



JOSELITO F. ALMAJOSE,
Opposer,

-versus-

SAN MIGUEL PUREFOODS COMPANY, INC.,
Respondent-Applicant.

X-----X

}
} IPC No. 14-2012-00581
} Opposition to:
} Appln. Serial No. 4-2012-004333
} Date filed: 10 April 2012
} **TM: "HUNGRY JUAN ROAST**
} **CHICKEN AND DEVICE"**

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2014 - 207 dated August 14, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, August 14, 2014.

For the Director:

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



JOSELITO F. ALMAJOSE,
Opposer,

-versus-

SAN MIGUEL PUREFOODS COMPANY, INC.,
Respondent-Applicant.

X ----- X

IPC No. 14-2012-00581
Opposition to Trademark
Application No. 4-2012-004333
Date Filed: 10 April 2012
Trademark: **"HUNGRY JUAN
ROAST CHICKEN AND
DEVICE"**

Decision No. 2014- 207

DECISION

Joselito F. Almajose¹ an opposition to Trademark Application Serial No. 4-2012-004333. The contested application, filed by San Miguel Purefoods Company, Inc.² ("Respondent-Applicant"), covers the mark "HUNGRY JUAN ROAST CHICKEN AND DEVICE" for use on "*rotisserie chicken with different sauces and cooked food*" and "*food kiosks or carts*" under Classes 29 and 33 of the International Classification of Goods³.

The Opposer alleges:

"1. On 1 May 2007, Opposer Joselito F. Almajose, doing business under the name and style of 'HUNGRY JUAN', began to operate an eatery business called 'Hungry Juan Eatery', located at 1087 Del Monte Avenue, Paltok, D-1, Quezon City, through a sole proprietorship.

x x x

3. Sometime in April 2007, Opposer filed an application for registration of the business 'Hungry Juan' with the Department of Trade and Industry (DTI). x x x

4. In September 2007, one of the Opposer's customers published an online write-up regarding Opposer's barbecue business. The customer is an online food blogger who has reviews on other restaurants such as Razon's, Sizzling Pepper Steak and Alba Restaurant. The uniform resource locator or 'URL' where the said write-up may be found is at <http://madelynnemultiply.com/reviews/item/6>. x x x

5. As early as 16 December 2010, the said write-up appears at the top internet search page when the phrase 'Hungry Juan' is searched through the worldwide web. x x x Thus, a simple search of the words 'HUNGRY JUAN' through the worldwide web would have alerted Respondent that such trade name is already owned and is currently being used by the Opposer for his eatery business.

¹ Of legal age, Filipino, with office address at No. 22, G. Felipe St., Brgy. Damayan, Frisco, Quezon City.

² A corporation organized and existing under the laws of the Republic of the Philippines with principal address at JMT Corporate Condominium, ADB Avenue, Ortigas Center, Pasig 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.

6. Soon after that, in 2009, Opposer likewise established its website. The uniform resource locator or 'URL' <http://www.hungryjuan.com>. x x x

7. For the period from year 2000 up to June 2007, Opposer was also a dealer of Wilkins Distilled Drinking Water and Viva Mineral Water, which were being sold by Philippine Beverage Partners Inc. ('PhilBev'). A photocopy of the Exclusive Dealership Agreement ("Agreement" between PhilBev and Opposer, covering the period 1 April 2006 up to 1 June 2007 is hereto attached as Annex 'F'. the Opposer has no original copy of the agreement since the said original is in the possession of PhilBev.

8. PhilBev was then a wholly-owned subsidiary of Coca-Cola Bottlers Philippines Inc. ('CCBPI'). About sixty-five (65%) percent of the shares of CCBPI was then owned by San Miguel Corporation ('SMC'). Thus, it is SMC who controlled and managed CCBPI, as well as other subsidiaries of CCBPI, namely PhilBev and Cosmos Bottling Company. These are indicated in an article found on the website of SMC, uploaded in 22 February 2007; and hereto attached as Annex 'G'. In fact, SMC has issued correspondences and inter office memorandum in relation to Opposer's Agreement with PhilBev. x x x

9. In 2010, SMC acquired Pure Foods Corporation to form the Respondent corporation, San Miguel Pure Foods Company, Inc. During the said period, sales agents wearing uniforms bearing the SMC logo would visit the place where Opposer's barbecue eatery business is located. Thus, the said sales agents of SMC were aware, or at least familiar with, the barbecue business of Opposer called 'Hungry Juan'.

