



MANG INASAL PHILIPPINES, INC.,
Opposer,

-versus-

IFP MANUFACTURING CORPORATION,
Respondent- Applicant.

X-----X

}
} IPC No. 14-2012-00369
} Opposition to:
} Appln. Serial No. 4-2011-006098
} Date Filed: 26 May 2011
} TM: "OK HOTDOG INASAL
} CHEESE HOTDOG FLAVOR
} LABEL MARK"

NOTICE OF DECISION

QUISUMBING TORRES
Counsel for the Opposer
12th Floor, Net One Center
26th Street corner 3rd Avenue
Crescent Park West, Bonifacio Global City
Taguig, Metro Manila

ATTY. ESTRELLITA BELTRAN-ABELARDO
Counsel for Respondent-Applicant
Blk. 22, Lot 13 Singkil St. Lagro Subdivision
Novaliches, Quezon City

GREETINGS:

Please be informed that Decision No. 2013 - 182 dated September 19, 2013 (copy enclosed) was promulgated in the above entitled case.

Taguig City, September 19, 2013.

For the Director:

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



MANG INASAL PHILIPPINES, INC.,
Opposer,

IPC No. 14-2012-00369

Opposition to Trademark
Application No. 4-2011-006098
Date Filed: 26 May 2011

-versus-

IFP MANUFACTURING CORPORATION,
Respondent-Applicant.

Trademark: **OK HOTDOG INASAL
CHEESE HOTDOG FLAVOR
LABEL MARK**

x ----- x

Decision No. 2013- 182

DECISION

Mang Inasal Philippines, Inc.¹ (Opposer) filed on 15 October 2012 an opposition to Trademark Application Serial No. 4-2011-006098. The contested application, filed by IFP Manufacturing Corporation² (Respondent-Applicant), covers the mark "OK HOTDOG INASAL CHEESE HOTDOG FLAVOR LABEL MARK" for use on "curls, corn, green peas, biscuit" under Class 30 of the International Classification of Goods³.

Opposer anchors its opposition on Section 123.1 (d) of the Republic Act No. 8293, also known as the Intellectual Property Code of the Philippines ("IP Code"). It claims to be the successor-in-interest of Mr. Edgar J. Sia II and the current owner of the mark "MANG INASAL, HOME OF REAL PINOY STYLE BARBEQUE AND DEVICE", which was registered 17 August 2006 for services Class 43. The Opposer also alleges that it has a pending application for registration of the mark "MANG INASAL" since 11 June 2011 for goods and/or services under Classes 29 and 43. It has first used the mark as early as 12 December 2003 and has extensively promoted the mark in the Philippines.

According to Opposer, "OK HOTDOG INASAL CHEESE HOTDOG FLAVOR LABEL MARK" incorporates the highly distinctive lettering style, color combination and layout of its own mark. It points out the following alleged similarities between the marks:⁴

- 1. In both marks, the word "INASAL" is spelled in red font with black outlined and a yellow background/outline;

¹ A company organized under the laws of the Philippines with principal address at Delgado Street corner Fuentes Street, Iloilo City, Philippines.

² With address at 261 Kabatuhan Road, Deparo Caloocan City, Metro Manila, Philippines.

³ 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.

⁴ See Opposition, pp. 4-5.

2. In both marks, the word "INASAL" is spelled using the same stylized font;
3. In both marks, the letters in the word "INASAL" are arranged in the same staggered format; and
4. The proportion of the word "HOTDOG" in relation to "INASAL" in Respondent-Applicant's mark bears an uncanny similarity to the proportion of space occupied by the word "MANG" in Opposer's registered mark.

The Opposer further contends that the goods in connection with which Respondent-Applicant's mark is sought to be registered is closely related to the restaurant services under which its own mark is registered. It bewails that given the similarities, there is a studied attempt on the part of Respondent-Applicant to copy its renowned "MANG INASAL, HOME OF REAL PINOY STYLE BARBEQUE AND DEVICE" mark and to ride on the goodwill that it created through years of exclusive and continued use. It avers that consumers will be deceived as the confusing similarity will suggest a connection, association or affiliation between Opposer and Respondent-Applicant, thereby causing substantial damage to the goodwill and reputation of the former. Opposer furthers that the registration of Respondent-Applicant's mark will work to impede its natural expansion of its use of its mark.

A Notice to Answer dated 18 October 2012 was issued and furnished to Respondent-Applicant. However, the latter failed to comply. Accordingly, Respondent-Applicant was declared in default and the case was submitted for decision. Respondent-Applicant thereafter moved that the order of default be lifted but the same was denied in Order No. 2013-948 issued on 04 July 2013.

The issue to be resolved is whether Application No. 4-2011-006098 should be allowed registration.

