



NUTRI-ASIA, INC.,
Opposer,

-versus-

GREEN GOLD GOURMET FOODS,
INCORPORATED,
Respondent-Applicant.

}
} IPC No. 14-2012-00548
} Opposition to:
} Appln No. 4-2011-012969
} Date filed: 27 October 2011
} TM: "MR. PINAKURAT
} BOY BASTOS (LABEL MARK)"
}

X-----X

NOTICE OF DECISION

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GREETINGS:

Please be informed that Decision No. 2014 - 279 dated October 31, 2014 (copy enclosed) was promulgated in the above entitled case.

Taguig City, October 31, 2014.

For the Director:


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



NUTRI-ASIA, INC.,	}	IPC No. 14-2012-00548
Opposer,	}	Opposition to:
	}	
- versus -	}	Application No. 4-2011-012969
	}	Date Filed: 27 October 2011
GREEN GOLD GOURMET FOODS,	}	
INCORPORATED,	}	Trademark: MR. PINAKURAT
Respondent-Applicant.	}	BOY BASTOS (LABEL MARK)
x-----x	x	Decision No. 2014 - <u>279</u>

DECISION

NUTRI-ASIA, INC.¹ ("Opposer") filed a Verified Notice of Opposition to Trademark Application No. 4-2011-012969. The contested application, filed by GREEN GOLD GOURMET FOODS, INCORPORATED² ("Respondent-Applicant"), covers the mark MR. PINAKURAT BOY BASTOS (LABEL MARK) for use on "condiments, sauces, spices" under Class 30 of the International Classification of goods³.

The Opposer anchors its opposition on Section 123.1 (j) of Republic Act No. 8293 or the Intellectual Property Code of the Philippines ("IP Code"). According to the Opposer, "Pinakurat" is a descriptive term and is thus not entitled to trademark protection. The Opposer also maintains that "Boy Bastos" is an immoral or scandalous word not entitled to trademark protection. Further, the Opposer alleges, among other things, that:

"1. *Pinakurat* indicates that the condiments, sauces and spices on which it is used have a "shocking" or "surprising" characteristic.

"2. *Pinakurat* indicates that the condiments, sauces and spices on which it is used have a taste similar to the dish pinakurat.

In support of the opposition, the Opposer submitted the following pieces of evidence:

1. Certified true copy of the Articles of Merger between Nutri Asia, Inc. and Southeast Asia Food, Inc. (*Exhibit "A"*);
2. Certified true copy of the Amended Articles of Incorporation of Nutri-Asia, Inc. (*Exhibit "B"*);
3. Certified true copy of the Amended Articles of Incorporated of Southeast Asia Food, Inc. (*Exhibit "C"*);
4. Judicial Affidavit of Lalaine Gonzales-Camiña (*Exhibit "D"*);
5. Print out of Application No. 4-2010-500127 filed on 29 January 2010 for the trademark DATU PUTI PINOY KURAT SPICED TUBA VINEGAR AND DEVICE


1 A corporation duly organized and existing under the laws of the Republic of the Philippines, with principal address at 12th Floor, Centerpoint Condominium, Garnet Road corner Julia Vargas Avenue, Ortigas Center, Pasig City.

2 A corporation duly organized and existing under the laws of the Republic of the Philippines, with address at Purok 3, Puga-an, Iligan City, Lanao del Norte.

3 Nice Classification is a classification of goods and services for the purpose of registering trademarks and service marks, based on a multilateral administered by the World Intellectual Property Organization. This treaty is called the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks concluded in 1957.