11. Sometime in June 2010, Opposer learned that on 21 May 2010, Respondent filed an application for registration of the trademark 'Hungry Juan Barbecue and Device' (hereinafter referred to as 'First Application') for the following classes of goods under the Nice Classification, Ninth Edition:

Class No. 29 – rotisserie chicken with different sauces; cooked food
Class No. 43 – food kiosks; carts

x x x

12. On 12 August 2010, Opposer filed its own application for registration of the trademark 'Hungry Juan'. x x x

13. On 22 December 2010, Opposer filed its opposition to Respondent's First Application. The case was submitted for decision and up to this date, remains pending with the IPO.

14. To Opposer's surprise, Respondent filed another application on 10 April 2012 for registration of the trademark 'Hungry Juan Roast Chicken and Devise' (hereinafter referred to as 'Second Trademark Application') for the following classes of goods under the Nice Classification, Ninth Edition:

Class No. 29 – rotisserie chicken with different sauces; cooked food
Class No. 43 – food kiosks; carts

x x x

16. Respondent's Second Trademark Application was allowed registration and was published on 19 November 2012.

17. In view of the similarity between Opposer's trademark 'Hungry Juan' and Respondent's trademark 'Hungry Juan Roast Chicken and Device', and the fact that the main product sought to be identified by the said trademarks is one and the same (namely chicken and other cooked meats), Opposer, in order to protect its rights as the real owner of the trademark 'Hungry Juan, now filed this Opposition to Respondent's trademark application."

In support of his Opposition, the Opposer submitted the following as evidence:⁴

1. photographs of the entrance of the "HUNGRY JUAN" pork and chicken barbecue eatery, its interior and the uniforms of its waiters;
2. copy of the menu of the Hungry Juan eatery;
3. copy of the certificate of registration of Opposer's business name issued by the DTI on 20 April 2007 and certificate of the notary public that the photocopy is a faithful registration of the original certificate of registration;
4. print-out of the write-up from the website <http://madelynne.multiply.com/reviews/item/6>;
5. printed copies of the search result page using two widely used search engines, namely Yahoo and Google, showing such write-up at the top of the search results of "Hungry Juan";
6. printout of Opposer's website;
7. photocopy of the Agreement between the Opposer and PhilBev;
8. print-out of the article uploaded on 22 February 2006 at the website of SMC;
9. letter from SMC addressed to Opposer, signed by its then Vice President and Corporate Sales Director, Mr. Pablo P. Pacquing;
10. copy of the Inter Office Memorandum of SMC showing the customer feedback on dealers of Wilkins, including Opposer;
11. copy of Respondent's trademark "HUNGRY JUAN ROAST BARBCUE AND DEVICE" and its coloured version;
12. copy of Opposer's mark "HUNGRY JUAN";
13. judicial affidavit of Opposer; and
14. copy of Respondent's trademark "HUNGRY JUAN ROAST CHICKEN AND DEVICE" and its coloured version.

For its part, the Respondent-Applicant avers:

"Respondent independently conceptualized the original 'HUNGRY

⁴ Marked as Exhibits "A" to "K", inclusive.

JUAN ROAST CHICKEN & DEVICE'
mark.

