



FERRERO S.p. A.,
Opposer,

-versus-

PURE SNACK FOOD HOUSE CORP.,
Respondent- Applicant.

X-----X

}
} IPC No. 14-2010-00166
} Opposition to:
} Appln. Serial No. 4-2008-014659
} Date Filed: 04 December 2008
} TM: "TIK TAK"

NOTICE OF DECISION

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PURE SNACK FOOD HOUSE CORPORATION

Respondent-Applicant
11 LBICA Compound, Malinis Street
Lawang Bato, Valenzuela City

GREETINGS:

Please be informed that Decision No. 2014 - 115 dated April 22, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, April 22, 2014.

For the Director:

Edwin A. Dating
Atty. EDWIN DANILO A. DATING
Director III
Bureau of Legal Affairs



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IPC No. 14-2010-00166

Appln. Serial No. 4-2008-014659

Filing Date: 04 December 2008

Trademark: "TIK TAK"

Decision No. 2014 - 115

DECISION

FERRERO S.p.A.¹ filed an opposition to Trademark Application Serial No. 4-2008-014659. The application, filed by PURE SNACK FOOD HOUSE CORP. ("Respondent-Applicant")², covers the mark "TIK TAK" for use on "corn puff, cornchips, corn snack" under class 30 of the International Classification of Goods and Services³.

The Opposer alleges among other things the following:

"I. Opposer Is The Owner of the 'TIC TAC' Trademarks, Which Are Registered In The Philippines And Have Come To Be Exclusively Associated With Opposer's Products In The Public's Mind Through Opposer's Continuous And Exclusive Use Thereof In Philippine Commerce For The Past Two (2) Decades.

"1.1. Opposer is the true owner of the mark 'TIC TAC' and variations thereof, which are covered by active Philippine trademark registrations (collectively, registered 'TIC TAC' trademarks), all in International Class 30, x x x

"1.2. Opposer first used 'TIC TAC' as a trademark in the Philippines in 1990. Attached hereto as Exhibit 'F' is a certified true copy of the Fifteenth (15th) Anniversary Declaration of Actual Use executed by Opposer and filed on 28 July 2008 in connection with Philippine Trademark Registration No. 054828 for the mark 'TIC TAC', which indicates that the said mark was first used in 1990.

"1.3. Under Section 2-A of Republic Act No. 166, the precursor of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines ('IP Code'), ownership of a trademark could be acquired not by registration but by actual use thereof. x x x

"1.4. Following the provisions of Republic Act No. 166, which was the law in effect at the time Opposer first used and registered 'TIC TAC' trademarks, Opposer is deemed to be the true owner thereof.

"1.5. On the other hand, Section 122 of the IP Code provides that 'the rights in the mark shall be acquired through registration made validly in accordance with the provisions of this law.' Thus, Opposer also registered its 'TIC TAC' trademarks under the IP Code. This act of

¹ A corporation duly organized and existing under the laws of Italy with principal office address at Piazaale Pietro Ferrero, 1, Alba (Cuneo), Italy.

² A domestic corporation with address at 11 LBICA Compound, Malinis St., Lawang Bato, Valenzuela City.

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.

registration unquestionably consolidated true and lawful ownership thereto upon Opposer, who is therefore entitled to the law's protection from the use of an identical mark or any colourable imitation thereof without its consent.

"1.6. Hence, Opposer is entitled to the rights of trademark registrants under the law such as the exclusive right to prevent all third parties not having its consent from using in the course of trade identical or similar signs or containers for goods or services which are identical or similar to those in respect of which its trademark is registered where such use would result in a likelihood of confusion.

"II. Respondent-Applicant's Proposed Mark 'TIK TAK' Cannot Be Registered Because It Infringes On Opposer's Registered 'TIC TAC' Trademarks.

x x x

"A. Respondent-Applicant's Proposed Mark 'TIK TAK' is Confusingly Similar To Opposer's Registered 'TIC TAC' Trademarks.

"3.1. Respondent-Applicant's application for the registration of the mark 'TIK TAK' should be denied because the same is confusingly similar to Opposer's registered 'TIC TAC' trademarks. In determining the likelihood of confusion, the following factors must be considered: [a] the resemblance between the marks; [b] the similarity of goods to which the trademarks are attached; [c] the likely effect on the purchaser; and [d] the registrant's express or implied consent and other fair and equitable considerations.'

x x x

"B. Respondent-Applicant's Use of The Mark 'TIK TAK' On Goods Under Class 30 Is Likely To Casue Confusion Or Mistake Or Deceive Purchasers As To The Source Or Origin Of These Goods.