- (Exhibit "E");
6. Copies of Official Action Papers Nos. 02 and 05 of the Bureau of Trademarks (Exhibits "F" and "G");
 7. Copy of Southeast Asia Food, Inc.'s Verified Petition for Cancellation filed on 10 March 2011 (Exhibit "H");
 8. Copy of the Verified Answer with Motion to Dismiss filed by Green Gold Gourmet Foods, Inc. (Exhibit "I");
 9. Copy of the Order dated 20 September 2011 issued by this Bureau (Exhibit "J");
 10. Copy of the Objection (to the Order dated 20 September 2011) filed by Nutri-Asia, Inc. (Exhibit "K");
 11. Copy of Green Gold's Complaint filed on 20 September 2011 (Exhibit "L");
 12. Copy of Nutri-Asia, Inc.'s Verified Answer with Compulsory Counterclaims (Exhibit "M");
 13. Copy of Order No. 2011-69 dated 22 November 2011 (Exhibit "N");
 14. Copy of the Motion for Reconsideration filed by Nutri-Asia, Inc. (Exhibit "O");
 15. Copies of the Orders dated 01 February 2012 issued by this Bureau (Exhibits "P" and "Q");
 16. Copy of the Motion for Dissolution of Injunction filed by Nutri-Asia, Inc. (Exhibit "R");
 17. Print out of the status of the subject trademark application (Exhibit "S");
 18. Print out of web page <http://business.inquirer.et/money/breakingnews/view/20080223-120763/Pinakurat-Vinegar-that-surprises> (Exhibit "T");
 19. Print out of the status of Registration No. 4-2004-011237 (Exhibit "U");
 20. Print out of the web page <http://tarr.uspto.gov/servlet/tarr?regser=serial&entry=77679893> (Exhibit "V");
 21. Print out of Respondent-Applicant's web page www.sukapinakurat.com (Exhibit "W");
 22. Print out of Respondent-Applicant's website showing "Suka WAYKURAT" among its products (Exhibit "X"); and
 23. Photographs of vinegar products and copy of receipt (Exhibits "Y-series").

The Respondent-Applicant filed its Verified Answer on 03 June 2013, specifically denying the allegations stated in the Verified Opposition and averring the following special and affirmative defenses:

- "1. The instant opposition is a mere re-hash of the issues brought forth by Opposer in IPC No. 14-2011-00084, and said issues, in fact, are irrelevant to the registration of the subject mark;
 - "2. Opposer is not a proper party to the instant opposition at all;
 - "3. Opposer is not entitled to use "Pinakurat" or any confusingly similar terms in its marks;
 - "4. The term "Pinakurat" is not descriptive of vinegar, sauces, condiments or spices;
 - "5. Even assuming *arguendo* that PINAKURAT is descriptive of vinegar, sauces, condiments and spices, it has already been imbued with secondary
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meaning and has become distinctively associated with Respondent-Applicant's products;

"6. "BASTOS" is not an immoral or scandalous word; and

"7. Opposer applied for the mark PINOY KURAT in bad faith."

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

1. Certified true copy of the Certification from the Department of Trade and Industry dated 02 August 2011 (*Exhibit "1"*);
2. Certified true copy of an article in *Cook Magazine* dated September 2002 (*Exhibit "2"*);
3. Copy of Certificate of Registration No. 4-2004-011237 for the mark SUKA PINAKURAT AND DEVICE issued on 16 June 2006 (*Exhibit "3"*);
4. Certified true copy of Deed of Sale of Intellectual Properties transferring to Green Gold Gourmet Foods, Inc. (*Exhibit "4"*);
5. Certified true copy of the Request for Recordal of the Assignment of a Registered Mark to Green Gold Gourmet Foods, Inc. (*Exhibit "5"*);
6. Certified true copy of the Registrability Report (Official Action Paper No. 2) dated 12 May 2010 for Datu Puti PINOY KURAT bearing Application No. 4-2010-500127 (*Exhibit "6"*);
7. Certified true copy of Registrability Report (Official Action Paper No. 5) dated 19 August 2010 (*Exhibit "7"*);
8. Certified true copy of the Decision of Dir. Leny Raz dated 10 March 2011 for the mark DATU PUTI PINOY KURAT SPICED TUBA VINEGAR AND DEVICE, Application No. 4-2010-500127 (*Exhibit "8"*);
9. Certified true copy of the Order of Dir. Leny Raz dated 26 April 2011 (*Exhibit "9"*);
10. Print out of DATU PUTI PINOY KURAT SPICED TUBA VINEGAR AND DEVICE with Application No. 4-2010-500127 (*Exhibit "10"*);
11. Certified true copy of Order No. 2011-69 dated 22 November 2011 issued by the Bureau of Legal Affairs (*Exhibit "11"*);
12. Certified true copy of Compliance to Order No. 2011-69 on 05 December 2011 received by the IPO (*Exhibit "12"*);
13. Certified true copy of Writ of Preliminary Injunction, Order No. 2012-07 dated 01 February 2012 (*Exhibit "13"*);
14. IPO file print out from website on the application of MR. PINAKURAT LOGO with Application No. 4-2011-12972 filed by Green Gold Gourmet Foods, Inc. (*Exhibit "14"*);
15. Copy of the application form of MR. PINAKURAT GAYUMA (LABEL MARK) with Application No. 4-2011-12970 filed by Green Gold Gourmet Foods, Inc. (*Exhibit "15"*);
16. Certified true copy of DATU PUTI PINAKURAT SPICED TUBA VINEGAR AND DEVICE with Application No. 4-2009-12183 (*Exhibit "16"*);
17. Certified true copy of the print out of DATU PUTI PINAKURAT SPICED TUBA VINEGAR AND DEVICE with Application No. 4-2009-12184 (*Exhibit "17"*);
18. Copy of the Motion for Extension of Time to File Verified Opposition involving the mark MR. PINAKURAT PUZZ'N (LABEL MARK) (*Exhibit "18"*);
19. Copy of the Motion for Extension of Time to File Verified Opposition for the mark MR. PINAKURAT BABUYAP (LABEL MARK) (*Exhibit "19"*);
20. Copy of the Motion for Extension of Time to File Verified Opposition for the mark