3.1 Respondent-Applicant 'HUNGRY JUAN ROAST CHICKEN AND DEVICE' mark is a variation of its prior 'HUNGRY JUAN ROAST BARBECUE AND DEVICE' AIMED AT SALES OF ROAST CHICKEN. Respondent-Applicant's chose the words 'Hungry' and 'Juan', in good faith, as part of its trademark 'HUNGRY JUAN ROAST CHICKEN & DEVICE' for the following reasons:

- a. Respondent independently conceptualize the original 'HUNGRY JUAN ROAST BARBECUE & DEVICE' mark;
- b. Respondent exercised due diligence when it filed its application for the registration of the 'HUNGRY JUAN ROAST BARBECUE & DEVICE' mark; and
- c. Respondent was unaware of the existence of Opposer's Hungry Juan Eatery at the time it conceptualized the 'HUNGRY JUAN ROAST BARBECUE' business and filed the corresponding application for trademark registration thereof with this Honorable Office.

3.2. Contrary to Opposer's claim, at the time Respondent began conceptualizing the mark 'HUNGRY JUAN ROAST BARBECUE & DEVICE', it was not aware of the existence of Opposer's Hungry Juan Eatery. The 'HUNGRY JUAN ROAST BARBECUE' concept is a result of a marketing project of Respondent, entitled 'PROJECT ADOBO', which in turn resulted in the production of the mark 'HUNGRY JUAN ROAST CHICKEN AND DEVICE'. In an email dated 02 February 2010 addressed to Ms. Vanessa Julian of Jimenez Basic, the advertising agency engaged by Respondent, Ms. Kathrina A. Hernandez, Assistant Project Manager of San Miguel foods, Inc., details the background and objectives of 'PROJECT ADOBO'. Under the project brief, PROJECT ADOBO was aimed at expanding Respondent's Ready-To-Eat ('RTE') portfolio, which includes its existing RTE, 'Monty's', which sells Monterey's pork and beef with rice, single serve meat and beef products and sandwiches.

3.3. One of the immediate targets for PROJECT ADOBO is to come up with a business concept, name, brand, or image for Respondent's RTE business which must be catchy and can be easily remembered by consumers. Respondent wanted a brand name that had greater mass appeal, attractive and can be effortlessly associated with its RTE products.

3.4. Respondent's team for PROJECT ADOBO considered earlier proposals that were thought to have mass appeal, including 'Da Meating Place', 'Ang Karne Mo!', 'Eat Da Meat' and 'Meat Street'. x x x

3.5. In the course of thorough research by the team for PROJECT ADOBO, they came across the foreign fastfood names 'Hungry Jack's' and Starvin' Marvin's Backyard BBQ ('Starvin' Marvin's'). These concepts became the inspiration for Respondent's 'HUNGRY JUAN ROAST BARBECUE & DEVICE' mark. x x x

3.6. Based on the PROJECT ADOBO team's research, Hungry Jack's is a fast food franchise of the International Burger King Corporation which has been operating in Australia since 1971. Hungry Jack's primarily offers hamburgers and chicken sandwiches, including the well-known Whopper Burger.

3.7. On the other hand, Starvin' Marvin's is a barbecue catering service in Bangalore, India that serves smoked meats and barbecues and barbecues for small social functions and large corporate events. x x x

3.8. The concept behind the brand names Hungry Jack's and Starvin' Marvin's fulfilled Respondent's brand name requirements of easy recall and catchiness. The words 'Hungry' and 'Starving' denote an immediate need to be satisfied, which ties directly to the ready-to-eat aspect of the PROJECT ADOBO. Also, the use of actual names 'Jack' and 'Marvin' in the brand names provides a personal and friendly quality which draws customers in with the implied personal and friendly relationship with the RTE brand.

3.9. To achieve mass appeal with Filipino consumers, the concept of Hungry Jack's and Starvin' Marvin's was localized by adopting the iconic and archetypal Filipino name 'Juan'. It was decided that the word 'Hungry' would be retained since it provided a pleasant-sounding alliteration when used with the word 'Juan'. As a result, the PROJECT ADOBO team recommended the name 'HUNGRY JUAN ROAST BARBECUE' for Respondent's RTE business, to emphasize the cooking method to be used in its various food offerings.

