast difference in the products or services would not indicate any undue benefit to the Respondent-Applicant at the expense of the Opposer.

WHEREFORE, premises considered the instant opposition to Trademark Application Serial No. 4-2009-002487 is hereby DENIED. Let the filewrapper of Trademark Application Serial No. 4-2009-002487 be returned together with a copy of this DECISION to the Bureau of Trademarks (BOT) for appropriate action.

SO ORDERED.

Makati City, 12 July 2010.

NATHANIEL S. AREVALO
Director, Bureau of Legal Affairs
Intellectual Property Office

14 George W. Luft Co., Inc. vs. Ngo Guan, 18 SCRA 944 (1966)
15 American Foundries vs. Robertson, 269 US 372,381