- MR. PINAKURAT COCUYAP (LABEL MARK) (Exhibit "20");
21. Judicial Affidavit of Rendo Stuart Del Rosario, Chief Executive Office of Green Gold Gourmet Foods, Inc. (Exhibit "21");
 22. Certified true copy of the article written by Rex Ortega entitled "*Pinakurat: Vinegar that Surprises*" dated 23 February 2008 (Exhibit "22");
 23. The phrase in the article which states "*Pinakurat is now the famous brand of vinegar made in Iligan City. And there seems to be no stopping its growing fame because it has not only become the must-have pasalubong from visitors of this city of waterfalls, but it is the most in demand padala to Filipinos abroad*" (Exhibit "22-a");

The case was scheduled for mediation conference on 26 July 2013. After it was declared a failure of mediation for refusal of the parties to mediate, the case was then after set for preliminary conference and the same was terminated on 28 January 2014. Both parties filed their respective position paper on 07 February 2014.

Should the Respondent-Applicant be allowed to register the mark MR. PINAKURAT BOY BASTOS (LABEL MARK)?

Sec. 123.1 (j) of R. A. No. 8293, relied upon by the Opposer, provides, in part, that a mark cannot be registered if it:

x x x

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

The above-quoted provision expresses the prohibition on registration of what is known as descriptive mark. Aptly, a term is descriptive if, as understood in its normal and natural sense, it "forthwith conveys the characteristics, functions, qualities or ingredients or 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 services are provided in such a way that the consumer does not have to exercise powers of perception or imagination.⁴

There is no dispute that the word PINAKURAT, which forms part of the Respondent-Applicant's mark, was derived from the Cebuano dialect "*kurat*". "*Kurat*", as translated in the application, means shocked, frightened or surprised. Thus, it is the Opposer's position that the use of the word PINAKURAT immediately signals to consumers that the food products which bear such mark have a "shocking" or "surprising" characteristic. According to the Opposer, as applied for condiments and sauces, the term suggests the characteristic of spiciness.⁵

The words "shocking" has been defined as something causing a feeling of surprise and dismay while "frightened" as to drive or force by arousing fear. These words characterize or express the feeling of a person. When applied to food items, these terms do not readily convey the characteristic, quality or ingredients of a product. Thus, the use of

⁴ *Societe Des Produits Nestle S. A. v. Court of Appeals*, G. R. No. 112012, 04 April 2001.

⁵ Paragraph 15 of Opposer's Verified Opposition.

the word PINAKURAT for processed, dried/dehydrated and powdered meat, seafoods, fruits and vegetables; condiments, sauces, spices does not readily convey an immediate idea as to the ingredients or qualities of the products. As correctly pointed out by the Respondent-Applicant, it requires a certain degree of imagination and perception to establish a link between the term and the products on which it is used.