3.10. Respondent's Mr. Arellano worked together with Respondent's graphic designer the different elements of the logo. While Starvin' Marvin's logo uses an image of a cowboy wearing a cowboy hat and checkered kerchief around his neck Respondent used the image of a typical Filipino wearing a local salakot and yellow handkerchief around his neck. The Filipino male is pictured to be holding a chicken leg and barbecue skewers, the main RTE products to be sold by Respondent. The result is distinctive, colorful and welcoming logo with a relatable character on a warm, inviting, red background that featured the main products of the business as well as the roasting method of cooking of the products.

3.11. Thereafter, aiming on focusing on its roast chicken business, Respondent-Applclicant revised its 'HUNGRY JUAN ROAST BARBECUE & DEVICE' mark by changing the word 'barbecue' to 'chicken' and changing the representations of a chicken leg and barbecue skewers into a representation of a whole roasted chicken in the subject 'HUNGRY JUAN ROAST CHICKEN AND DEVICE'.

3.12. It is clear from the foregoing that Opposer's business had no influence whatsoever on, and was not even known to, Respondent when it conceptualized its 'HUNGRY JUAN ROAST BARBECUE' brand for its RTE business. In fact, the elements of Respondent's 'HUNGRY JUAN ROAST BARBECUE & DEVICE' mark are so specific and significant to the business that there are strict guidelines for their fabrication and use in the packaging and promotional materials as carefully crafted and condensed into Respondent's Brand Manual to be observed by franchises of the business.

Respondent exercised due diligence when it filed its application for the registration of the 'HUNGRY JUAN ROAST BARBECUE & DEVICE' mark'

3.14. On 19 April 2010, the business concept 'HUNGRY JUAN ROAST BARBECUE' for Respondent's RTE business was completed. Ms. Hernandez prepared and submitted for approval the complete presentation for the 'HUNGRY JUAN CONCEPT' as it was then called. x x x

3.15. The next step for Respondent's RTE business is the registration of the trademark 'HUNGRY JUAN ROAST BARBECUE & DEVICE' with the Honorable Office. Contrary to Opposer's allegations, Respondent did not file its application for registration of its 'HUNGRY JUAN ROAST BARBECUE & DEVICE' mark in bad faith. To ensure that there is no impediment to seeking registration of the mark, Respondent sought the legal expertise of the undersigned counsel to ensure the availability for use and registration of the 'Hungry Juan' name for goods and services in Classes 29 and 43. x x x

3.16. While the trademark search conducted yielded registrations and pending applications containing either the word 'Hungry' or the word 'Juan', there was no a registration or pending application containing the phrase 'Hungry Juan'. The registrability opinion indicates that the mark 'HUNGRY JUAN ROAST BARBECUE & DEVICE', when viewed as a whole, is generally distinctive and may be available for registration. The report also contained undersigned counsel's advice that the words 'Hungry', 'Roast' and 'Barbecue' may be considered descriptive and/or generic of Class 29 goods and Class 43 services and therefore the disclaimer of the said words may be required. x x x Since Opposer's application for the registration of his 'Hungry Juan' mark was filed only on 12 August 2010, or months after the trademark search was conducted, it was not included in the search report.

3.17. Because of the positive results of the trademark search, Respondent proceeded with the filing of the application for registration of its 'HUNGRY JUAN ROAST BARBECUE & DEVICE' on 21 May 2010. The application was accorded Application No. 4-2010-005435. The application was examined and Respondent's mark was determined to have met the requirements of registrability under Sections 123 and 124 of the IP Code. During the examination of the application, Opposer's mark was not even cited against Respondent's application. The application was thereafter allowed for publication on 22 November 2010.

x x x"

The Respondent-Applicant's evidence consists of the following:⁵

1. copy of the email to Ms. Julian dated 02 February 2010 and its attached project brief;
2. copy of an email dated 02 February 2010 from Ms. Hernandez showing the menu of Monty's;
3. copies of the email exchanges between Ms. Julian and Ms. Hernandez regarding the proposed named for Project ADOBO, dated 04, 10 and 16 February 2010;
4. affidavit of Respondent's Assistant Vice President for Marketing, Mr. Jose Alberto Arrelano, detailing the conceptualization of the "HUNGRY JUAN ROAST BARBECUE" brand and mark;
5. print out of the web listing of Starvin Marvin's;
6. copy of the "HUNGRY JUAN ROAST BARBECUE" RTE brand manual;

⁵ Exhibits "1" to "20", inclusive.