"4.1. Section 138 of the IP Code embodies the principle that protection of registered trademarks extends not only to use of the mark on goods or services specified in the certificate of registration, but likewise to goods and services related thereto. x x x

"4.2. In this case, the goods in connection with which Respondent-Applicant proposes to use the mark 'TIK TAK' are ordinary household products in the same International Class as coffee, tea, cocoa, sugar, rice, tapioca, sago, coffee substitutes flour and preparations made from cereals; bread, biscuits, cakes, pastry and confectionary, ices, honey, treacle, yeast, baking powder; salt; mustard, pepper, vinegar, sauces, spices and candies; corn puff, cornchips, corn snack. In short, all of these products are snack items that are easily bought at retails shops, even at your friendly neighbourhood sari-sari store.

x x x

"III. Opposer's Registered Mark 'TIC TAC' Is Well-Known Internationally And In The Philippines, And Thus Precludes The Registration Of The Mark 'TIK TAK' For Use On Similar Goods.

"5.2. The mark 'TIC TAC' is well-known internationally and in the Philippines. 'TIC TAC' breath mints were first introduced in Italy in the 1960s. When the Ferrero family decided to market their products beyond Europe, they chose the 'TIC TAC' brand as their key to entry into the North American market in 1969, Ferrero set up a sales office in New York City. Opposer obtained its trademark registration for 'TIC TAC' in the United Kingdom on 14 April 1969 and shortly thereafter, in the United States on 15 July 1969. The mark 'TIC TAC' has also been

registered in the name of Opposer in numerous countries, including large Asian economies like China, Japan, India and Hong Kong.

"5.3. For its tireless industry, unlimited perseverance, and marketing strategy, Opposer's registered 'TIC TAC' trademarks have undeniably become a household name in the Philippines. Further, the products covered by the same have so penetrated the market as to become available literally right around the corner from every Filipino, in convenience stores and supermarkets. x x x

"5.6. In addition, Opposer has widely advertised in print and broadcast media over the years, spending millions of dollars in expenses for the advertisement and promotion of its products bearing the mark 'TIC TAC'. It is also significant to note that orange-flavored 'TIC TAC' breath mints figured prominently in the 2007 critically-acclaimed sleeper hit movie, 'Juno'.

"5.7. As a consequence of Opposer's extensive use, sales, advertising and promotion of the mark for decades throughout various countries in the world, the mark 'TIC TAC' has become popular among consumers and has achieved a vast and unparalleled public recognition/awareness and positive reputation in the international market, and, thus, has become an internationally well-known mark. It also bears noting that to date, the goods bearing Opposer's registered mark 'TIC TAC' are the most-widely sold breath mint worldwide, with gross annual sales amounting to almost Two Hundred Million United States dollars.

x x x

"5.10. It must be noted that Respondent-Applicant filed for the application of the mark 'TIK TAK' only on 04 December 2008, long after Opposer's 'TIC TAC' trademarks were registered with the Honorable Office beginning on 16 April 1993 and long after the 'TIC TAC' brand of breath mints became popular worldwide. Considering the worldwide popularity of the 'TIC TAC' mark, combined with the striking similarities of the competing marks, it is readily apparent that Respondent-Applicant conceptualized its mark intending to ride on the popularity and goodwill of Opposer's mark."

The Opposer's evidence consists of the following:

1. Exhibit "A" - Printout of Ferrerto SpA Company History;
2. Exhibit "B" - Printout of IPO e-Gazette showing Respondent-Applicant's application for TIK TAK;
3. Exhibit "C" - Copy of Opposer's registration for TIC TAC wordmark;
4. Exhibit "D" - Copy of Opposer's registration for TIC TAC INSIDE A LEAF";
5. Exhibit "E" - Copy of Opposer's registration for TIC TAC;
6. Exhibit "F" & "F-1"- Certified true copy (CTC) of 15th Anniversary Declaration of Actual Use by Opposer;
7. Exhibit "G-1"- "G-3"- Receipts issued by different retail stores for the purchase of TIC TAC items;
8. Exhibit "H" - Image of actual items purchased;
9. Exhibit "I" - Legalized certification/affidavit executed by Opposer's Proxy Holders, Daniele Lingua and Massimo Gaidano;
10. Exhibit "I-1"- "I-23"- Copy of worldwide registration of TIC TAC;
11. Exhibit "J"- "J-1" - Copy of History of Sponsorship in Formula 1;
12. Exhibit "K" - Downloaded document on The Top 25 F1 Liveries of All Time
13. Exhibit "L"- "L-1" - Downloaded document on the History of TIC TAC; and,

14. Exhibit "M" - Authenticated Certificate of Massimo Gaidano and Giordano Cardini.

This Bureau issued and served upon the Respondent-Applicant a Notice to Answer on 13 October 2010. Respondent-Applicant however, did not file an answer. Thus, the Respondent-Applicant was declared in default and the case deemed submitted for decision.