At most, the word PINAKURAT may be considered merely as suggestive of the characteristic of the goods. Suggestive terms are those which, in the phraseology of one court, require "imagination, thought and perception to reach a conclusion as to the nature of the goods." Such terms, "which subtly connote something about the product," are eligible for protection in the absence of secondary meaning. While suggestive marks are capable of shedding "some light" upon certain characteristics of the goods or services in dispute, they nevertheless involve "an element of incongruity," "figurativeness," or "imaginative effort on the part of the observer."⁶

In this regard, this Bureau finds merit in the arguments raised by the Respondent-Applicant, to wit:⁷

"29. "PINAKURAT" does not immediately signal to consumers that the product has "shocking" or "surprising" characteristic. The word "PINAKURAT" is not even germane to Respondent-Applicant's vinegar, which can also be applied to its condiments, sauces and spices:

"There is no merit in [Opposer's] claim that the term "PINAKURAT" of the cited mark is a descriptive and generic term, which cannot become a dominant feature of the mark or be exclusively appropriated as a trademark. We concur with Examiner Salviejo that the cited etymology of the term "PINAKURAT" does not present itself to be a sufficient justification to conclude that the term is descriptive of the nature, quality, ingredients or other characteristics of the product "vinegar". A considerable degree of imagination and perception would still be needed to establish a link between the term used and the product it is emblazoned on. In fact, no such reasonable inference can be made from the term "pinakurat" to the product "vinegar".

Further, the presence of a Certificate of Registration in favor of the cited mark is sufficient to bar any other confusingly similar mark from registration, notwithstanding alleged objections made by the [Opposer] to its registrability.

"30. In the case of *Societe Des Produits Nestle S. A. v. Court of Appeals*, 356 SCRA 207 (2001), the Supreme Court differentiated descriptive terms from suggestive terms:

x x x

⁶ *Societe Des Produits Nestle, S. A.*, supra.

⁷ Respondent-Applicant's Position Paper, pages 15-19.

"31. Clearly, the term "PINAKURAT" is not descriptive of the goods, or their characteristics, it seeks to protect. Even the alleged meaning of "PINAKURAT" --- shocking or surprising --- are not common characteristics of the covered goods. At most, and this is already stretching the connotation of the word, "PINAKURAT" may be said to be suggestive of the characteristics of the goods. Even so, suggestive marks are registrable, as held in the Nestle case. Even as early as in the case of *Ang v. Teodoro*, 74 Phil 50, the Supreme Court held:

x x x

"32. Applying the foregoing in this case, "PINAKURAT" is never used adjectively to define or describe the goods, or their characteristics, rather, is merely suggestive of them. Thus, the term "PINAKURAT" need not be disclaimed, and was the proper subject of appropriation when the SUKA PINAKURAT mark was registered.

"33. Further, the admissions made by Opposer in the instant Opposition belie its claim that the word "PINAKURAT" is descriptive. Opposer relates the meaning of the word "KURAT" to spicy taste, or in Tagalog "*anghang*", contrary to its admission in paragraph 14 of the instant Opposition, Opposer claims that:

"The term *pinakurat* is an affixation of the Cebuano root word "kurat". It means "in a sudden or surprising manner as to shock the person."

"34. It is plainly and simply absurd to say that the term "PINAKURAT" immediately conveys the characteristics of the goods, when Opposer is also claiming that the meaning of the same term is "shocking" or "surprising".

"35. It may be that Opposer finds that Respondent-Applicant's goods have a surprising or shocking characteristic for being spicy or maanghang. Precisely, Opposer already spells out that the alleged characteristic of the products is their spiciness, and not their being surprising or shocking. In paragraph 18 of the instant Opposition, it admitted that "*pinakurat*'s direct English or Tagalog translation is not spicy or *pinaanghang*. Indeed, Opposer admitted that it had to exercise powers of perception or imagination to connect the terms "shocking" or "surprising" to spiciness in taste.

Accordingly, this Bureau finds that the Respondent-Applicant's trademark application as not falling within the definition of descriptive mark under Section 123.1 (j) of the IP Code. Also, the Opposer's bare assertion that "BOY BASTOS" is an immoral or scandalous word not entitled to trademark protection must fail for failure to substantiate its allegation with proof or evidence that indeed the word "BASTOS" alone offends decency or morality.

WHEREFORE, premises considered, the instant opposition is hereby **DISMISSED**. Let the filewrapper of Trademark Application Serial No. 4-2011-012969 be returned, together with a copy of this Decision, to the Bureau of Trademarks for information and appropriate action.

SO ORDERED.

Taguig City, 31 October 2014.



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