7. copy of the memo communication dated 19 April 2010 from Ms. Hernandez with signature approvals of Ms. Rita Imelda Palabyab, President, Mr. Leo A. Obviar, General Manager, Mr. Francisco Jimenez, Jr., National Sales Manager and Mr. Arellano;
8. copy of the email exchange between Mr. Arellano and Atty. Alexandra B. Trilliana, General Counsel of Respondent, dated 14 April 2010 regarding the request for a trademark availability search;
9. certified true copy of Atty. Trilliana's memo to Mr. Arellano dated 06 May 2010 discussing the availability and registrability of Respondent's mark; and
10. certified true copy of samples of Respondent's extensive advertisements and promotional materials used for Respondent's campaigns.

Pursuant to Office Order No. 154, s. 2010, the case was referred to mediation. The parties, however, failed to amicably settle. On 23 April 2014, a Preliminary Conference was conducted and terminated. Only the Opposer filed its position paper.

Records reveal that the Opposer filed its application for the mark "HUNGRY JUAN" on 12 August 2010. On the other hand, the Respondent-Applicant filed its application for its mark "HUNGRY JUAN ROAST CHICKEN & DEVICE" on 10 April 2012.

The issue to be resolved is whether Respondent-Applicant should be allowed to register the trademark "HUNGRY JUAN CHICKEN BARBECUE & DEVICE".

For comparison, the competing marks are reproduced below:



Opposer's mark



Respondent-Applicant's mark

When one looks at the Opposer's mark, what is impressed and retained in the eyes and mind are the words "HUNGRY JUAN". This feature of the mark identifies the product and the source thereof. Upon scrutiny of Respondent-Applicant's mark, the same conclusion is reached. Because both applications cover similar and related goods and services, confusion, mistake or even deception is likely to occur. 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 purchased as to cause him to purchase the one supposing it to be the other.⁶

Succinctly, since the Respondent-Applicant will also use or uses the mark "HUNGRY JUAN ROAST CHICKEN AND DEVICE" to goods on "*rotisserie chicken with different sauces and cooked food*" and "*food kiosks or carts*" under Classes 29 and 33 which are also similar and/or closely related to the goods and/or services covered by the Opposer's "HUNGRY JUAN" mark. Thus, the slight differences in the competing marks will not diminish the likelihood of the occurrence of confusion, mistake and/or deception. After all, the determinative factor in a contest involving registration of trade mark is not whether the challenged mark would *actually* cause confusion or deception of the purchasers but whether the use of such mark would *likely* cause confusion or mistake on the part of the buying public.⁷

Moreover, it is settled that the likelihood of confusion would not extend not only as to the purchaser's perception of the goods but likewise on its origin. In **Societe des Produits Nestle S.A. vs. Martin T. Dy, Jr.**⁸, the Supreme Court held:

"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: '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.'"

Anent Respondent-Applicant's argument that it has a prior pending application of its mark "HUNGRY JUAN ROAST BARBECUE AND DEVICE", the same must fail as the Opposer aptly raised the issue of ownership.

It is stressed that the Philippines implemented the TRIPS Agreement when the IP Code took into force and effect on 01 January 1998. Art. 15 of the TRIPS Agreement reads:

Section 2: Trademarks
Article 15

⁶ Societe des Produits Nestle,S.A. vs. Court of Appeals, GR No. 112012, 04 April 2001.

⁷ American Wire & Cable Company vs. Director of Patents, G.R. No. L-26557, 18 February 1970.

⁸ G.R. No. 172276, 08 August 2010.

