



**LIWAYWAY MARKETING CORP.,**  
Opposer,

**-versus-**

**ANTONIO L. TAN,**  
Respondent-Applicant.

X-----X

} **IPC No. 14-2011-00427**  
}  
} Opposition to:  
} Appln. Serial No. 4-2010-010586  
} Date filed: 27 September 2010  
} **TM: "OSHIMANJU"**  
}  
}  
}  
}

**NOTICE OF DECISION**

**ANGARA ABELLO CONCEPCION REGALA & CRUZ**

Counsel for Opposer  
22<sup>nd</sup> Floor, ACCRALAW TOWER  
Second Avenue corner 30<sup>th</sup> Street  
Crescent Park West, Bonifacio Global City  
Taguig City

**ANTONIO L. TAN**

Respondent-Applicant  
Suite 200 Del Monte Mansion Bldg.  
Del Avenue, cor. Speaker Perez St.,  
Quezon City

**TRADEMARKKS & INTELLECTUAL PROPERTY SERVICES, INC**


Counsel for Respondent-Applicant  
Unit 1607-A 16<sup>th</sup> Floor, AIC Burgundy Empire Tower  
ADB Avenue, Ortigas Center, Pasig City

**GREETINGS:**

Please be informed that Decision No. 2013 - 03 dated January 03, 2013 ( copy enclosed) was promulgated in the above entitled case.

Taguig City, January 03, 2013.

For the Director

  
**Atty. PAUSI U. SAPAK**  
Hearing Officer  
Bureau of Legal Affairs



LIWAYWAY MARKETING CORP.,  
Opposer,

- versus -

ANTONIO L. TAN,  
Respondent-Applicant.

x-----x

IPC No. 14-2011-00427

Opposition to:

Appln. Serial No. 4-2010-010586

Date Filed: 27 September 2010

Trademark: OSHIMANJU

Decision No. 2013 - 23

## DECISION

LIWAYWAY MARKETING CORPORATION ("Opposer")<sup>1</sup> filed on 14 November 2011 a Verified Notice of Opposition to Trademark Application Serial No. 4-2010-010586. The application, filed by ANTONIO L. TAN ("Respondent-Applicant")<sup>2</sup>, covers the mark OSHIMANJU for use on "*small cakes with fillings*" under Class 30 of the International Classification of Goods.<sup>3</sup>

The Opposer alleges, among other things, the following:

- A. Opposer's OISHI marks were registered and used in the Philippines prior to Respondent-Applicant's application for the registration of the mark 'Oshi Manju', giving Opposer the exclusive ownership of the mark OISHI and the right to prevent others from using and registering marks that are confusingly similar thereto such as Respondent-Applicant's 'Oshi Manju' mark;
- B. Opposer's OISHI marks are well-known in the Philippines and worldwide, entitling the Opposer protection from the use and registration of confusingly similar marks such as Respondent-Applicant's 'Oshi Manju' mark;
- C. The trademark applications filed by Respondent-Applicant and his business called Colent Enterprise Co. clearly show his intent to associate his 'Oshi Manju' mark with his products bearing the mark 'Oshi Manju', capitalizing upon the goodwill of Opposer's OISHI marks; and
- D. Opposer will suffer substantial damage due to the use and registration of Respondent-Applicant's 'Oshi Manju' mark as it is confusingly similar with Opposer's OISHI marks and its variants considering that they all cover closely

<sup>1</sup> Is a corporation organized and existing under the laws of the Philippines with office address at 2225 Tolentino Street, Pasay City, Metro Manila.

<sup>2</sup> A Filipino with address at Suite 200 Del Monte Mansion Bldg., Del Monte Avenue, corner Speaker Perez Street, Quezon City.

<sup>3</sup> The Nice Classification is a classification of goods and services for the purpose of registering trademark and services marks, based on the 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 Purpose of the Registration of Marks concluded in 1957.

related and almost identical goods, which confusing similarity is further established by:

D.1. A visual comparison of Respondent-Applicant's 'Oshi Manju' mark and Opposer's OISHI marks; and

D.2. An aural comparison of Respondent-Applicant's 'Oshi Manju' mark and Opposer's OISHI marks."

The Opposer's evidence consists of the following:

1. Copy of the application details of 'Oshi Manju' taken from the Intellectual Property Office's online database, last visited 17 September 2011;
2. Affidavit of Mr. Salvador C. Aguilar;
3. Various sources similarly defining "MANJU" as a cake or pastry; and
4. Copy of the mark 'OSHI MANJU' bearing Serial No. 4-2006-003300, applicant TAN JOSE which was refused registration (September 20, 2007) used on battery Products.<sup>4</sup>

This Bureau issued a Notice to Answer and served upon the Respondent-Applicant. However, the Respondent-Applicant did not file his Verified Answer. Hence, this Opposition proceeding is considered submitted for decision based on the opposition and evidence submitted by the Opposer.