Records reveal that at the time Respondent-Applicant filed an application for registration of its mark "OK HOTDOG INASAL CHEESE HOTDOG LABEL MARK", the Opposer has a valid and existing registration of its mark "MANG INASAL, HOME OF REAL PINOY STYLE BARBEQUE AND DEVICE" issued on 28 May 2007 under Certificate of Registration No. 4-2006-009050. Unquestionably, the Opposer is the prior registrant.

Now, to determine whether the marks of Opposer and Respondent-Applicant are confusingly similar, the two are shown below for comparison:



Home of Real Pinoy Style Barbeque"

Opposer's mark



Respondent-Applicant's mark

When one looks at the Opposer's mark, what is impressed in the eyes and mind is the word "inasal". It is the integral component of the mark "MANG INASAL HOME OF REAL PINOY STYLE BARBEQUE" because it is conveyed in bold letters and at the positioned at the center. Upon scrutiny of Respondent-Applicant's mark, the same conclusion may be derived therefrom. Be as it may, the similarity is insufficient to reach a conclusion that there may exist a confusion, much more deception. The only similarity between the two competing marks is the appropriation of the word "inasal", which describes a manner of cooking meat and therefore, descriptive. Other than this, the two competing marks are uniquely presented.

In *Societe des Produits Nestle vs. Court of Appeals*⁵, the Supreme Court explained:

"Generic terms are those which constitute 'the common descriptive name of an article or substance,' or comprise the 'genus of which the particular product is a species'" or are 'commonly used as the name or description of a kind of goods,' or 'imply reference to every member of a genus and the exclusion of individuating characters,' or 'refer to the basic nature of the wares or services provided rather than to the more idiosyncratic characteristics of a particular product,' and are not legally protectable. On the other hand, a term is descriptive and therefore invalid as a trademark if, as understood in its normal and natural sense, it 'forthwith conveys the characteristics, functions, qualities or ingredients of a product to one who has never seen it and does not know what it is,' or 'if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods,' or if it clearly denotes what goods or

⁵ G.R. No. 112012, April 4, 2001.

services are provided in such a way that the consumer does not have to exercise powers of perception or imagination." (Emphasis supplied.)

The so-called descriptive terms, which may be used to describe the product adequately, cannot be monopolized by a single user and are available to all. It is only natural that the trade will prefer those marks which bear some reference to the article itself.⁶ Precisely for this reason, Opposer was constrained to disclaim the word "inasal" in its Certificate of Registration. This word cannot be subject of exclusive use in view of its descriptive property. In fact, the Trademark Registry of the Intellectual Property Office Philippines (IPOPIL), the contents of which this Bureau can take cognizance of via judicial notice, would disclose that there are other entities aside from Opposer and Respondent-Applicant that utilizes the word "inasal" as part of their marks presented in similar font and color.

Moreover, the confusion or mistake, much more deception, is unlikely in this instance as bolstered by the fact the goods covered by Opposer's trademark registration are different from that of the Respondent-Applicant's. Opposer's goods are particular for that which are offered in their fastfood and restaurant chains. On the other hand, Respondent-Applicant's goods consist of snacks or curls that are available in ordinary stores. They do not flow in the same channels of trade as to result to any confusion. A consumer could easily discern that there is no connection between the curls or snacks offered by Respondent-Applicant and the meals offered by the Opposer in its restaurants. Therefore, it is doubtful that a purchaser of that would encounter a product bearing "OK HOTDOG INASAL CHEESE HOTDOG FLAVOR MARK" would be reminded of "MANG INASAL HOME OF REAL PINOY STYLE BARBEQUE".

Corollarily, the enunciation of the Supreme Court in the case of **Mighty Corporation vs. E. & J. Gallo Winery**⁷ aptly states that:

"A very important circumstance though is whether there exists likelihood that an appreciable number of ordinarily prudent purchasers will be misled, or simply confused, as to the source of the goods in question. The 'purchaser' is not the 'completely unwary consumer' but is the 'ordinarily intelligent buyer' considering the type of product involved. He is 'accustomed to buy, and therefore to some extent familiar with, the goods in question. The test of fraudulent simulation is to be found in the likelihood of the deception of some persons in

⁶ Ong Ai Gui vs. Director of Philippines Patent Office, G.R. No. L-6235, March 28, 1955.

⁷ G.R. No.154342, 14 July 2004.

some measure acquainted with an established design and desirous of purchasing the commodity with which that design has been associated. The test is not found in the deception, or the possibility of deception, of the person who knows nothing about the design which has been counterfeited, and who must be indifferent between that and the other. The simulation, in order to be objectionable, must be such as appears likely to mislead the ordinary intelligent buyer who has a need to supply and is familiar with the article that he seeks to purchase."

Finally, 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 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.⁸ Based on the above discussion, Respondent-Applicant's trademark met this function.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2011-006098 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 19 September 2013.


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

⁸ Pribhdas J. Mirpuri vs. Court of Appeals, G.R. No. 114508, 19 November 1999.