Protectable subject Matter

- 1. Any sign, or any combination of signs, capable of distinguishing the goods or services of one undertaking from those of other undertakings, shall be capable of constituting a trademark. Such signs, in particular words, including personal names, letters, numerals, figurative elements and combinations of colours as well as any combination of such signs, shall be eligible for registration as trademarks. Where signs are not inherently capable of distinguishing the relevant goods or services, members may make registrability depend on distinctiveness acquired through use. Members may require, as a condition of registration, that signs be visually perceptible.**
- 2. Paragraph 1 shall not be understood to prevent a Member from denying registration of a trademark on other grounds, provided that they do not derogate from the provision of the Paris Convention (1967).**
- 3. Members may make registrability depend on use. However, actual use of a trademark shall not be a condition for filing an application for registration. An application shall not be refused solely on the ground that intended use has not taken place before the expiry of a period of three years from the date of application.**
- 4. The nature of the goods or services to which a trademark is to be applied shall in no case form an obstacle to registration of the trademark.**
- 5. Members shall publish each trademark either before it is registered or promptly after it is registered and shall afford a reasonable opportunity for petitions to cancel the registration. In addition, Members may afford an opportunity for the registration of a trademark to be opposed.**

Further, Article 16 (1) of the TRIPS Agreement states:

- 1. The owner of a registered trademark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trademark is registered where such use would result in a likelihood of confusion. In case of the use of an identical sign for identical goods or services, a likelihood of confusion shall be presumed. The rights described above shall not prejudice any existing prior rights, nor shall they affect the**

possibility of Members making rights available on the basis of use.

Significantly, Sec. 121.1 of Republic Act No. 8293, otherwise known as the Intellectual Property Code of the Philippines ("IP Code") adopted the definition of the mark under the old Law on Trademarks (Rep. Act No. 166), to wit:

"121.1. 'Mark' means any visible sign capable of distinguishing the goods (trademark) or services (service mark) of an enterprise and shall include a stamped or marked container of goods; (Sec. 38, R.A. No. 166a)"

Sec. 122 of the IP Code further states:

"Sec. 122. How Marks are Acquired. – The rights in a mark shall be acquired through registration made validly in accordance with the provisions of this law. (Sec. 2-A, R.A. No. 166a)"

There is nothing in Section 122 which says that registration confers ownership of the mark. What the provision speaks of is that the rights in a mark shall be acquired through registration, which must be made validly in accordance with the provisions of the law.

Corollarily, Section 138 of the IP Code provides:

"Sec. 138. Certificates of Registration. – A certificate of registration of a mark shall be prima facie evidence of the validity of the registration, the registrant's ownership of the mark, and the registrant's exclusive right to use the same in connection with the goods or services and those that are related thereto specified in the certificate." (Emphasis supplied)

Clearly, it is not the application or the registration that confers ownership of a mark, but it is ownership of the mark that confers the right to registration. While the country's legal regime on trademarks shifted to a registration system, it is not the intention of the legislators not to recognize the preservation of existing rights of trademark owners at the time the IP Code took into effect.⁹ The registration system is not to be used in committing or perpetrating an unjust and unfair claim. A trademark is an industrial property and the owner thereof has property rights over it. The privilege of being issued a registration for its exclusive use, therefore, should be based on the concept of ownership. The IP Code implements the TRIPS Agreement and therefore, the idea of "registered owner" does not mean that ownership is established by mere registration but that registration establishes merely a presumptive right of ownership. That presumption of ownership yields to superior

⁹ See Section 236 of the IP Code.

evidence of actual and real ownership of the trademark and to the TRIPS Agreement requirement that no existing prior rights shall be prejudiced. In **E.Y. Industrial Sales, Inc. vs. Shen Dar Electricity and Machinery Co., Ltd.**¹⁰, the Supreme Court held:

"RA 8293 espouses the "first-to-file" rule as stated under Sec. 123.1(d) which states:

x x x

Under this provision, the registration of a mark is prevented with the filing of an earlier application for registration. This must not, however, be interpreted to mean that ownership should be based upon an earlier filing date. While RA 8293 removed the previous requirement of proof of actual use prior to the filing of an application for registration of a mark, proof of prior and continuous use is necessary to establish ownership of a mark. Such ownership constitutes sufficient evidence to oppose the registration of a mark.

Sec. 134 of the IP Code provides that 'any person who believes that he would be damaged by the registration of a mark x x x' may file an opposition to the application. The term 'any person' encompasses the true owner of the mark, the prior and continuous user.