Should the Respondent-Applicant's trademark application be allowed?

It is emphasized that the essence of trademark registration is to give protection to the owners of the 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 of his products.<sup>5</sup> Thus, Section 123.1 (d) of R.A. No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code") provides that a mark cannot be registered if it is identical with a registered mark belonging to a different proprietor or a mark with an earlier filing or priority date in respect of the same goods or services or closely related goods and services, or if it nearly resembles such a mark as to be likely to deceive or cause confusion.

<sup>4</sup>Marked as Exhibits "A" to "D" with attached Annexes.

<sup>5</sup> Pribhdas J. Mirpuri v. Court of Appeals, G.R. No. 114509, 19 November 1999.

The records show that at the time the Respondent-Applicant filed his trademark application on 27 September 2010, the Opposer already has an existing trademark registration for the mark OISHI under Reg. No. 4-2003-009764, registered on 17 August 2006 for "sauces (condiments) and candies" under Class 30 and "juices, fruit drinks, soft drinks, ice teas, soda, mineral water" under Class 32<sup>6</sup> and Reg. No. 4-2000-001439 for "snack food products, namely, chips, fries, pizzas, crunches, crisps, flakes, crackers, cookies, nuts, breads made from floury or starch substances" under Class 30.<sup>7</sup> On the other hand, the Respondent-Applicant's trademark application is used on "small cakes with fillings" under Class 30. The goods, therefore, are used on similar or closely related goods.

But are the competing marks, as shown below, identical or similar or resemble each other such that confusion, mistake or deception is likely to occur?

The logo for 'Oishi' is written in a bold, rounded, bubbly font with a thick black outline and a white fill. The letters are closely spaced and have a playful, informal appearance.

Opposer's Mark

The logo for 'OSHIMANJU' is written in a tall, condensed, serif font. The letters are closely spaced and have a classic, formal appearance.

Respondent-Applicant's Mark

This Bureau finds that the competing marks are confusingly similar. All the elements of the Opposer's mark OISHI are present in the Respondent-Applicant's mark. The only difference is the addition of the word "MANJU" in the Respondent-Applicant's mark, a Japanese term that translates to cake or pastry. Hence, generic of the goods to be covered by the Respondent-Applicant's trademark application, and as such cannot serve as a distinguishing features to prevent a likelihood of confusion with the Opposer's mark.

Considering that the competing marks are used on similar or closely related goods particularly pastry and/or cake under Class 30, confusion, mistake, or even deception, as to the goods or products or with respect to the origin or manufacturers thereof are likely. Consumers may even assume that one mark is just a variation of the other and there is a connection or association between the two marks and/or between the contending parties themselves, when in fact there is none.

In this regard, confusion cannot be avoided by merely adding, removing or changing some letters of a registered mark. Confusingly 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>8</sup> The conclusion (of similarity) created by

<sup>6</sup> Annex "G-2".

<sup>7</sup> Annex "G-3".

<sup>8</sup> Societe Des Produits Nestle, S.A. v. Court of Appeals, G.R. No. 112012, 04 April 2001, 356 SCRA 207, 217.

use of the same word as the primary element in a trademark is not counteracted by the addition of another term.<sup>9</sup>

The field from which a person may select a trademark is practically unlimited. As in all cases of colorable imitation, the unanswered riddle is why, of the millions of terms and combination of letters available, the Respondent-Applicant had come up with a mark identical or so closely similar to another's mark if there was no intent to take advantage of the goodwill generated by the other mark.<sup>10</sup>


It is stressed that the laws on Trademarks and Tradenames is based on the principle of business integrity and common justice. This law, both in letter and spirit is laid upon the premise that, while it encourage fair trade in every way and aims to foster, and not to hamper competition no one especially a trader, is justified in damaging or jeopardizing others business by fraud, deceit, trickery or unfair methods of any sort. This necessarily precludes the trading by one dealer upon the good name and reputation built by another.<sup>11</sup>

Accordingly, this Bureau finds that the registration of 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 filewrapper of Trademark Application Serial No. 4-2010-010586 together with a copy of this Decision be returned to the Bureau of Trademarks for information and appropriate action.

**SO ORDERED.**

Taguig City, 03 January 2013.

  
**ATTY. NATHANIEL S. AREVALO**  
*Director IV*  
*Bureau of Legal Affairs*



*joanne*

<sup>9</sup> Continental Connector Corp. v. Continental Specialties Corp. 207 USPQ 60.

<sup>10</sup> American Wire and Cable Co. v. Director of Patents et.al. SCRA 544, G.R. No. L-26557, 18 February 1970.

<sup>11</sup> See Baltimore Bedding Corp. v. Moses, 182 and 229 34A (2d) 338.