Should the Respondent-Applicant be allowed to register the trademark TIC TAC?

The Opposers anchor their opposition on Section 123.1(d) of Republic Act No. 8293, otherwise known as The Intellectual Property Code of the Philippines, which provides that:

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;

As culled from the records and the evidence presented by the parties, at the time the Respondent-Applicant filed its trademark application on 04 December 2008⁴, the Opposer has prior applications and registrations issued for the following trademarks: "TIC TAC" WORDMARK (filing date: 05 April 1990; registration date: 16 April 1993)⁵; "TIC TAC INSIDE A LEAF DEVICE" (filing date: 21 April 1993; registration date: 29 March 1995)⁶; and, "TIC TAC" (filing date: 21 April 1993; registration date: 10 October 1995)⁷.

But, are the contending marks, depicted below, resemble each other such that confusion, even deception, is likely to occur?



TIC TAC

Opposer's Trademarks

⁴ File wrapper records.
⁵ Exhibit "C" of Opposer.
⁶ Exhibit "D" of Opposer.
⁷ Exhibit "F" of Opposer.

Tik Tak

Respondents-Applicants' Trademark

The resemblance of the foregoing marks is unmistakable. The only difference is the ending letters C and K which when spoken, produce no difference in its aural property. With respect to the goods covered, the Opposer's goods include coffee, tea, cocoa, sugar, rice, tapioca, sago, coffee substitutes flour and preparations made from cereals; bread, biscuits, cakes, pastry and confectionary, ices; honey, treacle, yeast, baking powder; salt, mustard; pepper, vinegar, sauces, spices, ice;⁸ and, candies;⁹ whereas, Respondent-Applicant's goods include corn puff, corn chips, and corn snack.¹⁰ These goods appear closely related to each other. They are both food items which belong to the same classification of goods, and flow on the same channels of trade.

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.¹¹ Colorable imitation does not mean such similitude as amount to identify, nor does it require that all details be literally copied. Colorable imitation refers to such similarity in form, context, words, sound, meaning, special arrangement or general appearance of the trademark or tradename with that of the other mark or tradename 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.¹²

It is stressed that the determinative factor in a contest involving trademark registration is not whether the challenged mark would actually cause confusion or deception of the purchasers but whether the use of such mark will likely cause confusion or mistake on the part of the buying public. To constitute an infringement of an existing trademark, patent and warrant a denial of an application for registration, the law does not require that the competing trademarks must be so identical as to produce actual error or mistake; it would be sufficient, for purposes of the law, that the similarity between the two labels is such that there is a possibility or likelihood of the purchaser of the older brand mistaking the newer brand for it.¹³ The likelihood of confusion would subsist not only on the purchaser's perception of goods but on the origins thereof as held by the Supreme Court:¹⁴

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 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.

⁸ Exhibit "C" of Opposer.

⁹ Exhibits "D" and "E" of Opposer.

¹⁰ Filewrapper records.

¹¹ Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 04 April 2001, 356 SCRA 207, 217.

¹² Emerald Garment Manufacturing Corp. V. Court of Appeals, G.R. No. 100098, 29 December 1995.

¹³ American Wire and Cable Co. v. Director of Patents, et al., (31 SCRA 544) G.R. No. L-26557, 18 February 1970.

¹⁴ Converse Rubber Corporation v. Universal Rubber Products, Inc., et al., G.R. No. L-27906, 08 January 1987.

The field from which a person may select a trademark is practically unlimited. As in all cases of colourable imitation, the unanswered riddle is why, of the millions of terms and combination of letters and designs available, the Respondent-Applicant had come up with a mark identical or so clearly similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark.¹⁵

Accordingly, this Bureau finds that the Respondent-Applicant's trademark application is proscribed by Sec. 123.1 (d) of the IP Code.

WHEREFORE, premises considered, the instant opposition is hereby **SUSTAINED**. Let the file wrapper of Trademark Application Serial No. 4-2008-014659 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 22 April 2014.


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

¹⁵ American Wire and Cable Co. v. Director of Patents et. al. (SCRA 544), G.R. No. L-26557, 18 Feb. 1970.