



STSS GLOBAL IP,
Opposer,

-versus-

TAIPEI FOODS, INC.,
Respondent -Applicant.

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IPC No. 14-2012-00332
Opposition to:
Appln. Serial No. 4-2011-009486
Date filed: 10 August 2011
TM: "SHI LIN AND ITS CHINESE
CHARACTERS"

NOTICE OF DECISION

VILLARAZA CRUZ MARCELO & ANGANGCO

Counsel for the Opposer
CVCLAW CENTER
11th Avenue corner 39th Street
Bonifacio Triangle, Bonifacio Global City
Taguig City

THE GENERAL MANAGER

TAIPEI FOODS, INC.
Respondent-Applicant
Block 13 Lot 1, E Rodriguez Jr. Avenue
Bagumbayan, Quezon City

GREETINGS:

Please be informed that Decision No. 2014 - 46 dated February 18, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, February 18, 2014.

For the Director:

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



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Decision No. 2014- 46

DECISION

STSS GLOBAL IP ("Opposer")¹ filed an opposition to Trademark Application Serial No. 4-2011-009486. The application, filed by TAIPEI FOODS, INC. ("Respondent-Applicant")², covers the mark "SHI LIN and its Chinese Characters" for use on services for providing food and drink under Class 43 of the International Classification of Goods and Services³.

The Opposer alleges, among other things that the subject mark cannot be registered because it is primarily a geographical word⁴ and is likely to mislead the public as to the geographical origin of the goods or services covered by the mark. According to the Opposer, the mark applied for registration by the Respondent-Applicant is similar or visually and aurally identical to the Opposer's well-known mark "Shilin Taiwan Street Snacks" and trade name. To support its opposition, the Opposer submitted as evidence the following:

1. Exhibit "A" – copy of an online document showing the Respondent-Applicant's Trademark Application Serial No. 4-2011-009586, downloaded from the Intellectual Property Office of the Philippines website;
2. Exhibit "B" – printout of the webpage taken from the Shilin District – Taipei City Government website;
3. Exhibit "C" – printout of the webpage taken from the National Palace Museum;
4. Exhibit "D" – online article about Shilin or Shi Lin Night Market, taken from the website <http://www.taiwanfun.com/north/taipei/article/0201/0201/covershilin.htm>;
5. Exhibit "E" – another online article about the Shilin Night Market, this time published by the Tourism Bureau of Tourism in its website;
6. Exhibit "F" – first online advertisement;
7. Exhibit "G" – second online advertisement;

¹ Corporation organized and existing under the laws of the Republic of Singapore, with business address at Anson Road, # 11-03, International Plaza, Singapore 079903.

² Is a corporation organized and existing under the laws of Republic of the Philippines, with address at Block 13, Lot 1, E. Rodriguez Jr. Avenue, Bagumbayan, Quezon City.

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 *Asia Brewery, Inc. v. Court of Appeals and San Miguel Corporation*, 224 SCRA 437 (1993).

8. Exhibit "H" – third online advertisement;
9. Exhibit "I" – Certificate/Affidavit of Mr. Daniel Tay Kok Siong;
10. Exhibit "J" – collection of photographs of Opposer's various stores and kiosks;
11. Exhibit "K" – copy of the exhibit's program inviting readers to start a SHIHLIN TAIWAN STREETS SNACKS;
12. Exhibit "L" – printout of the website www.pinoy-entrepreneur.com;
13. Exhibit "M" – printout of the website www.franphil.com;
14. Exhibit "N" – printout of Opposer's website;
15. Exhibit "O" – list of Philippine "nationals" that have contracted the Opposer to avail of franchising opportunities in the Philippines;
16. Exhibits "P" to "Y" – ten representatives emails sent by Philippine Nationals inquiring about the procedure for putting up a SHIHLIN TAIWAN STREETS SNACKS in the Philippines and thanking the Opposer for explaining the details of the franchising opportunity; and
17. Exhibit "Z" – compilation of various advertisements and articles on SHIHLIN TAIWAN STREETS SNACKS.

This Bureau issued a Notice to Answer and served a copy thereof upon the Respondent-Applicant on 21 March 2013. However, the Respondent-Applicant did not file an answer. Thus the Hearing Officer issued Order No. 2013-909 on 26 June 2013 declaring the Respondent-Applicant in default.

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

The Opposer anchors its case on Sec. 123.1, paragraphs (g) & (j) of Rep. Act No. 8293, also known as the Intellectual Property code of the Philippines ("IP Code"), which provides:

Sec. 123. Registrability – 123.1. A mark cannot be registered if:

x x x

(g) is likely to mislead the public, particularly as to the nature, quality, characteristics or geographical origin of the goods or services.

x x x

(j) consists exclusively of signs or of indications that may serve in trade to designate the kind, quality, intended purpose, values, geographical origin, time or production of the goods or rendering of the services or other characteristics of the goods or services.

The Opposer presented evidence establishing the following:

1. the words "SHI LIN" refers to a district in Taipei, Taiwan⁵ often referred to as the origin of culture in Taipei;
2. "Shilin" or "Shi Lin District" has a population of 283,855 and an area of 62.36 square kilometers;

⁵ Exhibit "B".

3. the National Palace Museum, first established in 1925 and one of the must-see attractions in Taiwan, is located in Shilin District;
4. one of the most famous night markets in Taipei is located in Shilin, the "Shilin Night Market" built as early 1899 and famous for various snacks and eateries and has become a renowned place for great foods⁶; and
5. "Shilin" is the place where the former Official Residence of Chiang Kai-Shek and Madam Chiang is located, and today, has universities, vocational colleges and special educational schools for the blind and mentally retarded; foreign schools are also present⁷.

In this regard, the Respondent-Applicant is engaged in the business of restaurant located in Podium Mall, Fort Bonifacio, Makati and Binondo, Manila offering Taiwanese cuisine and excellent service to customers.⁸ Thus, it is likely that patrons would have the impression that the goods/services offered by the Respondent-Applicant in its restaurant under the mark "SHI LIN and Chinese Characters" are:

1. made in or originated from and/or connected with the Shilin District located in Taipei, Taiwan, and/or
2. have the same quality and/or characteristics pertaining to those coming from or available in the Shilin District in Taipei, Taiwan.


However, while its name is Taipei Foods, Inc., the Respondent-Applicant is a local business entity, a corporation organized and existing under the laws of the Philippines, with address at Block 13, Lot 1, E. Rodriguez Jr. Avenue, Bagumbayan, Quezon City, Philippines. Its restaurant is in the Philippines and not in Taiwan. There is no evidence that the Respondent-Applicant has connections with the Opposer and/or the Shilin District in Taipei, Taiwan.

Thus, this Bureau finds and concludes that the registration of the mark SHI LIN and its Chinese Characters is proscribed by Section 123.1 (g) of the IP Code. It is emphasized that the Respondent-Applicant was given the opportunity to defend its trademark application. However, it chose not to.

WHEREFORE, premises considered the instant opposition is hereby **SUSTAINED**. Let the filewrapper of Trademark Application Serial No. 4-2011-009486 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 18 February 2014.


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

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⁶ Tourism Bureau of Taiwan, Exhibit "E".

⁷ Exhibit "B".

⁸ Exhibits "F", "G", and "H".