Notably, the Court has ruled that the prior and continuous use of a mark may even overcome the presumptive ownership of the registrant and be held as the owner of the mark. As aptly stated by the Court in Shangri-la International Hotel Management, Ltd. v. Developers Group of Companies, Inc.:

Registration, without more, does not confer upon the registrant an absolute right to the registered mark. The certificate of registration is merely a prima facie proof that the registrant is the owner of the registered mark or trade name. Evidence of prior and continuous use of the mark or trade name by another can overcome the presumptive ownership of the registrant and may very well entitle the former to be declared owner in an appropriate case.

x x x x

Ownership of a mark or trade name may be acquired not necessarily by registration but by adoption and use in trade or commerce. As between actual use of a mark without registration, and registration of the mark without actual use thereof, the former prevails over the latter. For a rule widely accepted and firmly entrenched, because it has come down through the years, is that actual use in commerce or

¹⁰ G.R. No. 184850, 20 October 2010.

business is a pre-requisite to the acquisition of the right of ownership.

XXXX

By itself, registration is not a mode of acquiring ownership. When the applicant is not the owner of the trademark being applied for, he has no right to apply for registration of the same. Registration merely creates a prima facie presumption of the validity of the registration, of the registrant's ownership of the trademark and of the exclusive right to the use thereof. Such presumption, just like the presumptive regularity in the performance of official functions, is rebuttable and must give way to evidence to the contrary.
(Emphases supplied.)

The prior use and ownership of the Opposer of the trademark "HUNGRY JUAN" has been sufficiently established. The Department of Trade and Industry ("DTI") issued in its favor a Certificate of Business Name Registration¹¹ for "HUNGRY JUAN EATERY" as early as 20 April 2007, way before Respondent-Applicant filed its trademark application. This corroborates the Opposer's claim that it started using its mark since 2007 when its eatery first opened for operation. While it is true that a certificate of registration from this Office serve a different purpose to that issued by the DTI, the latter may be considered insofar as the provisions of Section 165.2 of IP Code applies, to wit:

"165.2.(a) Notwithstanding any laws or regulations providing for any obligation to register trade names, such names shall be protected, even prior to or without registration, against any unlawful act committed by third parties.

(b) In particular, any subsequent use of the trade name by a third party, whether as a trade name or a mark or collective mark, or any such use of a similar trade name or mark, likely to mislead the public, shall be deemed unlawful. (Emphasis supplied.)

The above law explicitly states that trade names, whether or not registered, shall be protected against similar trade names, trademarks and/or collective marks, likely to mislead the public. To allow Respondent-Applicant to register and continuously use the mark "HUNGRY JUAN ROAST BARBECUE & DEVICE" may lead consumers to believe that the goods and/or services under the said mark is connected to that of the Opposer's, or the other way around. Noteworthy, Respondent-Applicant failed to dispute the Opposer's prior use of the latter's mark "HUNGRY JUAN".

¹¹ Exhibit "C" of the Opposer.

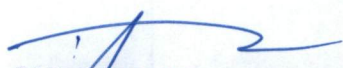
The Respondent-Applicant argued that it had no intention to copy the Opposer's mark. Intention to imitate, however, is inconsequential in this case. "HUNGRY JUAN" is highly distinctive such that the likelihood of confusion is strong. Public interest requires that co-existence of marks that are practically identical and used on similar and related goods or services should not be permitted.

It is stressed that the intellectual property system was established to recognize creativity and give incentives to innovations. Similarly, the trademark registration system seeks to reward entrepreneurs and individuals who through their own innovations were able to distinguish their goods or services by a visible sign that distinctly points out the origin and ownership of such goods or services. To allow Respondent-Applicant to register the subject mark will make the trademark registration simply a contest as to who files an application first with the Office.

WHEREFORE, premises considered, the instant Opposition to Trademark Application No. 4-2012-004333 is hereby **SUSTAINED**. Let the filewrapper of the subject trademark application be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 14 August 2014.


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